## United States Court of Appeals for the Second Circuit



**APPENDIX** 

# 74-1767

IN THE

### United States Court of Appeals

FOR THE SECOND CIRCUIT

No. 74-1767

SHATTUCK ET AL,

Appellees,

v.

HOEGL ET AL,

Appellants.

On Appeal from the United States District Court for the Western District of New York

#### JOINT APPENDIX

Francis J. Hone
Brumbaugh, Graves, Donohue
& Raymond
30 Rockefeller Plaza
New York, New York
10020
Attorneys for Appellants

JOSEPH G. WALSH, ESQ. IBM 'Monterey & Cottle Roads San Jose, California 95114

Pennie & Edmonds
330 Madison Avenue
New York, New York 10017
Attorneys for Appellees

Received 8/5
Remie + Edmonds
By Pennie + Edmonds



PAGINATION AS IN ORIGINAL COPY

#### A-I

#### TABLE OF CONTENTS

		Page
1.	Relevant Docket Entries.	A-3
2.	Deposition subpoena to testify or to produce documents and things addressed to John Weigl and dated February 11, 1974.	A-5
3.	Deposition subpoena to testify or to produce documents and things addressed to John Weigl and dated March 13, 1974.	Λ-7
4.	Shattuck et al Order to Show Cause Why the Witness Weigl Should Not Be Compelled to Produce Allegedly Privileged Documents, dated April 23, 1974, and Memorandum in Support thereof.	A-9
	Attachments to Item 4:	
	Identification of Privileged Documents	A-10
	Exhibit A - Opinion by Judge Burke dated March 26, 1974.	A-27
	Exhibit B - Transcript of Weigl Testimony of April 5, 1974, pp. 7, 14-15, 22, 26, 27, 45-47.	A-32
	Exhibit C - Preliminary Statement of Hoegl et al dated November 7, 1972.	A-41
	Affidavit of Clyde C. Metzger dated April 18, 1974.	A-49
5.	Memorandum of Hoegl et al in Opposition to the Shattuck et al Request for a Show Cause Order dated April 30, 1974.	A-51
	Attachments to Item 5:	
	Exhibit A - Xerox Research and Engineering Division, Research Laboratories Report No. RL64-45, dated August 15, 1964, cover page, pp. 19-20.	A-66
	Exhibit B - Preliminary Statement of Hoegl et al dated November 7, 1972.	A-69
	Exhibit C - Hoegl et al Declaration, Power of Attorney and Petition.	A-71
6.	Transcript of Proceedings before the Court on April 30, 1974.	A-73
7.	Shattuck et al Supplemental Memorandum in Support of Movants' Request for an Order to Show Cause Why the Witness Weigl Should Not be Compelled to Produce Allegedly Privileged Documents (undated) handed to the Court at the hearing on April 30, 1974.	A-97
	Attachments to Item 7:	
	Exhibit E - Hoegl et al CIP Declaration (lines 1-10) and Claims (Claim 1)	A-102
	Exhibit F - Weigl deposition, pp. 74-77, 80-82, 109-112.	A-105
	Exhibit G - Karambelas deposition, pp. 97-98, 106.	A-116

Attachments to Item 8:  Exhibit D - Letter-Report No. 19 dated August 24, 1964.  Exhibit E - Letter-Report No. 21 dated November 25, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081. A-  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	
Supplemental Affidavit of Clyde C. Metzger dated April 19, 1994.  8. Supplemental Memorandum of Hoegl et al in Opposition to the Shattuck et al Request for Privileged and Work Product Documents, dated May 3, 1974.  Attachments to Item 8:  Exhibit D - Letter-Report No. 19 dated August 24, 1964.  Exhibit E - Letter-Report No. 21 dated November 25, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081.  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	
8. Supplemental Memorandum of Hoegl et al in Opposition to the Shattuck et al Request for Privileged and Work Product Documents, dated May 3, 1974.  Attachments to Item 8:  Exhibit D - Letter-Report No. 19 dated August 24, 1964.  Exhibit E - Letter-Report No. 21 dated November 25, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081.  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	121
Exhibit D - Letter-Report No. 19 dated August 24, 1964.  Exhibit E - Letter-Report No. 21 dated November 25, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081.  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	
Exhibit D - Letter-Report No. 19 dated August 24, 1964.  Exhibit E - Letter-Report No. 21 dated November 25, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081.  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	
Exhibit E - Letter-Report No. 21 dated November 23, 1964.  Exhibit F - Comprehensive Progress Report No. 6, March 1965.  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081.  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	
Exhibit F - Comprehensive Progress Report No. 0, Nates 1905  Exhibit G - Communication from Patent Office declaring interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081. A-  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	135
interference.  Exhibit H - Motion Under Rule 231(a)(4) to Deny Hoegl et al the Benefit of Earlier Application Serial No. 519,081. A-  Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	141
Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.	151
Exhibit I - Decision on Motions.  Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.  A-	153
Exhibit J - Petition to the Commissioner.  Exhibit K - Communication from Patent Office on Petition.  A-	164
Exhibit K - Communication from Patent Office on Petition. A-	-165
	-184
EXHIBIT L - Salashy Hotebook	-186
	-191
	-195
	-206
	-207
	-209
9. Letter dated May 3, 1974 from Anthony W. Karambelas to the Hon. Harold P. Burke and Memorandum of Law Submitted on Behalf of Party	A-215
Attachments to Item 9:	
Transcript of April 30, 1974 Proceedings Before Court, pp. 21- 8	
Weigl deposition, pp. 81-82.	A-223
Lorenz v. Finkel, 142 U.S.P.Q. 26 (CCPA 1964).	A-225
Patent Office Decision of 12/20/73 on Shattuck et al Motion Under Rule 287.	A-237
10. Decision and Order of the Court dated May 7, 1974.	A-241
11. Notice of Appeal dated May 14, 1974.	A-245

#### A-3

#### ITEM No. 1

#### Relevant Docket Entries

Da 19	74	Proceeding
Feb.	11	Subpoena served
Mar.	13	Subpoena served
Apr.	23	Order to Show Cause Signed
Apr.	30	Memo in Opposition to Show Cause Motion
Apr.	30	Supplemental Memo in Support of Show Cause Motion
May	3	Supplemental Memo in Opposition to Show Cause Motion
May	3	Response Brief to Supplemental Memo in Support of Show Cause Motion
May	7	Decision and Order of Judge Burke Signed
May	14	Notice of Appeal
June	4	Record on Appeal filed in United States Court of Appeals for the Second Circuit

#### ITEM No. 2

DEPOSITION SUBPOFNA TO TESTIFY OR PRODUCE DOCUMENTS OR THINGS	(Herlard Sept. 1971) D.C. Form No. 0

## Anited States District Court

FOR THE
Western District of New York
CIVIL ACTION FILE No.
Shattuck et al
Shaccack et al
Interference No. 93,04
Noegl et al
TO: JOHN W. WEIGL 534 Wahlmont Drive West Webster, New York 14580
YOU ARE COMMANDED to appear at  700 Midtown Tower on the 20th day February 197%, at on behalf of the party Shattuck et al
at the taking of a deposition in the above entitled action pending in the United States Districtive formula Districtive and bring with you' all documents
described in Schedule A attached hereto.
to a February 23 of 7h
Dated February 11 19.71.
JOSEPH G. WALSH, ESQ. JOHN K. ADAMS
Allorney for the party Shattuck et al  Montarey and Cottle Reads San Your, Callet 1911  Address Tel: 403-227-7100  Clerk.  By  Deputy Clerk.
Any subposenced organization not a party to this suit is hereby admonished pursuant to Rule 30 (b) (6). Federal Rules of Civil Procedure, to file a designation with the court specifying one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and shall set forth, for each person designated, the matters on which he will testify or produce documents or things. The persons so designated shall testify as to matters known or reasons y available to the organization.
1. Strike the words "and bring with you" unless the subscene is to resulte the prediction of dreaments or tangible things, in which case the documents and things should be designated in the blank space provided for that purpose. If testimony by an organization representative or designed is requested, describe with transceable particularity the matters on which examination is requested.
RETURN ON SERVICE
Received this subpoena at
and on at
served it on the within named by delivering a copy to h and tendering to h allowed by law.'  the fee for one day's attendance and the mileage allowed by law.'
Dated:, 19
Service Fees  Travel Services
TotalS
Subscribed and sworn to before me, a this day of 19



Schedule of Documents for Subpoena Duces Tecum.
To Be Served on Witnesses Identified in the
Accompanying Notice

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Fatent Office.

#### ITEM No. 3

DEPOSITION SUBPOENA TO TESTIFY OR PRODUCE DOCUMENTS OR THINGS (Revised Oct. 1953) D. C. Fared No. 8

### United States District Court

FOR	RTHE
WESTERN DISTRICT	OF NEW YORK
Meredith Shattuck	CIVIL ACTION FILE No.
Helmut Hogl	Interference No.98,047
JOHN W. WEIG1 534 Wahlmont Drive West Webster, New York 14580	J
New Federal Building, State Street on the day harch 194 on behalf of the party Shattuck et al	at 12:30 M. to testify Patent Office
xat the taking of a denosition in the above entitled lescribed in Schedule A attached her	action pending in the United States Listrict Court and bring with you
Dated 13, 749	JOHN K. ADAME
Josephag forwalsh, esq.	•
the party Shattuck et al	By
San Jose, California 95114	Deputy Clerk. uire the production of documents or tangible things, in which case the docu-
HE NEW YORK NOW NEW TO NEW YORK NEW YO	ON SERVICE
Bessived this submoone of	
Received this subpoena at and on	at
served it on the within named by delivering a copy to h and tendering to h allowed by law.*  Dated:	the fee for one day's attendance and the mileage
Service Fees	Ву
Travel \$	
Total\$	
Subscribed and sworn to before me, a	this
day of 19	

<sup>&</sup>lt;sup>2</sup> Fees and mileage need not be tendered to the witness upon service of a subpoena issued in behalf of the United States or an officer or agency thereof. 28 USC 1825.

Note.—Affidavit required only if service is made by a person other than a United States Marshal or his deputy.

Fru

Schedule of Documents for Subpoena Duces Tecum To Be Served on Witnesses Identified in the Accompanying Notice

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Patent Office.

#### ITEM No. 4

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.,

Movants,

: Patent Interference 98,047 v .

HOEGL ET AL.,

Respondents.

ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

On the file of the above-captioned case and the affidavit of Clyde C. Metzger and Movants' Memorandum in Support of Request for Court Order attached hereto

IT IS HEREBY ORDERED that Respondents show cause at a at the United States Count House, Rochester, N.Y. hearing before this Court to be held on the 26th day of April 1974, at 10:00 o'clock A.M. why an Order should not be issued compelling the witness Weigl, or the real party in interest, Xerox Corporation, to produce to Movants the documents identified in Shattuck et al. Exhibit 26 annexed hereto, and compelling the witness Weigl to answer all questions relating to such documents.

IT IS FURTHER ORDERED that sufficient cause for waiving ordinary notice requirements having been shown, Movants, by their attorneys, are directed to serve a copy of this Order on Anthony W. Karambelas, Esq., Xerox Corporation, Xerox Square, Rochester, New York 14644, and Francis J. Hone, Esq., Brumbaugh, Graves, Donohue & Raymond, 30 Rockefeller Plaza, New York, New York 10020 attorneys for Respondents on or before the 2+4 day of April 1974.

> /S/ Harold P. Burke United States District Judge

Dated: Rochester, New York

April 23 , 1974

IDENTIFICATION OF PRIVILEDGED DOCUMENTS IN THE FILE S OF DR. WEIGHT RELATING TO THE COUNT OF INTERFERENCE NO. 98,047

ORIGINATOR	RECIPIENT/DISTRIBUTEES	DATE	SUBJECT
1. J. Weigl.  Attachments to Document	A. Mahassel/ J. Mammino A. G. Tweet W. W. Tyler D. L. Stockman J. J. Ralabate	4/2/70	Invention Record: High Speed Organic Photo- conductor Coatings (J. Mammine
la. J. Mammino	J. Weigl	3/26/70	•
		8/15/64	RL64-45
lb. J. Mammino G. Jvirblis			
lc. J. Weigl	A. Mahassel/ J. Mammino J. Urbach	4/2/70	Battelle Work on Heavily Doped PVK

Shattuck Eph#26 SQ. RMF 4-5-74

## IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

-----х

SHATTUCK ET AL.,

Movants,

v. : Patent Interference 98,047

HOEGL ET AL.,

Respondents

\_\_\_\_\_

MEMORANDUM IN SUPPORT OF MOVANTS' REQUEST FOR AN ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

#### Introduction

This request for an Order directing the witness Weigl to produce allegedly privileged documents relates to the above-entitled ancillary proceeding which was initiated on March 4, 1974 by the filing with this Court of the Shattuck et al. "Motion Under Rule 37 F.R.C.P. For Order Compelling The Production Of Documents And Answers To Questions Propounded Under Rule 30, F.R.C.P." (hereinafter "Motion Under Rule 37").

The ancillary proceeding is based on Patent Office
Interference No. 98,047 between the interference parties Meredith
D. Shattuck and Ulo Vahtra ("Shattuck et al.") and Helmut Hoegl
and Giacomo Barchietto ("Hoegl et al.").

The real parties in interest are International Business Machines Corporation ("IBM"), assignees of Shattuck et al., and Xerox Corporation ("Xerox"), assignees of Hoegl et al.

The original Motion Under Rule 37 had been brought because, in attempting to take the deposition of a witness, John W. Weigl, an employee of Xerox, the witness refused to answer all substantive questions or produce any documents specified in a subpoena duces tecum which had been served upon him.

#### The Court Order Of March 26, 1974

In an opinion dated March 26, 1974 (annexed hereto as Exhibit A) this Court held, inter alia,

(i) that Shattuck et al. are "entitled to unrestricted access to sources of information bearing on the question of fraud,"

and

(ii) that "Weigl is directed to produce at said time [April 5, 1974] and place any documents in his possession, custody or control, within the scope of Schedule A annexed to the subpoena duces tecum served on him on or about February 11, 1974, and particularly such documents as laboratory reports, memoranda, correspondence, or notes relating to work done prior to August 1, 1964, either by Weigl or by Dr. E. Lell, with whom Weigl worked at Xerox Corporation in Rochester, New York, or by others under his direction or control, which relate to photoconductive compositions comprising from about 0.49 to about 1.23 moles of 2, 4, 7-trinitro-9 fluorenone ("TNF") per monomeric unit of a polymerized vinyl carbazole ("PVK") compound.

"Weigl is directed to testify with respect to any documents produced in accordance with the schedule of the subpoena duces tecum."

#### The Testimony Of Weigl And Its Significance

At the deposition on April 5, 1974, pursuant to the Court's Order requiring the witness Weigl to answer questions which he had previously refused to answer, Weigl admitted, as alleged by Shattuck et al., that he had in fact carried out work in 1963 coming within the subject matter of the interference count! (Transcript of Weigl testimony of April 5, 1974, pp.14-15, annexed hereto as Exhibit B.)

The significance of this admission lies in the fact that Hoegl et al. (or their attorneys), although they knew of this earlier work by Weigl, nevertheless, stated under oath in their Preliminary Statement in this interference that they, Hoegl et al., were the true inventors of the invention covered by the interference count and that they made that invention in 1964. Moreover,

this early work of Weigl, constituting highly relevant prior art uniquely within the knowledge of Xerox, was not brought to the attention of the Patent Office as clearly required by the law.

The significance of Xerox holding Hoegl et al. out as the inventors of the subject matter of the interference count is of critical importance, as noted below, because it enabled Xerox to institute this interference which they could not otherwise have done.

It is submitted that Shattuck et al., as pointed out below in more detail, have established a prima facie showing that fraud has been perpetrated in connection with (i) the filing of the Hoegl et al. Preliminary Statement, (ii) the filing of the Hoegl et al. patent application involved herein, and (iii) the withholding of material facts from the Patent Office so as to justify this Court in issuing the requested ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS. Such allegedly privileged documents were withheld at the Aprtil 5, 1974 deposition of Weigl and are identified in Shattuck et al.'s Deposition Exhibit 26 annexed to said Order.

#### The Relevant Sequence Of Events

Summarizing the relevant facts, some of which have already been set forth in the Shattuck et al. Motion Under Rule 37 filed with this Court on or about March 4, 1974, the following sequence of events are particularly pertinent to the present motion:

1. On January 6, 1966 Hoegl et al. filed a parent patent application relating to an electrophotographic plate and process. The invention described and claimed therein was directed to a special type of "overcoat layer" which could be used with various assertedly old, prior art photoconductive compositions.

One of the many assertedly old and "unuseable" (according to Hoegl et al.) photoconductive compositions referred to by Hoegl et al. was a PVK-TNF composition (ratio 1:1) which comes within the scope of this interference count.

2. On December 16, 1969 the Shattuck et al. United States patent 3,484,237, which is involved in this interference, issued to IBM. This patent described and claimed a photoconductive composition which is now the subject matter of this interference, namely

"An organic photoconductive composition comprising from about 0.49 to about 1.23 mols of 2,4,7-trinitro-9-fluorenone per monomeric unit of a polymerized vinyl-carbazole compound."

- 3. In April 1970 IBM commenced commercial production of IBM copier machines employing a specific photoconductive composition coming within the terms of claim 1 in the Shattuck et al. patent.
- 4. On January 21, 1971, after learning of the issuance of the Shattuck et al. patent (Weigl deposition p. 22, annexed hereto as Exhibit B), and while the Hoegl et al. parent patent application was still pending in the Patent Office, Hoegl et al. filed a "continuation-in-part" application (hereinafter "CIP application") wherein their original parent application was radically altered so that instead of being directed to the special "overcoat layer," the CIP application was now directed to, and even claimed, the very same PVK-TNF composition (ratio 1:1) which Hoegl et al. had previously thought to be "unuseable in conventional imaging systems" and "undesirable" in regard to certain important properties. Thus, of all the innumerable photoconductive compositions which Hoegl et al. had orignally disclosed in their parent application as being old and "unuseable," the CIP application was now entirely directed to just one photoconductive composition, namely, a PVK-TNF composition (ratio 1:1) which was now described as "new" and "acceptable." This composition, of

course, came within the scope of the claims of the Shattuck et al. patent. The CIP application was accompanied by a declaration of inventorship (equivalent to an oath) wherein Hoegl et al. declared that they believed themselves to be (i) the "original" and (ii) the "first" inventors of a PVK-TNF composition (ratio 1:1) as the law required them to do! The purpose of the filing of the CIP application was, of course, to provoke an interference with the Shattuck et al. patent on the grounds that the invention claimed therein was supposedly first made by Hoegl et al.

5. On November 7, 1972, after the declaration of the present interference between the Shattuck et al. patent and the Hoegl et al. CIP application, Hoegl et al. swore that they made the invention set forth in the present interference count, that is, the invention defined by claim 1 of the Shattuck et al. patent.

#### The Hoegl Et Al. Preliminary Statement And CIP Application Are Tainted With Fraud

We submit that a prima facie showing has been made that fraud has been perpetrated in connection with the filing of the Preliminary Statement, as well as the filing of the Hoegl et al. CIP application. Specifically:

It has now been established that Hoegl et al. (or their attorneys as noted below) knew of Weigl's early work with TNF and PVK before the filing of the Hoegl et al. CIP application on January 21, 1971, and before the filing of the Hoegl et al. Preliminary Statement on or about November 7, 1972. A document attached to the Hoegl et al. Preliminary Statement, written by, inter alia, Hoegl et al. on November 25, 1964 states that the work which Hoegl et al. carried out in 1964 "show again what E. Lell and J. Weigl already have pointed out; namely, that TNF is the best CT sensitizer found so far for PVK" (Exhibit C annexed hereto comprises the relevant portion of the Hoegl et al. Preliminary Statement and attachment, specifically page 3 of such attachment).

A-16

It has further been established that this work of Lell and Weigl involved PVK and TNF coming within the scope of the interference count (Weigl deposition, pp. 15-16, annexed hereto as Exhibit B).

It has further been established that the Xerox patent attorneys were also aware of the earlier work of Lell and Weigl and that such attorneys must therefore have improperly caused the filing of the CIP application and the Preliminary Statement in the name of Hoegl et al. (Shattuck et al. Exhibit 26, annexed to the Order requested herein, was produced by Xerox during the Weigl deposition. This Exhibit 26 describes documents relating to the early work of Weigl which comes within the scope of the Weigl subpoena [and thus the interference count] and were sent to Mr. A. Mahassel, the Xerox Patent Manager, and Mr. J. J. Ralabate, a Xerox patent attorney. See pp. 45-46 of Weigl deposition annexed hereto as Exhibit B.)

## The Significance Of A False Assertion Of Inventorship In A CIP Application And A Preliminary Statement

Without extensive discussion of the purposes of the Patent Laws and Patent Office Rules requiring sworn statements (or declarations) as to the proper inventorship on a CIP application (35 U.S.C. § 115)\* and in a Preliminary Statement (Patent Office Rule 216),\*\* suffice it to say that the requirement for such oaths is to prevent an attempt by a party, after seeing an invention patented (and even commercially used) by another, to improperly usurp that invention as its own. When Xerox filed the Hoegl et al. CIP

<sup>\* 35</sup> U.S.C. § 115 provides that, "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicts a patent ..."

<sup>\*\*</sup> Patent Office Rule 216 provides that, "The preliminary statement must state that the party made the invention set forth by each count of the interference ..."

application there was no way under the Patent Laws in which Xerox could have even instituted this interference except by improperly holding out Hoegl et al. as the inventors of this subject matter. It was statutorily impermissible at that time to file a new application in the name of Weigl or anyone else.\*

#### The Allegedly Privileged Documents

The documents which Weigl refused to produce on the ground of attorney-client privilege are described in Shattuck et al. Deposition Exhibit 26 which was produced by Xerox and is annexed to the Order requested herein. Regarding Document 1 referred to therein:

- J. Weigl, a non-lawyer, was Manager of Imaging Materials Department of the Applied Research Laboratory (Exhibit B, p. 7).
- A. Mahassel was Xerox Patent Manager in Rochester, an attorney but not a member of the New York Bar (Exhibit B, p. 46).
- A. G. Tweet, a non-lawyer, was Weigl's supervisor (Exhibit B, p. 46).
- W. W. Tyler, a non-lawyer, was Manager of the Xerox Research Laboratories (Exhibit B, p. 46).
- D. L. Stockman, a non-lawyer, was a Research Manager concerned with photoconductors, generally (Exhibit B, p. 46).
- J. J. Ralabate was a Xerox patent attorney (Exhibit B, p. 46).

#### Regarding Document 1(a):

J. J. Mammino and J. Weigl referred to above were non-lawyers.

<sup>\* 35</sup> U.S.C. § 102(b) provides that a person shall not be entitled to a patent if "the invention was patented ... in this or a foreign country ... more than one year prior to the date of application for patent in the United States ..." By the time the Hoegl et al. CIP application was filed on January 21, 1971, the Shattuck et al. U. S. patent had long since issued (December 16, 1969) and the corresponding Shattuck et al. British and New Zealand patents had already been published and issued on August 7, 1968, and June 13, 1967, respectively.

Attorney-client privilege is not being asserted as to this document and it has been produced except for portions alleged by Hoegl et al. to be irrelevant.

Regarding Document 1(c):

- J. Weigl, A. Mahassel, J. Mammino, have been identified above.
- J. Urbach, a non-lawyer, was a Research Manager, Xerox, Palo Alto Research Center (Exhibit B, p. 47).

The Need For Discovery Of The Alleged Privileged Documents

It should be noted that the privileged documents withheld by Weigl are dated in March and April 1970, just about the time IBM commenced commercial production of its IBM copier machines employing a specific PVK-TNF composition coming within the scope of the Shattuck et al. patent.

Since these documents admittedly relate to the early work of Weigl coming within the scope of the interference count and since such work was admittedly done prior to the alleged invention date of Hoegl et al., it is considered extremely relevant to the issue of fraud to learn, for example, what possible basis the Xerox patent attorneys had for causing Hoegl et al. to declare that they, Hoegl et al., believed themselves to be the original and first inventors of PVK-TNF compositions (ratio 1:1) when any such alleged invention was apparently derived from the earlier work of Weigl.

Did Xerox initially consider filing an application in Weigl's name at that time? Did Xerox attempt to attribute Weigl's work to Hoegl et al. and then, failing to do so, improperly cause the filing of the Hoegl et al. CIP application and the Preliminary Statement in the name of Hoegl et al? Why did Xerox not advise the Patent Office of Weigl's early work, as they should have done and thus permit the Patent Office to make its determination of whether Weigl's work would be a statutory bar to the Hoegl et al.

CIP application?\* All these questions are relevant to Xerox's intent, which is an important aspect regarding the issue of fraud.

The <u>only</u> way such very critical answers can properly be determined and the <u>only</u> way that <u>all</u> the facts regarding the intent of Xerox can be brought to the attention of the Patent Office is by the production of the documents herein requested.

## The Special Facts In This Case Justify The Production Of The Documents Requested Herein

In connection with this interference, it is particularly significant that the alleged inventors, Hoegl and Barchietto, are not residents of the United States. They reside in Europe and are not subject to subpoena. IBM requested Xerox to produce these witnesses and offered to pay the expenses which they would incur in a trip to the United States. IBM also requested Xerox to enter into a stipulation under Patent Office Rule 284 (e) which would permit the taking of the testimony of Hoegl and Barchietto in Europe. Xerox refused both requests (Exhibit D).

Moreover, the Patent Office has already held, as previously pointed out in the Shattuck et al. Motion Under Rule 37, that it "has no authority to order or force a person to testify in an interference proceeding," but that "Shattuck et al. can, however, call the persons involved as their own witnesses which apparently is what they intend to do." This is what Shattuck et al. are now doing and this is why Shattuck et al. require the assistance of this Court in obtaining the documents requested herein. The Patent Office, in their December 20, 1970 decision, also indicated that any evidence regarding fraud in connection with ex parte prosecution of the Hoegl et al. CIP patent application should be brought to the attention of the Commissioner of

<sup>\* 35</sup> U.S.C. \$ 102(g) provides that, "A person shall be entitled to a patent unless ... (f) he did not himself invent the subject matter sought to be patented, or (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it ..."

Patents by way of a Petition to the Commissioner Under Patent Office Rule 56 (Motion Under Rule 37, Exhibit 6 annexed thereto). Patent Office Rule 56 provides in part that:

"Any application ... fraudulently filed or in connection with which fraud is practiced or attempted on the Patent Office, may be stricken from the files." (emphasis added)

Accordingly, it is respectfully submitted that it is essential for Shattuck, et al. to have access to the documents requested herein and thus be able to present all the facts to the Patent Office regarding the issue of fraud.

herein are extremely narrowly defined, namely, documents relating to work which was (i) admittedly carried out by persons other than Hoegl et al. and coming within the scope of the interference count, (ii) admittedly carried out prior to the date of invention which was sworn to by Hoegl et al., and (iii) admittedly known to Hoegl et al. (or their attorneys) prior to the time Hoegl et al. filed their CIP application and their Preliminary Statement.

A further justification for ordering the production of the allegedly privileged documents requested herein is the fact that, as stated above, Hoegl et al. made such a radical change in their patent application after learning of the issuance of the Shattuck et al. patent and after IBM began commercial production of their copier machines employing PVK and TNF. The radical change appearing in the Hoegl et al. CIP application had obviously been prompted by the issuance of the Shattuck et al. patent and by IBM's commercial use of PVK-TNF compositions. It was clearly not the result of any recent work done by or invention made by Hoegl et al. since Hoegl et al. had completed all their work on PVK-TNF compositions back in 1966, nearly five years before Xerox filed the CIP application in their name (Exhibit B, pp.26-27)

In summary, therefore, this is a case where Xerox, after being spurred into activity by the issuance of the IBM patent, permitted Hoegl et al. to swear in a CIP application that they were the inventors of a photoconductive composition covered by that IBM patent (i) in spite of the fact that Hoegl et al. had previously described that very same composition as old, "unsuitable," and "undesirable," and (ii) in spite of the fact that this very same composition was known by Xerox to have already been made by others prior to Hoegl et al., and (iii) in spite of the fact that Xerox failed to disclose to the Patent Office, as required by law, this highly significant prior art work of others.

Then, during this interference, Xerox refused to produce the alleged inventors, Hoegl et al., for testimony; then refused to even permit the taking of such testimony in Europe under Patent Office Rule 284(e); then instructed all its employees and former employees to not answer any questions whatsoever on the issue of fraud; and then, after being ordered by this Court to provide Shattuck et al. with "unrestricted access" to evidence regarding the issue of fraud, Xerox ordered the witnesses not to produce the most relevant documents on the ground of attorney-client privilege.

#### The Issue Of Fraud In Interference Proceedings Regarding The Hoegl Et Al. CIP Application And Preliminary Statement

As stated by this Court in its Order of March 26, 1974 compelling the witness Weigl to testify and to produce documents, "fraud is ancillary to priority." (Exhibit A, p. 2). It is also clear that in connection with an interference proceeding a fraudulent CIP oath or Preliminary Statement is a serious issue relevant to such proceeding. Langer v. Kaufman, 465 F.2d 915 (CCPA 1972).

The Issue Of Fraud Regarding Hoegl Et Al's Failure To Advise The Patent Office Of Facts Regarding The Critical Prior Art Work Of Weigl

The extremely pertinent prior art work of Weigl, admittedly known to Xerox, and involving the very same PVK-TNF composition (ratio 1:1) which Hoegl et al. asserted to be their invention was improperly withheld from the Patent Office.

In <u>Langer v. Kaufman</u>, 465 F.2d 915, 920-1 (CCPA 1972), the Court referred back to its earlier decision in <u>Norton v.</u>
Curtiss, 433 F.2d 779 (CCPA 1970), stating:

"[W]e \*\*\* subscribe to the recognition of a relationship of trust between the Patent Office and those wishing to avail themselves of the governmental grants which that agency has been given authority to issue. \*\*\* [The Patent Office] must rely on applicants for many of the facts upon which its decisions are based. The highest standards of honesty and candor on the part of applicants in presenting such facts to the office are thus necessary elements in a working patent system. We would go so far as to say they are essential. (emphasis added.)

\* \* \* \*

"[W]e \*\*\* repeat the words of the Supreme Court:

"A patent by its very nature is affected with a public interest. \*\*\* The far reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeking that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope."

known to an applicant should be submitted to the Patent Office for consideration rather than being dismissed as nonrelevant in the opinion of applicant or its advisors is emphasized in <a href="Beckman Instruments Inc.">Beckman Instruments Inc.</a> v. Chemtronics Inc., 428 F.2d 555 (5 Cir. 1970). In that case Beckman and the inventor, Clark, knew about, but failed to disclose to the Patent Office, a prior art device invented by Stow which the Court found to completely anticipate the Clark invention. The Court stated the rationale

and measure of Beckman and Clark's duty to disclose facts to the Patent Office as follows:

"Appellants' conduct must be examined against the standard of conduct required of an applicant before the Patent Office. The Patent Office does not have full research facilities of its own, and it has never been intended by Congress that it should. In examining patents, the Office relies heavily upon the prior art references that are cited to it by applicants. It is therefore evident that our patent system could not function successfully if applicants were allowed to approach the Patent Office as an arm's length adversary." (pp. 564-5) (emphasis added.)

\* \* \*

"Appellants' only reply to these facts is that they did not consider Stow's work to be relevant prior art. This assertion, however, is rendered utterly incredible both by Beckman's conduct and by the obvious similarity of the Stow and Clark devices. Furthermore, the determination that the prior art did not render the patent invalid should have been left to the Patent Office rather than being decided privately by Beckman and Clark. Consequently, we conclude that there was no excuse for appellants' failure to disclose Stow's work to the Patent Office, and this conclusion prevents us from considering Beckman's conduct as fulfilling an "uncompromising duty" of good faith disclosure. We are constrained to hold the patent invalid on this ground also." (p. 566) (emphasis added)

#### Prima Facie Evidence Of Fraud Vitiates The Asserted Attorney-Client Privilege

It has long been the rule, not only in cases involving fraudulent procurement of a patent, but in any case involving a crime or fraud, that a claim of attorney-client privilege respecting a communication, relating to the furtherance or commission of such crime or fraud, is vitated or destroyed. 8 Wigmore, Evidence, \$ 2298 (McNaughton Rev. 1961). In the case of Clark v. United States, 289 U.S. 1 (1933), Justice Cardozo summarized the rationale upon which the attorney-client privilege is pierced:

"... There is a privilege protecting communications between attorney and client. The privilege takes flight if the relation is abused. A client who consults an attorney for advice that will serve him in the commission of fraud will have no help from the law. He must let the truth be told...

To drive the privilege away, there must be 'something to give colour to the charge;' there must be 'prima facie evidence that it has some foundation in fact.'... When that evidence is supplied, the seal of secrecy is broken.... Nor does the loss of the privilege depend upon the showing of a conspiracy, upon proof that client and attorney are involved in equal guilt. The attorney may be innocent, and still the guilty client must let the truth come out ... (p. 15)

Other cases which support this general proposition are: <u>United States v. Bob</u>, 106 F.2d 37, 40 (2 Cir. 1939); <u>SEC v. Harrison</u>, 80 F.Supp. 226, 230 (D.C. 1948); <u>United States v. Weinberg</u>, 226 F.2d 161, 172 (3 Cir. 1955), cert. den., 350 U.S. 933 (1955).

The foregoing proposition that the attorney-client privilege disappears in the face of <u>prima facie</u> evidence of fraud has been held to apply to patent interference proceedings. In <u>Ziegler v. Natta</u>, 157 U.S.P.Q. 400 (S.D.N.Y. 1968) the District Court held, at page 400, as follows:

"The documents, mostly lawyers' letters and opinions, are undoubtedly relevant to the issue of bona fides of the attribution of inventorship to Ziegler and Martin in plaintiff's application Serial No. 514,068 in 1955, thereafter amended in 1958 to Ziegler, Martin, Breil and Holzkamp. Although we have some doubt as to whether or not they are privileged communications, we are satisfied that the defendant has offered sufficient prima facie evidence seriously challenging the bona fides of the aforementioned amendment. We have been told that 'the far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that the patent monopolies spring from backgrounds free from fraud or other inequitable conduct. Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co., 324 U.S. 806, 816, 65 USPQ 133, 138 (1945).

"Accordingly, whether the documents are privileged as confidential communications or as work products, these privileges disappear when otherwise a fraud would be committed on the public ... The documents, therefore, must be made available.

The circumstances of this case clearly demonstrate that should the documents sought to be withheld by the witness Weigl fall within the purview of the attorney-client relationship, they are nonetheless subject to an order requiring their production to movants. Shattuck et al. have clearly demonstrated herein prima facie evidence of fraud in connection with (i) the Hoegl et al. CIP oath, (ii) the Hoegl et al. Preliminary Statement, and (iii) the failure of Xerox to advise the Patent Office of highly relevant prior art uniquely within the knowledge of Xerox. Thus, any allegedly attorney-client documents pertaining to the very specific issue of Xerox's knowledge of Weigl's early work and how Xerox handled such knowledge in connection with the Hoegl et al. CIP application and Preliminary Statement should be produced in order that the truth with respect to these matters be brought out and presented to the Patent Office.

#### CONCLUSION

For all of the reasons stated above, and particularly by reason of the fact that the public interest is directly affected by the grant of a patent, the Court should grant Movants', Shattuck et al.'s, request for an order directing the witness Weigl to produce the allegedly privileged documents identified in Shattuck et al.'s Exhibit 26 annexed to the Order to Show Cause, and to answer all questions relating to such documents.

Respectfully submitted,

Dated:

WISER, SHAW, FREEMAN, VAN GRAAFEILAND, HARTER & SECRETS

By 700 Midtown Tower Rechester, New York 14604 (716) 232-6500 Attorneys for Movants

#### Of Counsel:

Pennie & Edmonds
Clyde C. Metzger
Robert J. Kadel
Sidney R. Bresnick
330 Madison Avenue
New York, New York 10017

Joseph G. Walsh International Business Machines Corporation Monterey & Cottle Roads San Jose, California 95114 UNITED STATES DISTRICT COURT WESTERN DISTRICT OF HEW YORK

SHATTUCK, ET AL.,

Movants

- vs -

No. 98,047

HOEGL, ET AL.,

Respondents

Wiser, Shaw, Freeman, VanGraafeiland,
Harter & Secrest
700 Midtorm Tower
Rochester, N.Y. 14604
Attorneys for movants

Pennio & Edmonds
330 Madison Avenue
New York, N.Y. 10017
and
Joseph G. Walsh
% International Business Machine Corp.
San Jose, Calif. 95114
(of counsel)

Brumbaugh, Graves, Donchue & Raymond 30 Rockefeller Plaza New York, N.Y. 10020 by Francis J. Hone

Paris, Haskell & Levine
Washington, D.C.
and
Anthony W. Karambelas
Merox Comporation
Xerox Square
Rochester, N.Y. 14644
Attorneys for respondents

Harris, Beach & Wilcox 2 State Street Rochester, N.Y. 14614 by Elliott Horton (of counsel) The movents on March 6, 1974 filed a motion with five separately numbered paragraphs under Rule 37, rederal Rules of Civil Procedure, for an order compelling the production of documents and answers to questions propounded under Rule 30, Federal Rules of Civil Procedure.

The motion was argued orally on March 19, 1974 and was submitted on written memoranda.

This court has jurisdiction to determine the motion under Title 35 U.S.C. Section 24.

The documents and the testimony which the movants attempted to get through the deposition of Weigl have a direct bearing on the movants allegations of fraudulent misconduct on the part of Hoegl, et al in filing their Proliminary Statement. The alleged fraud is ancillary to priority of invention. If fraud should be established it could be the basis for striking the Preliminary Statement. In that sense any testimony of Weigl relating to the subject of Shattuck, et al.'s, claim of fraud is relevant to the interference proceeding.

The movants have a statutory right to the desired discovery through this court. This court has ancillary jurisdiction over discovery in the interference proceeding. This court should exercise that jurisdiction

to complement patent office jurisdiction in search for the truth. Patent Office rules of admissibility of evidence do not govern discovery under the Federal Rules of Civil Procedure in an interference proceeding.

There is no ground for objection that the documents or evidence sought in the discovery will be inadmissible at the trial, so long as the documents and testimony sought to be elicited appear to be reasonably calculated to lead to the discovery of evidence that would be admissible. The movants are entitled to unrestricted access to sources of information bearing on the question of fraud. Neight is not a party to the interference proceeding. He has no standing to refuse to answer questions asked at the deposition on the ground that they are irrelevant to the interference proceeding.

Weigl is directed to answer the questions which he refused to answer on the advice of counsel at the deposition on February 20, 1974, and which appear in the copy of the transcript submitted as Exhibit 3 annexed to the affidavit of Clyde T. Metzger.

Weigl is directed to appear at the Office of Wiser, Shaw, Freeman, VanGraafeiland, Harter & Secrest, 700 Midtown Tower, Rochester, New York 14604, on April 5, 1974 at 10:00 A.M. to answer the questions previously asked him and to answer any further questions he may be asked with respect to his work for Xerox Corporation in the field of photoconductive compositions relating to possible fraud in connection with the filing of the Preliminary Statement in Interference No. 98,047 and as they relate to any further issues relevant to said interference.

Meigl is directed to produce at said time and place any documents in his possession, custody or control, within the scope of Schedule A annexed to the subposna duces tecum served on him on or about Pebruary 11, 1974, and particularly such documents as laboratory reports, memoranda, correspondence, or notes relating to work done prior to August 1, 1964, either by Weigl or by Dr. E. Lell, with whom Weigl worked at Xerox Corporation in Rochester, New York, or by others under his direction or control, which relate to photoconductive compositions comprising from about 0.49

to about 1.23 moles of 2, 4, 7-trinitro-9 flourenone ("TNF") per monomeric unit of a polymerized vinyl-carbazole ("PVK") compound.

Weigl is directed to testify with respect to any documents produced in accordance with the schedule of the subpoena duces tecum.

Weigh is directed, if asked by the attorneys representing the movants, to state the names of co-workers in the laboratory with him, and their addresses, if known to him, in relation to the work done prior to August 1, 1964.

The application of the movents for expenses incurred in connection with this motion, including attorneys' fees, is denied.

ALL OF THE ABOVE IS SO ORDERED.

Carold P. Burke

HAMOLD P. BURKS United States District Judge

March 26. 1974.

,	Α	Yes, sir.
2	DQ13	Which of these people would be group leaders, at
		that time?
3		MR. HONE: Do you mean, with
4		group leaders?
5		MR. WALSH: With group leaders.
6		To the best of my recollection, Dr. Lell who worked
7	Α.	
8		independently, Dr. Martel and Dr. Brynko.
9	DQ14	At that time, did those three report to you?
10	A.	Yes, sir.
11	DQ15	And, am I correct, I might have asked this, I am not
		certain, but at that time, was your title manager
12		of Imaging Materials Department of the Applied Re-
13		search Laboratory?
14	Α.	To the best of my recollection, that was the title,
15	\ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \	at that time.
16		
17	DQ16	You testified the last time that during or shortly
18		after 1962, the people at Xerox "we" is the word
19	1	used, initiated discussions leading toward a re-
20	7	search project between Xerox and Battelle, I will
		ask you, was any research agreement reached between
21		Xerox and Battell?
22	1	MR. HONE: Now, to the extent
23	3   .	

1

3

5

7

8

9

10

11

12

13

15

16

17

18

20

21

22

23

DQ32

MR. WALSH: Do you have with you now the documents as to which you claim privilege?

MR. HONE: No.

MR. WALSH: You did not bring them with you?

MR. HONE: That is correct.

MR. WALSH: Do you have a list of the documents with the dates on which they were written and the addressees to whom they were sent and the person who sent them?

MR. HONE: No, I haven't such a list. That could be obtained if you feel it appropriate. I don't think it bears on the issue, but we could obtain them.

MR. WALSH: Let the record show that there appears to be, I would guess, approximately fifty pages, maybe seventy or so, which have been handed to us.

I will be more specific in my question, then. For

the year 1963, did you, Dr. Weigl, or anyone else in your group at Xerox work with compositions comprising from about 0.49 to about 1.23 moles of 2, 4, 7 trinitro-9 fluorenone per monomeric unit of a polymerized vinylcarbazole compound? To make certain everybody understands the question I will repeat it. In 1963, Dr. Weigl, did you or any member of your group at Xerox work with an organic photo conductive composition comprising from about 0.49 to about 1.23 moles of 2, 4, 7 trinitro-9 fluorenone per monomeric unit of a polymerized vinylcarbazole compound? MR. HONE: When you say, "from 0.49 to about 1.23," you mean anything within that range, is that correct? MR. WALSH: That is correct. MR. HONE: Fine. Yes. Is that work the subject of the records which Mr. DQ33 Hone just handed to me? Completely covers that.

18

1

2

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

19

20 DQ3

DQ34

21

22

23

Would you give us a brief summary of what is cover-

the call. 1 At the time of the call, regardless of who initiated D245 2 it, were you in the United States and was he in 3 Switzerland? Yes, sir. 5 E246 Do you recall the circumstances of this telephone 6 call? 7 MR. HONE: Well, I object on 8 the ground that it calls for an irro-9 levant and possibly confidential sub-10 ject matter, but if Dr. Weigl can 11 answer without revealing any confiden-12 tial subject matter other than dis-13 cussion of the subject matter of the 14 count of this interference I will be 15 glad to let him answer. 16 I will try to the very best of my ability to moon-17 struct this. To the best of my recollection, both 18 Hoegl and I were aware of the I.P.M. issue a the 19 on polyvinylcarbazole doped with 0.49 to 1.23 mole 20 to mole ratios of T.N.F. We were both aware of his 21 intention and we were trying to retrace in hir minds. 22 the origins and bask-count of this invention. 23

-		cation to Xerox as he understood it.
2		THE WITNESS: I am sorry, which
3		question would you like me to answer?
4		MR. WALSH: I will start
5		again.
		THE WITNESS: Please.
6	D256	You say that work under the sponsorship of Xerox in
7		the field of T.M.F. and P.V.C. containing materials
8		stopped. You seem to leave open the possibility
9		that work under somebody else's sponsorship might
10		have been going on. I am asking you if work had
11%		been done under the sponsorship of Xerox, would it
12		or would it not have been assigned to Xerox?
13	. A.	To the best of my understanding, work sponsored by
14		Xerox was the product of it, was the property of
15		Xerox.
16	DQ57	And, after April, 1966, to the best of your know-
17		ledge, and information, and, incidientally, if I
18		understood you correctly, Dr. Hoegl was sending you
19		reports and keeping you informed of his work so that
20		if work had gone on you would have known about it,
21		to the best of your knowledge, he did not work in
22	2	this field of T.N.F. and P.V.C. after April, 1956,
2	3	

۱ ا		is that correct?
2	Α.	Dr. Hoegl's reports to Xerox would cover work spon-
3		sored by Xerox and it is correct that there was no
4		Xerox sponsored work on polyvinylcarbazole and T.N.F.
5		subsequent to termination of this project.
6	1253	And, that termination was April, 1966?
7	Α.	That is correct, or very close to that time.
8	D059	There were a few incidental, further reports to which
9		you referred. When would they have terminated, in
10		a month or two?
11		MR. HONE: Dr. Weigl has al-
12	•	ready answered.
13	Α.	I believe by mid-1956. We have furnished you with
14		all information relating to the count that appears
15		in any reports that we were able to find from all
16.		relevant Battell-Geneva projects. There is only
17		one relevant Geneva project so far as I know and you
18		have information for everything.
19	DQ60	I'd like to call your attention again to the tele-
20		phone call between you and Dr. Hoegl in late 1972.
21		Am I correct, in concluding that during that tele-
22		phone conversation the work done by Xerox in 1963
23		and 1964, was discussed with Dr. Hoegl?

1		MR. WALSH: What is the basis
2		for that omission?
3		MR. HUNE: The other portions
4		of that document are not relevant to
5	7	the subject matter of the interference,
6		that is, the polyvinylcarbazole mix-
7		tures in the proportions that are
8		described in the count.
9		MR. WALSH: You are aware,
10		of course, that the court order says
11		not only relevant materials, but any-
12		thing reasonably calculated to lead
13		to relevant materials.
14		MR. HOME: That is correct.
15		I understand that.
16		MR. WALSH: You still say it
17	17.	is not relevant and you will not pro-
18		duce it?
19		MR. HONE: That's right, it
20		is not reasonably calculated to lead
21		to relevant materials.
22	DQ82 Could I ask y	ou, Dr. Weigl, to identify the recipients.
23	document 1, A	. Mahassel, could you identify him?
i		

1	A.	Certainly, patent manager in Rochester.
2	DQ83	J. Mammino?
3	. A.	He is one of the members of my group.
4	DQ84	That's right. A.G. Tweet?
5	Α.	I believe Dr. Tweet was my supervisor, at the time.
6	DQ85	W.W. Tyler?
7	A	I believe he was manager of the research laboratories
8		at the time.
9	DQ86	D.L. Stockman?
10	A	He was a research manager concerned with photocon-
11		ductors generally, at the time.
12	DQ87	Were all these men in Xerox in the United States?
13	Α.	Yes, sir.
14	DQ88	And, J.J. Ralabate I know as the Xerox patent
15		attorney?
16.	A	That's right.
17	DQ89	Do you know if Mr. Mahassel is a member of the New
18		York Bar?
19	A.	I can't answer that.
20	DQ90	Do you know if Mr. Ralabate is a member of the New
21		York Bar?
22		MR. KARAMBELAS: Mr. Mahassel
23		is not a member of the New York Bar,

11		
1	•	Mr. Ralatate is.
2	DQ91	Document 1-B, the name, J.Y. Irbilis, could you
3		identify that person?
4	A.	Same person as G. Salazny after her marriage. This
5		is her married name.
6	DQ92	She is a research worker in your group?
7	A	She specifically was a research aid during 1964, in
8.		my group.
9	DQ93	And, the other name, J. Erbauch?
10	A	J. Erbauch is a research manager, Xerox, Palo Alto
11		research center who I felt might possibly be interest-
12		ed.
13	DQ.94	May I ask you, what is the basis for the privilege
14		which you are alleging in regard to these documents,
15		specifically, document 1?
16		MR. HONE: The basis, Mr.
17		Walsh, is attorney-client communica-
18		tion, more specifically, a communica-
19		tion in response to an attorney re-
20	:	quest in connection with the legal
21		activitics of the attorney and, I
22		might add, that in addition to attorney-
23		client privilege which attaches to this,
	11	

### IN THE UNITED STATES PATENT OFFICE

1/3451A

Shattuck et al	)		· · · · · · · · · · · · · · · · · · ·	
v	)		Interference No.	98,047
Hoegl et al	)			

#### PRELIMINARY STATEMENT

- I, Helmut HOEGL along with Giacomo BARCHIETTO, declare that we are parties in the above-identified interference; that we made the invention set forth by the counts of the Interference; and that the invention set forth by the counts of the Interference was made by us as early as July, 1964, in Geneva, Switzerland; that
- 1) the invention was introduced into the United States as related to count 1 by written disclosure in a letter report No. 19, mailed August 24, 1964, and received in the United States on or about August 26, 1964, as evidenced by page 3 of said letter report attached hereto as Exhibit A, and as related to count 2 in letter report No. 21 mailed November 25, 1964, and received in the United States on or about November 27, 1964, as evidenced on pages 1 and 2 of said report attached hereto as Exhibit B.
- 2) The dates of reduction to practice in the United States are on or about August 25, 1954, as to count 1, and on or about November 27, 1954 as to count 2, the respective dates of reception for the written description of the reductions to practice in Geneva, Switzerland, embraced in letter reports Nos. 19 and 21 respectively.

3) If the allegations offered in 2) above are not found to be reductions to practice of the respective counts in the United States under law, then the date after conception of the invention when active exercise of reasonable diligence of reducing the invention to practice began was on or about August 26, 1964, and November 27, 1964, the reception dates of the respective letter reports Nos. 19 and 21.

We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or patent issuing thereon.

7. Moternatur 1972

Helmut HOEGE

Giacomo BARCHIETTO

Sworn before me at

Geneva, Switzerland,

this 716 day of

November, 1972

minnesm

THE SCUDY OF FUNDAMENTAL ASPECTS RELATED TO THE PHOTO-CREATION AND MODILITY OF FREE CHARGE CARRIERS IN CROANTS MATERIALS

Lotter-Report No. 21

to

Research & Engineering Center 800 Phillips Boad

> Webeter Now York, USA

> > Ly

Giacomo Barchietto, Helmut Hoegl, Adolf Steinemann and Demokos Tar.

This letter-report Caserlbes the week done during the month of butther lidge

The work would was concerned uninly with the following points:

- Propagation of hingly consitive by layers strongly absorbent in the UV and visible regions of the apectrum.
- Continuation of measurements of dys-sensitized PVK layers.
- Pluorescenco nonsuremento on various FVE films.
- Themoluminoucence measurements on pure TVK films.

# . 1. Et-bly coartified TVZ

As mentioned in our latest letter-report, No. 20, we have prepared double layers of both PVN and 2.4.7-trinitrofluoreness (MRF) (in lucite 2045 resin binder). These double layers showed very rapid photo-induced and slow dark decay. We observed that a recidual charge stoyed on the plates, and that the ansure of it depended on the thickness of the top lucite 2046 resin layer.

We made a number of emperiments to reduce the thickness of the Lucite top layer by the dip coating techniques. We found that the solvent removes too much of the base centing, and that it is too difficult to propare films of less than 10<sup>-4</sup> on thickness.

For those reasons, we next used the glou discharge polymerization process to evereent strongly deped FIX layers of about 5...6/2 thickness. We obtained very natiofactory results with this technique. Highly deped FIX layers that show too fact a dark discharge may thus be evereented with a very than insulating film, which reduces very effectively the dark discharge of the photosenductive layer; however, these layers are not sufficiently thick to cause significant residual charges upon illustration.

We made emperiments with two types of layers:

- PM + THP (1:1, molar vatio 6:5) and
- FVH + p-chlorenil [pd.1] (10:1, nolar ratio 15:1).

<sup>\*)</sup> see cog. J. Goodenn, J. Polymer Sef. MLIV, Insue 144 (1960), 991, and A. Bradley and J.P. Hannes, J. Micatrochem. Sec. 100 (1985), 190

These photoconductive layers were everseated with a polyner obtained by glow discharge polynerization of nethylmothnorylate. (Another experiment was made with othylsilicate, but the results with nethylmothnorylate were much better, olviously owing to much better insulating properties.)

Absorption and emission spectra of these photocenductive films were measured. Both the .VK/TWP and PVK/pOA layers are strongly absorbent between 550 and 800 m p, where pure IVK practically does not absorb at all. No fluorescence or phosphorescence was observed up to 700 m p.

Dark and photo-induced discharge characteristics were neacured.

As the decay of the voltage follows over a wide range that expected for chaic behavior, we have used the well-known equations for condensors to calculate the data listed in the following tables:

Enyor: PVK + THF (1:1), overcoated with glow discharge polymerical mothylmethacrylate. Sample 15. 50.

Thickness: 7.0 x 10"4 cm.

	Dark (D)	420 E A	Light 550 n/c	640 m/2
IL Light intensity (watt * cm-2) Fract.absorption A  til (see.), half-time  6 (sha-lca-1)  6 [  0 1 L  Cain	500 6 x 10 <sup>-16</sup>	8.3 = 10 <sup>-6</sup> 1 0.0 2 = 10 <sup>-13</sup> 3.5 = 10 <sup>7</sup> 0.037	4.15 = 10 <sup>-5</sup> 0.9 0.27 7 = 10 <sup>-13</sup> 2.7 = 10 <sup>7</sup> 0.06	4.35 = 10 <sup>-10</sup> 0.45 0.5 4 = 10 <sup>-13</sup> 1.4 = 10 <sup>7</sup> 0.044

2-1:30 5

hayer: PVH & pCA (1:1), overconted with glow discharge polymerical methylmethnorylate. Sample No. 51.
Thickness: 7.5 m 10-4.

	Durk (D)	360 n n !	14cht 775 7 At 1	500 n/n
I <sub>L</sub> Fract.cha. A t <sub>H</sub> (coa.)	206	7.5 × 10 <sup>-5</sup> 0.8 5.5	7.2 :: 10 <sup>-5</sup>	4.2 :: 10 <sup>-5</sup> 0.4 1.2
6(_N1cm-1)	1.7 × 10-15	5.3 = 10 <sup>-14</sup>	4 × 10 <sup>-14</sup>	1.5 = 20-2
6, 1, 1, 1, 1, 1, 1, 1, 1, 1, 1, 1, 1, 1,	-	4 = 105	3.7 × 205	2.1 × 10 <sup>4</sup>
Gain	•	0.0016	0.005	0.025

Those results show again what E. Lell and J. Weigh already have pointed out; namely, that THY is the best CT sensitizer found so far for FVH.

We believe that the process of overcoating organic photoconductive films with glow discharge polymerised thin films will be very useful. These top films can be used both to enhance the insulating properties of the base layers and act as protection against photo-chemical degradation.

## 2. Dyc-nonniticed PVK

We have continued absorption, emission, and electrostatic measurements on the corios of PVK layers constitued with increasing concentrations of Mile Dive A.

Those measurements are consulat complicated by the fact that the Cyc is used in form of its salt with sulfuric soid. IVE being a base, happen a refer turn that another to a complia cutest turn the release to the formed, and therefore the leucobase, when hile Blue A is added to FVE. Therefore, on sensitining PVE with hile blue A (or any other dye consistency), we have both the dye call and the leucobase to consider in

November 1, 1973

Anthony Karambelas, Egg.
Ralabate, Mahassel and Kondo
Xerox Corporation
Xerox Square
Rochester, New York 14603

Subject: Interference 98,047

Dear Tony:

I am writing to confirm and make of record our telephone conversation of this morning, in regard to the suggestion in my letter of October 16, 1973.

The party Hoogl et al declined the offer of the party Shattuck et al to pay the expenses of bringing Drn. Hoogl and Barchietto to the United States. The party Hoogl et al also declined to enter into a stipulation under Rule 284(e) so that the testimony of Dr. Hoogl and Dr. Barchietto could be taken orally in Europo.

Yours truly,

Joseph G. Walsh Attorney for the Party Shattuck et al

JGW: mm



# IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.

Movants,

: Patent Interference 98,047

HOEGL ET AL..

Respondents. :

.

# AFFIDAVIT OF CLYDE C. METZGER

STATE OF NEW YORK ) : ss.:

CLYDE C. METZGER, being duly sworn, deposes and says:

- 1. I am a member of the Bar of the State of New York, the Court of Appeals for the Second Circuit, and of the firm of Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, counsel for Movants, Meredith D: Shattuck and Ulo Vahtra ("Shattuck et al."), in the above-captioned action.
- 2. There is presently pending in the United States
  Patent Office a patent interference proceeding, No. 98,047, which
  was declared by the Patent Office on August 16, 1972 between
  Shattuck et al. and Hoegl et al.
- 3. The real parties in interest are International Business Machines Corporation ("IBM"), assignees of Shattuck et al., and Xerox Corporation ("Xerox"), assignees of Hoegl et al.
- 4. This affidavit is made in support of Movants'
  Request For An Order To Show Cause Why The Witness Weigl Should
  Not Be Compelled To Produce Allegedly Privileged Documents.
- 5. The party Shattuck et al. makes this request for an Order To Show Cause because its time for taking the testimony in this interference is presently set to expire on April 24, 1974

and although an extension has been applied for, it is not certain how much time will be granted by the Patent Office. In any event, time is clearly of the essence in connection with Shattuck et al.'s diligent completion of testimony in the interference.

- 6. On information and belief, the following documents, annexed to the Memorandum submitted herewith in support of the above Request For Order are true and correct copies of the originals thereof:
  - Exhibit A Court Order of March 26, 1974 Compelling The Witness Weigl To Produce Documents And To Answer The Questions Propounded To Him.
  - Exhibit B Copies of Transcript Pages 7, 14, 15, 26, 27, 45, and 46 from the deposition of John W. Weigl.
  - Exhibit C Relevant portions of the Hoegl et al. Preliminary Statement in this Interference No. 98,047.
  - Exhibit D Letter dated November 1, 1973 from Joseph G. Walsh, Esq., attorney for the party Shattuck et al. to Anthony Karambelas, Esq., attorney for the party Hoegl et al.

alycle C. Metoffer

Subscribed and sworn to before me this 15th day of April 1974.

Notary Public

BERTHA S. LEVONAS NOTASY PUBLIC, Cate of New York No. 41 2000183 Queens County Cart, Not in New York County Team English March 00, 1975

#### ITEM No. 5

# IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.,

Movants,

v. : Patent Interference 98,047

HOEGL ET AL.,

Respondents. :

MEMORANDUM OF HOEGL ET AL IN OPPOSITION TO THE SHATTUCK ET AL REQUEST FOR A SHOW CAUSE ORDER

### I. INTRODUCTION

Shattuck et al seek an order for the production of three documents from the files of Dr. Weigl as to which Hoegl et al claim attorney-client privilege and attorney-work product. As shown herein, production of those documents should not be required because:

- the documents being sought are privileged and also constitute attorney-work product;
- (2) Shattuck et al have not established any basis for a charge of fraud;
- (3) even if the documents were produced they could have no bearing whatsoever on Shattuck's charges of fraud;
- (4) Shattuck et al have already been provided with all of the factual information contained in the documents;
- (5) Shattuck's arguments regarding the content of the documents are based upon misstatements of the facts.

### II. BACKGROUND

At his deposition on February 20, 1974, Dr. John W. Weigl, a Xerox research scientist, was instructed not to answer certain questions or to produce certain documents from his files relating to activities other than those of the inventors, Hoegl and Barchietto, a party to this interference, regarding the subject matter of the interference count. These refusals to testify or produce documents were based upon the confidentiality of the information and the lack of relevance to the subject matter of the interference of any activities by Xerox employees which were unrelated to the invention of the subject matter by the inventors, Hoegl and Barchietto. No question of privilege was raised at that time because no privileged documents were known to exist in Dr. Weigl's files.

On March 26, 1974, following briefing and oral argument of a Motion Under Rule 37, this Court ruled that the asserted lack of relevance did not provide a basis for the refusals to produce and testify, and ordered Dr. Weigl to appear for his deposition on April 5, 1974, and answer the questions and produce the documents which had been withheld previously.

Pursuant to this Court's Order, Dr. Weigl did appear on April 5, 1974 and produced from his files the contemporaneous records and documents relating to work done within the scope of the count. He also testified fully with respect to the content of those documents, not only on April 5, but also at the continuation of his deposition on April 23, describing the work which was done at Xerox within the scope of the interference count as represented by the documents.

During the review of Dr. Weigl's files in response to this Court's Order, certain documents were found which were prepared by Dr. Weigl or under his supervision during March and April, 1970, pursuant to a request by Xerox attorneys in connection with the preparation for this interference. At the Weigl deposition of April 5, a claim of privilege and work product was made with respect to those documents and a list of the documents was prepared and given to counsel for Shattuck et al. Shattuck et al now seeks the production of those documents.

### III. THE EARLY EXPERIMENTAL WORK AT XEROX

In late 1963 and early 1964, as described in Dr. Weigl's latest deposition, Xerox was seeking a transparent, selfsupporting photoconductive insulator for use in the preparation of microfilm records. As one part of a larger study of many materials for use in that application, various mixtures of PVK and TNF were prepared and tested. On two occasions, once on Cctober 29 & 30, 1963 and later on April 23 & 24, 1964, xerographic plates containing a range of PVK-TNF mixtures passing through the 1 to 1 proportion comprising the subject matter of this interference was prepared and tested by a research aide, Gail Salasny, under the direction of Mr. Joseph Mammino. The results of those experiments are summarized at pages 19 and 20 of a report issued on August 15, 964 by Mr. Mammino and Miss Salasny (using her married name, Jvirblis) which has been marked as Shattuck et al Exhibit 46, a copy of which is attached hereto as Exhibit A.

Contrary to the assertion at page 5 of the Shattuck et al memorandum in connection with this Show Cause Order, the early

Xerox experimental work with PVK and TNF is obviously not the Lell and Weigl work referred to in the document attached to the Hoegl et al Preliminary Statement. In fact, Dr. Lell was never involved in the preparation of any plates containing PVK and TNF in a 1 to 1 ratio.

As described at pages 19 and 20 of Shattuck et al Exhibit 46, the results of the PVK-TNF experiments conducted at Xerox showed that:

"As the concentration of TNF in PVK was increased up to 50 wt.% TNF, the color of the layers changed from light buff (at 2 wt.% TNF) to dark amber at 50 wt.% TNF."

Such dark amber layers are unusable for applications requiring a transparent photoconductor. Consequently, the conclusion was expressed in that report that:

"Optimum sensitization of PVK layers was achieved with 20 wt.% TNF."

Dr. Weigl has pointed out that the PVK-TNF experiments by Mammino and Salasny, and particularly those involving the 1 to 1 proportion, were not considered to be an invention by Mammino and Salasny, or by anyone elso who was aware of them at that time, and that no patent application directed to that work was ever filed.

The law is clearly established that no event or activity can constitute an invention unless the participants recognize it as an invention. This rule was well summarized in the recent decision of Langer v. Kaufman, 465 F2d 915 (CCPA, 1972), where it was asserted that the preparation of a particular form of the compound TiCl<sub>3</sub>, within the scope of the interference count, constituted an invention of the subject

matter of the count. In holding that there was no invention because the material, even though prepared, was not recognized as an invention by the alleged inventor, the court stated (at 919 and 920):

"We agree with the conclusion of the board and appellees' contention that Heard v. Burton, 333 F.2d 239, 51 CCPA 1502 (1964), is controlling. In Heard, this court held that conception and reduction to practice could not be established nunc pro tunc. Although appellants in Heard had in fact prepared the new form of alumina catalyst involved in that case, there was no evidence of contemporaneous recognition that a new form has been discovered. Like the TiCl<sub>3</sub> catalyst of the present appeal, the new 'eta' form of alumina catalyst was not known in the art until after the date to which the other party to the interference was entitled. The import of the court's holding is clear from the following:

"[W]e sustain the board since we are not convinced Heard had such a 'definite and permanent idea of the complete and operative invention' [citation omitted] as to constitute conception within the meaning of the patent law. \* \*

"We agree with appellees that this case is controlled by the precedents holding nunc pro tunc reduction to practice to be defective. As appellees say in their brief, '\* \* 'In the present case it is the recognition and appreciation of the invention which was lacking to Dr. Heard prior to April 23, 1952 [appellees' filing date], and which Heard attempts now to provide by his later tests and acts after that date.'

"In the present case, while the interpretation of the X-ray diffraction patterns at trial does show that appellants did in fact prepare the gamma form, it is not evidence "of appreciation at the time those patterns were generated that any new form had been made. All the other evidence is to the contrary. We conclude that there was no conception by appellants at the alleged point in time."

Since none of the individuals having knowledge of the PVK-TNF experiments conducted at Xerox in 1963 and 1964 even considered the plates made with 1 to 1 proportions to be useful, much less inventive, there was clearly no prior invention of that subject matter at Xerox and the work done by Mammino and Salasny could not possibly constitute prior art to Hoegl and Barchietto. There was, therefore, no "withholding of material facts from the Patent Office" as erroneously contended at page 3 of the Shattuck et al memorandum.

## IV. THE DOCUMENTS IN QUESTION

# A. Description of the Documents

Following issuance of the Shattuck et al patent involved in this interference, an investigation was conducted by Xerox attorneys to determine what action might be taken with respect to provoking an interference with that patent in order to challenge IBM's claim to the patented subject matter. As a part of that investigation, Dr. Weigl was requested by Xerox attorneys in March, 1970, to review any records of work relating to PVK-TNF mixtures and transmit information to the Xerox attorneys regarding that work for their consideration. Dr. Weigl, in turn, asked Mr. Mammino to prepare an appropriate summary of the PVK-TNF work referred to above and Mr. Mammino did so in the form of an "Invention Record" dated March 26, 1970 (Document la in the list of privileged documents) which he

addressed to Dr. Weigl for transmittal to the attorneys who has requested it. In Dr. Weigl's deposition, he has described a Xerox "Invention Record" as a summary of activities which a research worker at Xerox wishes to call to the attention of Xerox attorneys to be considered for appropriate legal action.

By a memorandum dated April 2, 1970 (Document 1 in the list of privileged documents), Dr. Weigl forwarded the Mammino "Invention Record" to Mr. Mahassel, one of the attorneys in the Xerox Patent Department who had requested the information from Dr. Weigl, and provided Mr. Mahassel with his comments which he believed would be helpful to the review and evaluation of that material by the Xerox attorneys. To provide the Xerox attorneys with all of the information at his disposal which might be helpful in their evaluation, Dr. Weigl, at the same time, submitted to Mr. Mahassel a memorandum providing information and comments about the work at Battelle in Geneva by Dr. Hoegl and Dr. Barchietto on heavily doped PVK (Document 1c in the list of privileged documents). All of the recipients of these documents were either attorneys or Xerox managers having an interest in the matter, or supporting the investigation being conducted by the Xerox attorneys.

# B. The Documents Are Protected From Discovery

It is well established that communications submitted to an attorney for his use in connection with the prosecution of patent applications or interferences may be privileged as are the opinions or conclusions prepared by an attorney in connection with such work. In Beckman Instruments, Inc. v. Technical Development Corp., 172 U.S.P.Q. 642 (D.C. N.D. III., E. Div. 1972),

for example, the court refused to hold that a draft patent application and related correspondence transmitted to an attorney by an inventor for use in connection with patent application work were not privileged. Similarly here, the Weigl memoranda, including the Mammino "Invention Record", are privileged communications and are not subject to discovery by Shattuck et al.

Furthermore, any documents which are prepared by or at the request of an attorney for his use in connection with the preparation for, or the conduct of, a litigated matter constitute attorney-work product and are not subject to discovery if the factual information contained in those documents is otherwise available. Moreover, that rule applies to documents prepared in connection with an interference in the Patent Office, Sperry Rand Corp. v. International Business Machines, 159 U.S.P.Q. 86 (D.C. Del. 1968), Natta et al v. Zletz et al, 163 U.S.P.A. 675, (7 Cir. 1969), Natta et al v. E. I. du Pont de Nemours & Co., 161 U.S.P.Q. 389 (3 Cir. 1969). All of the original contemporaneous records referred to in these privileged memoranda which describe or relate to the subject matter of the count of this interference have already been produced to the party Shattuck et al in the interference. The privileged documents do refer to work with materials other than PVK and TNF, and also contain analyses of the information for the benefit of the attorneys, as well as speculation regarding possible attorney conclusions, but no factual information regarding any PVK-TNF work, which is not already in the presession of Shattuck et al, could be obtained from those documents. Consequently, they are immune from discovery.

In addition, a party charging "fraud" on the Patent

Office must make out a prima facie case of fraud before defeating a claim of privilege or work product with respect to such documents, Natta et al v. Zletz et al, supra. As pointed out herein, Shattuck et al has not made out any prima facie case of fraud.

V. SHATTUCK ET AL HAVE NOT MADE OUT A PRIMA FACIE CASE, OR EVEN ESTABLISHED ANY FOUNDATION FOR A CHARGE OF FRAUD

It is asserted by Shattuck et al (Memorandum, page 5) that "The Hoegl Et Al. Preliminary Statement and CIP Application Are Tainted With Fraud", and in that section of its Memorandum, Shattuck et al place the entire foundation for the Show Cause Order Request on the assertion that:

". . . a prima facie showing has been made that fraud has been perpetrated in connection with the filing of the Preliminary Statement, as well as the filing of the Hoegl et al. CIP application."

Those statements are demonstrably false.

#### A. The Preliminary Statement

In their Preliminary Statement, a copy of which is appended hereto as Exhibit B, Hoegl and Barchietto alleged only that "the invention set forth by the counts of the Interference was made by us as early as July, 1964; in Geneva, Switzerland".

Nowhere do the inventors state that they were "the true inventors" as contended at page 2 of the Shattuck Memorandum.

To establish a prime facie showing, or even provide a semblance of support for a charge of fraud with respect to the Preliminary Statement, there must be substantial evidence tending to show that Hoegl and Barchietto:

(a) did not make the invention of the counts at all, and

(b) knew they did not make that invention when they signed the Preliminary Statement.

There is no such evidence and Shattuck et al does not even assert there is any. Instead, Shattuck et al seek only to show knowledge by Hoegl and Barchietto of prior invention by another in support of the fraud claim with respect to the Preliminary Statement. But mere evidence of prior invention of the same subject matter by another, and even complete knowledge by Hoegl and Barchietto of such prior invention would be useless in attempting to establish fraud with respect to the Preliminary Statement since no allegation was made in that Statement that Hoegl and Barchietto believed themselves to the first inventors of the subject matter.

In connection with the Preliminary Statement, Shattuck et al has not, and cannot, make out a prima facie case of fraud in the absence of evidence tending to show that Hoegl and Barchietto never made the invention at all (which has not even been suggested by Shattuck et al), and that they knew that they did not make the invention (which cannot be established through testimony or documents of others relating to other events than the making of the invention by Hoegl and Barchietto).

Shattuck et al has utterly failed to provide foundation for this charge.

## B. The CIP Declaration

In the Declaration filed by Hoegl and Barchietto in the CIP application, a copy of which is appended hereto as Exhibit C, they stated "We verily believe that we are the original, first and joint inventors of the invention (comprising

1 to 1 PVK-TNF)". A prima facie showing of fraud with respect to that statement must at least be accompanied by evidence that

- (a) there was work done prior to the actual invention date of Hoegl and Barchietto which legally constituted a prior invention of the same subject matter, and
- (b) Hoegl and Barchietto knew of the prior work as prior invention of the same subject matter when they signed the CIP Declaration.

As pointed out above, the experimental work done at Xerox and described in the documents produced from the Weigl files did not and could not constitute an invention of the subject matter of the interference counts since the conclusion of the workers and others at the time was that the best proportion of TNF in PVK was 20% and not 50% or a 1 to 1 proportion (see Exhibit A hereto). The best that can be said for the work done at that time with a 1 to 1 mixture of PVK and TNF is that it constitutes an abandoned experiment since no patent application was ever filed claiming that that work constituted an invention.

Because there was no prior invention of the subject matter, Hoegl and Barchietto could not have made an incorrect statement in their CIP Declaration. Therefore, Shattuck et al has also failed to provide any foundation for this charge of fraud.

Furthermore, even if there had been a prior invention of the same subject matter, an allegation of fraud could only be supported by a showing that Hoegl and Barchietto did not "verily believe" that they were the first inventors. Their state of mind at that time can only be shown by their own testimony or

contemporaneous documents and could not possibly be established by documents prepared at Xerox by others at an earlier date, i.e., the Weigl file documents as to which privilege is claimed.

In Langer v. Kaufman, supra, a charge of fraud was based on the assertion that the oath in a continuing application, which stated:

"This application discloses and claims only subject matter disclosed in their pending application, Serial No. 662,017...".

was false. After noting that there were differences between the disclosures in the parent and continuing application, which were not material to the allowability of the claim, the Court stated (at p. 922):

"For the reasons given, we at least doubt that the '082 oath is false, but in any event, we find no basis for concluding that appellees have exhibited any misconduct before the Patent Office."

# C. Shattuck Et Al Have No Substantial Need Of The Documents

With respect to the belief of Hoegl and Barchietto when they signed the CIP Declaration, the statements by Shattuck et al at page 9 of the Memorandum that Xerox (a) refused to produce Hoegl and Barchietto for their testimony in the United States and (b) refused to enter into a stipulation under Patent Office Rule 284(e) permitting the taking of testimony of Hoegl and Barchietto in Europe are misstatements. In response to IBM's request that Xerox produce the witnesses for their testimony in this country, IBM was advised that Xerox has no control over the inventors, Hoegl and Barchietto, and cannot compel them to appear in this country for the taking of their testimony. Moreover, Xerox pointed out to IBM in response to the second request, that no stipulation under Rule 284(e) is appropriate until a motion filed under Rule 284(a) has been granted and a schedule

set in accordance with Rule 284(c). IBM never filed any such motion.

As has already been pointed out to Shattuck et al during the course of the Weigl deposition, the party Hoegl et al currently intends to take the testimony of Drs. Hoegl and Barchietto in connection with this interference and will serve the appropriate notice on the attorneys for Shattuck et al so that they can attend and cross-examine those witnesses.

There is, therefore, no basis for any claim by Shattuck et al that they must obtain access to privileged and work product documents in order to obtain facts relating to the state of mind of Hoegl and Barchietto at the time they signed the CIP Declaration.

VI. THERE IS NO FRAUD OR IMPROPRIETY IN
ADDING CLAIMS TO AN APPLICATION IN AN
ATTEMPT TO DOMINATE THE KNOWN USE OF
THE CLAIMED SUBJECT MATTER BY ANOTHER PARTY

At page 4 of their Memorandum, and again at page 10, Shattuck et al imply that there is an impropriety in the filing of a second application by Hoegl et al and the assertion of claims therein which are intended to dominate the subject matter of the Shattuck et al patent which had issued prior to the filing of the second Hoegl et al application. The law, however, is to the contrary. It is well established that an applicant for patent may at any time during the prosecution of the application add new claims to the application which take the original filing date of the application as long as they are supported by the disclosure of the application. As pointed out in General Tire & Rubber Co. v. Jefferson Chemical Co., Inc., 363 F. Supp. 871 (S.D.N.Y. 1973):

"The rules of the Patent Office provide for 'cancelling particular claims' and 'presenting new claims' (Patent Office Rule 119). These claims, when allowed, take the original filing date of the application, even where there has been an intervening purise use before the amendment has been made. See Coats Loaders & Stackers, Inc. v. Henderson, 233 F. 2d 915, 924 (6th Cir. 1956); King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc., 354 F. 2d 533, 539 (10th Cir. 1965). Moreover, the law seems settled in the absence of some countervailing showing not made here, that the effective date of the claims of the continuous applications are those of the original application."

Accord: Bolt Associates Inc. v. Rix Industries, \_\_\_\_\_\_F. Supp. \_\_\_\_\_(N.D. Cal. 1973), 178 U.S.P.A. 171, 173; Azoplate Corp. v. Silverlith Inc., 367 F. Supp. 711, 731-732 (D. Del 1973), 180 U.S.P.Q. 616, 631. Contrary to the assertion at page 6 of the Shattuck et al Memorandum, the very purpose of Rule 216 and the other Patent Office rules relating to interferences is to permit an applicant to amend his application so as to contest priority of invention with another applicant or patentee. Accordingly, Hoegl and Barchietto were fully authorized by law to file their CIP application for the purpose of contesting priority of invention of the count of this interference and the Patent Office has ruled that the original Hoegl and Barchietto application properly supports that count.

#### VII. CONCLUSION

For the reasons set forth above, the documents sought by Shattuck et al are privileged attorney communications and constitute attorney-work product. Moreover, Shattuck et al have not established a prima facie showing of fraud or even a semblance of support for the charge of fraud. Even if the

privileged documents were produced, they could not provide Shattuck et al with any further information with respect to the alleged basis for Shattuck et al's charge of fraud. Consequently, the Court should not require production of the privileged documents to Shattuck et al.

Respectfully submitted,

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

Dated: April 30, 1974

Francis J. Hone Attorneys for Hoegl et al 30 Rockefeller Plaza New York, New York 10020 (Tel. No. 212-489-3326)

#### Of Counsel:

Elliott Horton, Esq. Harris, Beach & Wilcox 2 State Street Rochester, New York 14614 Tel. (716) 232-4440

Ronald B. Hildreth, Esq. Brumbaugh, Graves, Donohue & Raymond 30 Rockefeller Plaza New York, New York 10020

Anthony W. Karambelas, Esq. Xerox Corporation Xerox Square Rochester, New York 14644

Statut dal & 46

XEROX RESEARCH AND ENGINEERING DIVISION

RESEARCH LABORATORIES REPORT NO. RL64-45

DYE AND CHARGE TRANSFER SENSITIZATION
OF SOME

POLYMERIC ORGANIC PHOTOCONDUCTORS
PROPERTY OF XEROX CORPORATION
Project 532412
(Program 53)

by

J. Mammino and G. Jvirblis Imaging Materials Department

August 15, 1964

XEROX

# 4. PVK Layers Sensitized with Varying Concentrations of Trinitrofluorenone

Optimum concentration of TNF in PVK was determined.

Sensitized layers of five to ten micron thickness were prepared on an aluminum substrate, dried, dark rested for 24 hours and electrometer evaluated as described. The data are summarized in Table III.

Optimum sensitization of PVK layers was achieved with 20 wt.% TNF. When the concentration of TNF in PVK was about 10 wt.% or less, the layers accepted positive corona charging more readily than negative charging. Above 20 wt.% TNF in PVK the layers accepted negative charges better than positive charges. Charge acceptance of the layers was fairly constant up to about 20 wt.% TNF in PVK. As the concentration of TNF was increased above this amount the charge acceptance of the layers decreased.

As the concentration of TNF in PVK was increased up to 50 wt.% TNF, the color of the layers changed from light buff (at 2 wt.% TNF) to dark amber at 50 wt.% TNF. As the concentration of TNF increased above 50 wt.% the color of layers lightened, possibly because the layer crystallizes at about 60 wt.% TNF in PVK.

TABLE 111.

CONCENTRATION STUDY OF THE IN TVK LAYERS

Notebook Reference	Material	rotmataere	nitial Potential, (volta)	Light dv/dt Discharge (volts/sec)	Discharge	Residual Potential @ 15 sec (volts)	Illumination Level (ft-candles @ 2800° K)	Seneitiv- ity (volte/fce)
1726-82	27 TNF 982 PVK (5 μ)	•	+390 -80	227 33,3	10.7	3	. 23.5	1:3
	5% THE 95% PVK	• •	+350	387 66.7	11:4	3	23.5	16.0
1726-90	10% TNF 90% PVK (5 µ)	General - 1g PVK (Rorden MP700-18) 10Z solution in benzenc was added to the corresponding amount of TNF (Eastern) dissol ed 1 g/15 ml in toluene	+210 -210	8.0	1.8	130	0.0633	98.0
	20% THF 80% PVK (10 µ)		+330	19.6 26.7	3.7	150 130	:	270 370 .
	30% THE 70% PVK (10-15 µ		+170 -190	13.3	0.5	65 70	:	170 250 240
	40% TNF 60% PVK (5 μ)	•	+190 -220	17.6 22.2	1.0	55 60	::	340
	50% TNF 50% PVK (10 µ)	•	+190 -210		2:1	50 30	:	400
	60% THF 40% PVK (5 µ)		+110		5.9 2.2	10 25	:	100
	707 THF 307 PVK (3 µ)	•	+130 -175	10.0	1:8	25 40	:	200

T. Mukerjee<sup>6</sup> has investigated xerographic response versus wavelength for PVK layers containing 20 wt.% TNF; highest quantum yield obtained was about 0.1 at  $\lambda$  = 4000 Å.

#### IN THE UNITED STATES PATEM OFFICE

d/3451A

Shattuck et al	)			
v	)	1. 184	Interference No	. 98,047
Hoesl ct al	)			

#### PRELIMINARY STATEMENT

I, Helmut HOEGL along with Giacomo BARCHIETTO, declare that we are parties in the above-identified interference; that we made the invention set forth by the counts of the Interference; and that the invention set forth by the counts of the Interference was made by us as early as July, 1964, in Geneva, Switzerland; that

- 1) the invention was introduced into the United States as related to count 1 by written disclosure in a letter report No. 19, mailed August 24, 1964, and received in the United States on or about August 26, 1964, as evidenced by page 3 of said letter report attached hereto as Exhibit A, and as related to count 2 in letter report No. 21 mailed November 25, 1964, and received in the United States on or about November 27, 1964, as evidenced on pages 1 and 2 of said report attached hereto as Exhibit B.
- 2) The dates of reduction to practice in the United States are on or about August 25, 1954, as to count 1, and on or about November 27, 1954 as to count 2, the respective dates of reception for the written description of the reductions to practice in Geneva, Switzerland, embraced in letter reports Nos. 19 and 21 respectively.

3) If the allegations offered in 2) above are not found to be reductions to practice of the respective counts in the United States under law, then the date after conception of the invention when active exercise of reasonable diligence of reducing the invention to practice began was on or about August 25, 1964, and November 27, 1964, the reception dates of the respective letter reports Nos. 19 and 21.

We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may Jeopardize the validity of the application or patent issuing thereon.

7.117-211-1-1972 Date

Helmut HOEGL

Fisione Barchietto

· Helmer book

Sworn before me at

Geneva, Switzerland,

this 71/2 day of

November, 1972

milleza



76.3	DECLARAT	POWER	OF ATTORNE	Y. ARD STATE	ron -	
Trans.	201	13	0.2	A No		7.5
We, _	TIETWAL TIC	origin and co	ACOMO BARCH.	LETTO THE		
The state of the s						
					, decl	are
that we a	citizens of	GERMANY	and ITAIN.	respectively	•	1.
				, residi	ng at _GRAND-LAN	CY/
201	261		160 -1			
Geneva	(Switzerland)	and Busto Ars	izio (Italy)			
3. 11 2			,			
			<del></del>		that we	have
read the for	regoing speci	fication a	nd claims a	nd we verily	believe that w	0 250
* J	, , , , , , , , , , , ,	,		in the verify	Device char w	e ale
the origina	l, first and	joint inver	ntors of the	invention	in	31
10 + 11 + 15	ELECTROPHOTO	GRAPHIC PL	MTE - D/345	1	described	and
27.7	1.55 4					
claimed in	the foregoing	specifica	tion; that	this applica	tion in part di	scloses
ind claims	subject matte	r disclose	d in our ear	clier filed	pending applica	tion,
	510.001				***	
erial No.	519,081	filed	January 6,	1966	; that, as to	0
bo subject	mathan of th	,				7.4.2
upplication	matter of th	is applica	tion which	is common to	said earlier	
ir used before	ore our inven	tion there	not believe	e that the s	ame was ever knownibed in any pr	own
publication	in any count	ry before	our inventi	the thereof	or more than on	inted
'ear prior	to said earli	er applicat	tion: or in	nublic use	or on sale in the	e ;
Inited State	es more than	one year p	rior to said	learlier ap	plication; that	1
aid common	subject matt	er was not	patented by	efore the da	te of said earl	ier
pplication	in any count	ry foreign	to the Unit	ted States.	on an application	05
iled by us	or our legal	representa	atives or as	ssigns more	than twelve mon	ths
efore said	earlier appl	ication; th	nat, as to	the subject i	matter of this	
pplication	which is not	common to	said earlie	er application	on, we do not k	ncw
nd do not h	believe that	the same wa	as ever know	m or used b	efore our inven	tion
hereof, or	patented or	described :	in any print	ted publicat	ion in any coun	try .
erore our	invention the	reof or mon	e than one	year prior	to this applica	tion,
r in public	c use or on s	ale in the	United Stat	tes more than	n one year prio	r. "
o this app.	lication; tha	t said sub	ject matter	was not pate	ented in any	
enresentati	ives or assign	nited State	es on an app	olication fi	led by us or our	r legal
hat no ann	lication for	natent on	the non-com	onths before	this application	or.;
hyention ha	as been filed	by us or	our legal re	nresentative	matter of this es or assigns in	
ny country	foreign to t	he United	States more	than twelve	months before	.1
his applica	ation, except	as follows	3:	c.idit c./cive	montens perore	
		,	-			
Water to the same	. 7/ .	:				
and the same					•	
nd that the	e earliest ap	plication !	for patent of	on this inver	ntion that has	
een filed b	by us or our	legal repre	esentatives	or assigns	in any country	
areign to t	the United St	atos and :	alain for	the muiturit.	6 . 4 1 -4 1 -	

claim for the priority of which is ade under 35 U.S.C. 119, is as follows:

10. 51 And we hereby appoint James J. Ralabate, Registration No. 19,211; Lbert Manassel Registration No. 19,064; Peter H. Kondo Registration No. 19,064; Pegistration No. 19,064; Peter H. Kondo Registration No. 19,064; Peter H. Registration No. 19,064; Peter H. Reg Registration No. , all Exerox Corporation, Xerox Square, Rochester, New York, 14603 our attorneys prosecute this application and to transact all business in the Patent Effice connected thorowith. All correspondence is to be held with James J. labate.

Wherefore we pray that Letters Patent be granted us for the invention discovery described and claimed in the foregoing specification and claims, id we hereby subscribe our names to the foregoing specification and claims, sclaration, power of attorney, and this petition.

The undersigned per tioners declare further true all statements made excin of their own knowledge are true and that all statements made on aformation and belief are believed to be true; and further that these tatements were made with the knowledge that willful false statements and he like so made are punishable by fine or imprisonment, or both, under ection 1001 of Title 18 of the United States Code and such willful false tatements may jeopardize the validity of the application or any patent ssuing thereon.  Inventor  First Name  Middle Initial  Last Name	は、一般など
<b>整</b> 种型的可能性,我们就是一个人的,但是一个人的,我们就是一个人的,我们就是一个人的。""我们就是一个人的,我们就是一个人的。""我们就是一个人的,我们就是一个人	
Post Office Address 25, chem. des Palettes, 1212 GRAND-LANCY/GENEVA (Switzerland)	
Date Dec. 23, 1970	
Inventor Karous Brucketh	٠.
Inventor   Manage   Middle Initial   Last Name	•
First Name Middle Initial / Last Name	•
First Name Middle Initial / Last Name Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)	
First Name Middle Initial / Last Name	
First Name Middle Initial Last Name  Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)  Date Dec. 19, 1970	
First Name Middle Initial Last Name  Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)  Date 19, 1970	
First Name Middle Initial Last Name  Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)  Date Dec. 19, 1970	
First Name Middle Initial Last Name  Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)  Date Sec. 19, 1970  Inventor First Name Middle Initial Last Name	
First Name Middle Initial Last Name  Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)  Date 19, 1970	

A-73 ITEM No. 6

# UNITED STATES OF AMERICA IN THE DISTRICT COURT OF THE UNITED STATES FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK, et al,

Movants,

- vs 
HOEGL, et al,

Respondents.

)

Advants,

Patent Interference
No. 98,047

Transcript of proceedings had in the above-entitled cause of action, before the HON. HAROLD P. BURKE, United States District Judge in the United States District Court, Rochester, New York, on Tuesday, April 30, 1974.

#### APPEARANCES:

MESSRS. WISER, SHAW, FREEMAN, VanGRAAFEILAND, HARTER and SECREST, ESQS.
(By William H. Helferich III, Esq.)
700 Midtown Tower
Rochester, New York 14604

MESSRS, PENNIE, EDMONDS, MORTON, TAYLOR AND ADAMS, ESQS.
(By Robert J. Kadel, Esq.)
330 Madison Avenue
New York, New York 10017

JOSEPH G. WALSH, ESQ. International Business Machines Corporation Monterey & Cottle Roads San Jose, California 95114

Appearing on behalf of the Movants.

# APPEARANCES: (Continuing)

MESSRS. BRUMBAUGH, GRAVES, DONOHUE AND RAYMOND, ESQS. (Ey Francis S. Hone, Esq.)
30 Rockefeller Plaza
New York, New York 10020

MESSRS. HARRIS, BEACH AND WILCOX, ESQS. (By Elliott Horton, Esq.) 2 State Street Rochester, New York 14614

MESSRS. PARIS, HASKELL AND LEVINE (By Boris Haskell, Esq.) 1232 Pennsylvania Building Washington, D.C. 20004

\_ and \_

ANTHONY L. KARAMBELAS, ESQ. Xerox Corporation Xerox Squere Rochester, New York 14604

Appearing on behalf of the Respondents.

Rochester, New York

Tuesday, April 30, 1974

10:00 o'clock A.M.

MR. WALSH: Your Honor, I am Joseph Walsh, appearing for the Party Shattuck, et al, which is to say IBM, the real party in interest.

With the Court's permission I will hand you a supplemental memorandum in support of our motion for an order to show cause. The supplemental memorandum was made necessary by additional facts elicited during depositions taken on Wednesday of last week, the day after I handed your Honor the original request for an order to show cause.

First of all, your Honor, I want to thank you for again rearranging your schedule to hear us.

THE COURT: All right.

MR. WALSH: Also, I wish to thank your Honor for the original order

compelling testimony. We have now uncovered a large number of additional facts which I submit clearly supports the present request for an additional order. In brief, your Honor, we have now proved conclusively that on May 5, 1964 Joseph Mammino, a research man working under the direction of Dr. Weigl at Xerox here in Rochester, made the invention which is the subject of the count of this interference. Specifically in May of 1964 Mr. Mammino made a composition containing equal weights of the chemicals TNF and PVK. With that composition he made an electrophotographic plate. With that electrophogoraphic plate he made Xerox copies. Those copies were legible. Copies of those copies are in the attached memorandum. All of this work was known to the Xerox Patent Department. It was discussed in memoranda written in 1970.

Mr. Mammino submitted a request that his invention be considered for filing a patent application in 1970. A draft of

A revised draft of a patent application
was prepared but the application was not
filed. Instead, with full knowledge of
Mr. Mammino's prior work which they never
called to the attention of the Patent
Office and about which the Fatent Office
would never had known had it not been for
your Honor's order and they proceeded to
change drastically the apparent application of Hoegl and Barchietto. Their
filing of the Continuation-In-Part application was done with knowledge on the
part of the Xerox attorneys, the prior
work of Mr. Mammino in Dr. Weigl's group.

It is possible that by a logical deduction we can prove that at the time they signed this preliminary statement in November of 1972, Dr. Hoegl and Dr. Barchietto also must have known of this work. Some of the additional documents being wheeled under the alleged claim of privilege by the Party Hoegl et al include

on Exhibit 27 Document No. 3 and 4.

These are letters written respectively
by Hoegl and Barchietto and these letters
were written on September 14, 1972. And
these documents specifically refer to
work done by Mammino in the United States
before the alleged conception date that
they swore to in their Preliminary Statement.

proved a prima fasic case of fraud on the Patent Office and for this reason the attorney-client privilege, if it does in fact exist, and we don't admit it existed in regard to many of these documents, should be stricken. Specifically we ask only for a very narrowly defined range of documents. We ask only for documents written before the date of the Preliminary Statement which was November, 1972 and not only must the documents be written before that date but they must refer specifically to work done in the United

States before August 1, 1964, the alleged conception date.

These documents by the very meeting of these two requirements must be extremely pertinent, extremely relevant, extremely probative. We frankly feel they must well be dispositive of this entire interference. I feel that these remarks, together with the two memorands we have submitted, fairly present our case. If you have any questions I will be pleased to try to answer them.

THE COURT: All right.

MR. HONE: If your Honor please, I am Francis Hone, and I represent the Party Hoegl, et al in this Interference. With leave of the Court I should like to hand up a memorandum by Hoegl in opposition to the original memorandum of Shattuck.

Just five minutes ago I received a copy of the Supplemental Memorandum of Shattuck which raises issues which weren't before the Court in the first memorandum

filed by Shattuck, and with your Honor's permission I should like to file a response to this.

THE COURT: How long would that take?

MR. HONE: I would hope to get it before your Honor by Friday.

THE COURT: All right.

MR. HONE: Thank you very much, your Honor.

THE COURT: Are we all right with the Patent Office?

MR. WALSH: We hope so, sir, but
we can't be sure. The present date for
us to complete our testimony in view of
a second extension expires on May 15th.

THE COURT: That is plenty of time.

MR. WALSH: Thank you, your Honor.

MR. HONE: If your Honor please, I will address my remarks to the issue raised in the first Shattuck memorandum and in opposition thereto.

This attempt by Shattuck to obtain

privileged and work product documents
from the files of Dr. Weizl goes far
beyond the discovery which we submit
is appropriate or necessary to Shattuck
in this Interference.

Honor, the issue before the Court was whether documents relating to work done at Xerox, not by a party to this Interference but by somebody else, were relevant to the issue of this Interference and in response to Shattuck's motion the Court ordered Dr. Weigl to appear to answer questions and produce documents relating to this work done in connection with the subject matter of the Interference.

Pursuant to that order Dr. Weigl did appear and testified and he has testified twice now with respect to work done at Xerox in connection with the subject matter of the interference.

He also produced copies of all of the

documents relating to that work. Those documents refer to work done in 1963 and 1964 at Xerox, and the Exhibit A to the memorandum I have handed to your Honor this morning summarizes the result of that work. That is the document dated in August, 1964.

During the review of Dr. Weigh's
files to check the documents, it was
discovered that there were communications
by Dr. Weigh transmitted to attorneys
in response to requests by them for
information relating to such work. This
issue was not one before the Court the
last time we were here and during Dr.
Weigh's deposition we identified the
documents that constituted attorney
communications and claimed privilege and
work product for them.

The documents in question, your Honor, were prepared by Dr. Weigl and by his assistant, Mr. Mammino at the

request of Xerox attorneys, in order to prepare them for the possibility of an Interference in connection with that subject matter. They are directed to it and were transmitted to attorneys in connection with this investigation and were used by them in connection with the preparation for the Interference.

The documents in question refer to and describe the very same work as to which Dr. Weigl has testified extensively in his deposition and which is described in the original contemporaneous records produced to Shattuck, et al. They also include reference to other work not within the scope of this Interference and include commentaries and speculative conclusions by Dr. Weigl, prepared at the request of the attorneys and for the benefit of the attorneys to assist them.

Most important, your Monor, those documents do not contain any factual information relating to work done in

connection with the subject matter of this Interference which is not described in or contained in the original contemporaneous documents which have already been produced to Shattuck et al.

There is nothing that Shattuck could learn from those documents with respect to the facts of the work done at Xorox in connection with the subject matter of this Interference. Now Shattuck seeks to justify the demand for privilege and work products by charges of fraud, and charges that have no basis in fact and as to which Shattuck cannot even make any foundation, much less make out a prima facte case.

and Barchietto deliberately made false statements in the Preliminary Statement that they submitted to the Patent Office in connection with this Interference.

The Preliminary Statement, your Honor, is appended as Exhibit B to the memorandum I have handed up this morning.

How all that was alleged by Hoegl and Barchietto in that Freliminary Statement is that they made the invention in Geneva, Switzerland on or before July, 1964. They said nothing about what is the first invention. Contrery to the allegation of Shattuck, in Shattuck's memorandum they did not say they were the true inventors nor did they say they were the first inventors. To provide a foundation for a charge of fraud which is a very serious charge with respect to the Preliminary Statement Shattuck should have substantial evidence tending to show that Hoegl and Barchietto did not in fact make the invention; and second, that they knew at the time they signed their Freliminary Statement that they did not in fact make the invention, Whether the invention was made by somebody clse or whether they know the invention had been made by somebody else before or after their date of invention

Statement is irrelevant to the issue of fraud with respect to the Preliminary Statement because no such allegation is in the Preliminary Statement.

Shattuck does not even assert that it had such evidence of prior invention or knowledge -- I'm sorry -- of noninvention by Hoegl et al or knowledge of such non-invention. Instead, Shattuck is seeking to getting access to these Xerox documents prepared for and transmitted to attorneys which could not possibly support either of those statements. That is, nothing in the documents prepared at Xerox in 1970, six years after the events, ever referred to in the documents, could provide any basis for a charge by Shattuck that Hoegl and Barchietto did not make the invention when they said they did in 1964 or that they knew they did not make it when they signed the Preliminary Statement in 1972. Shattuck, therefore,

has not made out a prime facte case with respect to alleged fraud with respect to the Preliminary Statement.

Shattuck also charges that Hoogl and Barchietto made knowingly false statements in the declaration that they filed in the Patent Office in December, 1970 in connection with the Continuation-In-Part patent application involved in this Interference. In that declaration Hoegl and Barchietto stated they believed themselves to be the original first and joint inventors of the subject matter of that application which included a claim dominant to the subject matter of the Shattuck patent. To show fraud with respect to that statement it must be established that first Hoegl and Barchietto were not in fact the original first and joint inventors of the subject matter they claimed. And second, that they did not believe themselves to be such at the time they signed that statement.

The evidence that we have completely falled to show any prior invention of the subject matter by others either here or at Merox or anywhere else; and it also falled to show any knowledge by Hosgl and Barchistto of any such prior invention.

Now as is described in the memorandum I have handed up this morning, your
Honor, there was no prior invention of
the subject matter at Xerox for the
simple reason that those who did the
work involved and that constituted a
series of tests running through a range
of proportions of PVK and TNF, including
a specimen that had a one-to-one proportion. Those who did that work completely
failed to recognize any advantage whatsoever in the one-to-one proportion which
is the subject matter of the counts of
this Interference.

on that work which is appended as Exhibit
A is that the best formulation of PVK

and TNF was twenty parts TNF to eighty parts PVK, and not fifty or one-two-one as is required by the subject matter of this Interference.

Now the law is well settled, your lionor, that there can be no invention resulting from the preparation of a material unless it is recognized by those who prepared it on were aware of it at the time it is prepared that that subject matter constitutes an invention. And Langor against Kaufman, the very case cited by Shattuck et al —

THE COURT: Well, that is all covered in your memorandum, I suppose.

MR. HONE: It is, your Honor.

THE COURT: I haven't got much time to apend on the law here because you know I have interrupted a case to hear this.

MR. HONE: I'm sorry, your Honor.

That point is covered in the memorandum and we establish in the memorandum that

prior art with respect to this work at

Xerox and therefore it is impossible for

Hoegl and Barchietto to have made a mis
statement in their Continuation-In-Part

oath or to have known that they made

knowingly false statements at that time.

Furthermore, I submit, your Honor, the documents prepared at Xerox in April, 1970, could not in any way constitute evidence of the state of mind of Hoegl and Barchietto when they prepared the declaration in December, 1970. The only evidence of that could come from their own testimony or from contemporaneous documents prepared by them. Consequently, there is no basis whatscever for this charge of fraud by Shattuck.

Shattuck also has not shown any substantial need of these documents as is required pursuant to Rule 26(b), in order to obtain access to work product documents. On the contrary, Shattuck

has all the basic factual information relating to the work done at Nerox which is referred to in these documents. There is no reason why Shattuck needs access to these documents.

And finally, Shattuck contends that there is some impropriety in asserting claims by Hoegl at al which are intended to dominate the subject matter of the issued Shattuck patent. On the contrary, the very purpose of the Patent Office rules relating to interferences is to permit applicants to amend their applications so as to contest the claims of others with respect to subject matter they believe they have invented. There is nothing fraudulent or improper in the addition of the Shattuck claims or claims dominating the Shattuck claims to Hoegl et al application and Shattuck's attempt to make it appear improper is groundless. The Patent Office, and in fact the Commissioner of Patents has

ruled that Hoegl is entitled to make these claims.

In conclusion, therefore, your Honor, Shattuck's request for access to these documents must be denied for the following reasons: First, they are privileged and work product documents. Second, Shattuck has not shown any foundation for its charge of fraud with respect to this subject matter. Third, Shattuck has all of the factual information contained in the documents and therefore cannot show any need for access pursuant to Rule 26(b). And Fourth, even if Shattuck had the documents they could not be used to support the Shattuck fraud charges. I submit, your Honor, that Shattuck's request should be denied, Thank you.

MR. WALSH: Your Honor, if I may have a few brief minutes in reduttal?

THE COURT: All right.

MR. WALSH: Mr. Mone alleges that

Mammino of the value of his work. I submit this is clearly erroneous. The man submitted a request for a patent application to the Patent Department.

Two drafts of such an application were prepared. Those drafts are part of the documents we seek to obtain. Obviously, they are very, very pertinent, very informative.

On one point, I might almost agree with Mr. Hone. We really don't need them because I think we have already proved fraud. But obviously we can never have too much proof, so to have even more proof, I request these documents.

In Exhibit 27 handed to your Honor today you will see a list of documents which they allege are privileged. I call your particular attention again to Item NO. 3 and 4, memoranda written on September 14, 1972, one by Hoegl, one by Barchietto. These documents specifi-

cally refer to the prior work of Mammino, otherwise they wouldn't have been listed there. That was a list of documents which do refer to that work. Obviously if the men write memoranda referring to the work they must have known about it. These memoranda were written before they signed their Preliminary Statement. They were written before they signed their substitute declaration in March, 1973. That March, 1973 supplemental declaration specifically said they are the first inventor.

Mr. Hone seems to be basing some defense on the fact that the specific words "first inventor" aren't in the Preliminary Statement. For whatever comfort he can get from it, let him have it but they are in the substitute declaration which was signed.

I also further submit, your Honor,
that the fraud here was committed by
the Xerox Patent Department. With
knowledge of their work on which the men

had requested a patent application to

be filed on which they had made two

drafts of an application, with knowledge

of all that work done before, the work

in Switzerland, they allowed these state
ments to be signed by the people in

Switzerland and never called it to the

attention of the Patent Office.

I submit that the public interest demands a full disclosure of this. The only way to have the full disclosure is for your Honor to order production of these allegedly privileged documents.

Thank you, your Honor.

THE COURT: Are you going to have your brief by Friday?

MR. HONE: Yes, I will.

THE COURT: I will dispose of it promptly.

MR. HONE: Thank you very much.

MR. WALSH: Thank you very much, your Honor.

THE COURT: Friday will be the 3rd of May and that will give me plenty of time. That is all.

# CERTIFICATE

I, A. Jake Jacobson, Official Reporter for the United States District Court for the Western District of New York appointed pursuant to the provisions of Title 28, United States Code, Section 753, do hereby certify that the foregoing is a full, true and correct transcript of the proceedings had in the within-entitled and numbered cause on the date herein-before set forth; and I do further certify that the foregoing transcript has been prepared under my supervision.

A. Jake Jacobson

Dated: May 1, 1974

### ITEM No. 7

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.,

Movants,

v.

: Patent Interference 98,047

HOEGL ET AL.,

Respondents.

SUPPLEMENTAL MEMORANDUM IN SUPPORT OF MOVANTS' REQUEST FOR AN ORDER TO SHOW CAUSE WHY THE WITNESS WEIGL SHOULD NOT BE COMPELLED TO PRODUCE ALLEGEDLY PRIVILEGED DOCUMENTS

## Introduction

Subsequent to the Court's Show Cause Order dated April 23, 1974 in the above-captioned case, Shattuck et al., on April 24, 1974, took the further deposition of the witness Weigl and also the deposition of Anthony W. Karambelas, Xerox's in-house patent counsel.

During these further depositions, highly significant additional evidence was elicited which (a) strongly confirms the prima facie evidence of fraud set forth in Shattuck et al.'s original Memorandum filed on April 23, 1974, and (b) strongly confirms the necessity for Shattuck et al. to have access to the allegedly privileged documents withheld by the witness Weigl.

## The Prior Art Work Of Dr. Weigl's Group

In regard to the equal weight PVK-TNF composition which Hoegl et al. swore they invented, and which they declared themselves to be the first and original inventors of, it now

Hoegl et al. Preliminary Statement, pg.1, annexed as Exhibit C to Shattuck et al.'s original Memorandum filed with this Court on April 23, 1974.

Hoegl et al. CIP Declaration (lines 1-10) and Claims (claim 1), annexed hereto as Exhibit E.

appears that prima facie evidence now exists that these oaths were not correct and that the Xerox patent attorneys were aware of this evidence when the Hoegl et al. CIP Declaration and Preliminary Statement were filed. Specifically:

- (i) This very same composition was previously made in the United States by members of Dr. Weigl's group, i.e., Mr. J. Mammino and/or others in 1963 and on up through May 1964.
- (ii) Legible photocopies had actually been produced during that time from photoconductive plates employing that equal weight PVK-TNF composition.
- (iii) Mr. Mammino prepared an Invention Record on March 26, 1970 covering that composition and submitted it to Dr. Weigl, who in turn submitted it to the Xerox Patent Department.<sup>5</sup>
- (iv) The Xerox Patent Department thereafter prepared a draft patent application and a revised draft application thereon (but never filed it as discussed hereinafter).
- (v) The Mammino work in 1963 through May 1964 was prior to the earliest date of "invention" alleged by Hoegl et al. in their Preliminary Statement.
- (vi) This early Mammino work was not abandoned, suppressed, or concealed as far as Xerox is concerned, since as late as 1970, as noted above, Mammino prepared an Invention Record on that work and the Xerox Patent Department even drafted a patent application and a revised patent application thereon.
- (vii) Thus, in regard to the equal weight PVK-TNF composition, the Mammino work is prior to, and apparently a complete anticipation of, Hoegl et al.

Allegedly Privileged Documents Withheld By The Witness Karambelas

During the deposition on April 24, 1974 of Xerox's in-house patent attorney, Anthony W. Karambelas, an extensive list of allegedly privileged documents was produced, 9 all relating

Weigl deposition, annexed hereto as Exhibit F, pgs.74-77,80-82.

Weigl deposition, annexed hereto as Exhibit F, pgs.109-112.

Shattuck et al. Exhibit 26 (Items 1 and 1a) annexed to the Show Cause Order herein dated April 23, 1974.

Karambelas deposition, annexed hereto as Exhibit G, pgs.97,98.

<sup>7</sup> See Footnote 1 above.

<sup>8 35</sup> U.S.C. § 102(f) and (g) are set forth in the footnote at page 9 of Shattuck et al.'s original Memorandum filed April 23, 1974.

<sup>9</sup> Shattuck et al. Exhibit 27, annexed hereto as Exhibit H.

to the work of Weigl's group prior to August 1, 1964.¹º This
list of documents itself (correspondence between Weigl and the
Xerox patent attorneys, draft applications on Mammino's work,
Xerox Patent Department affidavits, and documents relating to
Mammino's work, correspondence with Hoegl and Barchietto, etc.)
further establishes that the Xerox patent attorneys were well
aware of the early work of Weigl's group and considered it as
being obviously highly relevant prior art in regard to any assertion of inventorship by Hoegl et al. Yet, the Xerox Patent Department still permitted the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath. Moreover, Hoegl et al.
themselves, having full knowledge of the prior work of Weigl's
group on the exact same composition, 11 swore that they invented,
and were the first and original inventors of, that composition.

The Significance Of The Allegedly Privileged Documents Withheld By Weigl In View Of The Additional Evidence Referred To Above

The three documents withheld by Dr. Weigl, 12 one dated March 26, 1970 and two dated April 2, 1970, are particularly significant since they were all generated within two weeks after IBM representatives informed Xerox (on March 20, 1970) of the PVK-TNF composition used in the IBM copier machines which were to be put on commercial sale the following month, April 1970. 13

It is believed the documents requested herein may firmly establish that Dr. Weigl and the Xerox attorneys, in April 1970, concluded that the work of Dr. Weigl's group was not abandoned, suppressed, or concealed, and that therefore a patent application should be drafted in connection with that work (which was in fact done). 14 It would then, of course, be improper to permit the

Karambelas deposition, annexed hereto as Exhibit G, pgs.97-98.

Shattuck et al. Exhibit 27, annexed hereto as Exhibit H, Items 3 and 4.

<sup>12</sup> Items 1, 1a, and 1c of Shattuck et al. Exhibit 26, annexed to the Show Cause Order herein.

<sup>13</sup> Karambelas deposition, annexed hereto as Exhibit G, pg. 106.

<sup>14</sup> Karambelas deposition, annexed hereto as Exhibit G, pgs 37-98.

subsequent filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath.

For example, the documents withheld on the grounds of privilege may very well show that the actual reason for not filing the draft application was, not because Weigl's work was abandoned, suppressed, or concealed by Xerox, but because the Shattuck et al. United States and corresponding foreign patents had long since issued and Xerox was thereby statutorily barred from filing a new application in the name of Mammino or anyone else in Weigl's (See footnote 7 of original Shattuck et al. Memorandum.)

It is respectfully submitted that the highly pertinent facts regarding the prior art work of Dr. Weigl's group, and Xerox's reasons for permitting the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath in spite of that earlier work, are facts and reasons which Xerox in any event should have presented to the Patent Office so that the Patent Office could properly assess the Hoegl et al. CIP application against the prevailing statutory criteria, namely 35 U.S.C. § 102(f) and (g). 15

In Monsanto Company v. Rohm & Haas Company, 456 F2d 592 (3 Cir. 1972), cert. denied, 407 U.S. 934 (1972), for example, Monsanto had not disclosed all the relevant facts to the Patent Office regarding the invention claimed in their patent application. The Court stated therein at page 600:

> "Under these circumstances, it was impossible for the Patent Office fairly to assess Monsanto's application against the prevailing statutory criteria. Thus, Monsanto's failure to disclose amounted to misrepresentation transgressing equitable standards of conduct owed the public by the applicant in return for its monopoly."

<sup>35</sup> U.S.C. § 102 provides that, "A person shall be entitled to a patent unless ... (f) he did not himself invent the subject matter sought to be patented, or (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it ..."

#### CONCLUSION

The Hoegl et al. CIP Declaration and Preliminary Statement Oath appear to be obviously inconsistent with the earlier work of Weigl's group relating to the exact same composition.

The only way all the relevant facts on the issue of fraud can be brought to the attention of the Patent Office is by Shattuck et al. having unrestricted access to sources of information, including allegedly privileged documents, which relate to this admittedly pertinent prior art work of Dr. Weigl's group. This is particularly so since all the facts regarding this prior art work, and Xerox's reasons for permitting the filing of the Hoegl et al. CIP Declaration and Preliminary Statement Oath in spite of that earlier work, are facts and reasons which Xerox should have, by law, voluntarily disclosed to the Patent Office in any event. They are also, obviously, critical to the issue of fraud in this interference.

Dated:

Respectfully submitted,

WISER, SHAW, FREEMAN, VAN GRAAFEILAND, HARTER & SECREST

By Wester, Show, Framum, Van Branjeiant, Haire & Secret 700 Midtown Tower Rochester, New York 14604 (716) 232-6500 Attorneys for Movants

OF COUNSEL:

Pennie & Edmonds
Clyde C. Metzger
Robert J. Kadel
Sidney R. Bresnick
330 Madison Avenue
New York, New York 10017

Joseph G. Walsh International Business Machines Corporation Monterey & Cottle Roads San Jose, California 95114 ORIGINAL CLAIMS OF HOEGL ET AL. CIP APPLICATION SERIAL NO. 108,548, FILED JANUARY 21, 1971.

## WHAT IS CLAIMED IS:

- 1. An organic photoconductive composition comprising about one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole.
- 2. An electrophotographic process comprising the steps of: forming an electrostatic image on a photoconductive

element comprising about one part by weight

of 2,4,7-trinitro-9-fluorenone per one part

by weight of polyvinylcarbazole, and

developing the electrostatic image.

illa

DECLARATION, POWER OF ATTORNEY, AND TOTITION TO
We, BURLMUT HOLDI, and GUACOMO BARCHIETTO
, declare
that we are citizens of GERMANY and ITALY, respectively
residing at GRAND-LANCY/
Geneva (Switzerland) and Busto Arsizio (Italy)
; that we have
read the foregoing specification and claims and we verily believe that we are
the original, first and joint inventors of the invention in
7.
flaimed in the foregoing specification; that this application in part discloses and claims subject matter disclosed in our earlier filed pending application,
20-101 No. 530 003
bundly 0, 1900 , that, as to
the subject matter of this application which is common to said earlier application, we do not know and do not believe that the same was ever known
deed before our invention thereof, or patented or described in any printed
rubilcation in any country before our invention thereof or more than any
rear prior to said earlier application; or in public use or on sale in the Inited States more than one year prior to said earlier application; that
aid common subject matter was not patented before the date of said earlier
ipplication in any country foreign to the United States, on an application
lied by us or our legal representatives or assigns more than twelve manths
close said earlier application; that, as to the subject matter of this
pplication which is not common to said earlier application, we do not know nd do not believe that the same was ever known or used before our invention
nereof, or patented or described in any printed publication in any country
erore our invention thereof or more than one year prior to this application
In public use or on sale in the United States more than one year prior
o this application; that said subject matter was not patented in any ountry foreign to the United States on an application filed by us or our legal
epresentatives or assigns more than twelve months before this application;
hat no application for patent on the non-common subject matter of this
nvention has been filed by us or our legal representatives or assigns in
ny country foreign to the United States more than twelve months before his application, except as follows:
application, except as follows:
nd that the earliest application for patent on this invention that has
sentilled by us or our legal representatives or assigns in any country
oreign to the United States, and a claim for the priority of which is
ade under 35 U.S.C. 119, is as follows:
10. 50
And we hereby appoint James J. Ralabate, Registration No. 19,211; Libert Manassel Registration No. 19,064; Peter H. Kondo Registration No.
Registration No. 19,064 ; Peter H. Kondo Registration No. 184 ; and Registration No. , all
Skerox Corporation, Xerox Square, Rochester, New York, 14603 our attorneys
prosecute this application and to transact all business in the Patent
office connected therewith. All correspondence is to be held with James J.

Wherefore we pray that Letters Patent be granted us for the invention discovery described and claimed in the foregoing specification and claims, in we hereby subscribe our names to the foregoing specification and claims, inclaration, power of attorney, and this petition.

A STATE OF THE PARTY OF THE PAR
The undersigned peditioners declare further the all statements made
erein of their own knowledge are true and that all Matements made on
nformation and belief are believed to be true; and further that these
tatements were made with the knowledge that willful false statements and
he like so made are punishable by fine or imprisonment, or both, under the
ection 1001 of Title 18 of the United States Code and such willful false
tatements may jeopardize the validity of the application or any patent
ssuing thereon.
是一次的最高的一点,我们在这个人,就是一个人的一个人,就是这个人的一个人,我们就是一个人的一个人的一个人,也不是一个人的一个人的一个人,也不是一个人的一个人的一
Inventor telunit tored
First Name Middle Initial Last Name
Post Office Address 25, chem. des Palettes, 1212 GRAND-LANCY/GENEVA (Switzerland)
Date dec. 23 , 1970
Inventor Massey /douckert
Inventor Mana Middle Initial Last Name
Post Office Address Via Macchiavelli 15, BUSTO ARSIZIO (Italy)
• • • • • • • • • • • • • • • • • • • •
Date Dec. 29. 1970
N Inventor
First Name Middle Initial Last Name
· 보통하는 사람들은 사람들이 아니는 사람들이 아니는 사람들이 아니는 사람들이 아니는 사람들이 되었다. 그 사람들이 아니는 사람들이 되었다. 나는 사람들이 아니는 사람들이 아니는 사람들이 없는 사람들이 되었다.
Post Office Address
Date 1

on these pages or a subsequent successory or report reflecting this work.  MR. HONE: Well, why don't you and the questions one at a time?  DQ244. All right, when did you first see these pages, Dr. Weigle?  A. I don't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research Laboratories Report Number RL64-45". Later down
Questions one at a time?  DQ244. All right, when did you first see these pages, Dr. Weigle?  A. I den't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
questions one at a time?  DQ244. All right, when did you first see these pages, Dr. Weigle?  A. I don't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewe them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
DQ244. All right, when did you first see these pages, Dr. Weigle?  A. I don't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewe them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
Dr. Weigle?  A. I don't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
A. I don't believe I recall, but certainly it was, at the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
the very latest, at the time of the review of the notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
notebook in 1967, and I might possibly have reviewed them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
them during 1963 or 1964. Well, these in 1964.  DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
DQ245. These pages, do they or do they not all bear the notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
notation "Project number 532412"?  A. Yes.  DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
DQ246. I'll call your attention to the next group of three pages stapled together entitled, "Xerox Research and Engineering Division Research
three pages stapled together entitled, "Xerox Research and Engineering Division Research
Research and Engineering Division Research
2
in the page it bears the notation, Project Number
532412".
A. All right, sir.
DQ247. There are two names on it; J. Mammino and
G. Jvirblis, am I correct? I believe you pre-
viously testified that Jvirblis is the married

# Dr. John Weigle

1 .	Α.	Yes, sir.
2	DQ136.	Was this work represented on Shattuck, et al
3		Exhibit "28" the result of her idea?
4		MR. HONE: I object. Same objection
5		as before. Dr. Walsh can't know Dr.
6		Weigle can't know that, what was in Miss
. 7		Salasny's mind at the time.
8		MR. WALSH: Let him answer whether or
. 9		not he knew.
10	•	MR. HOME: Let him answer as to whether
11	-	or not he had any understanding with respec
12		to that question.
13	DQ137.	All right. I will ask you that question. Do you
14		have any understanding as to whether or not this
15		work was the idea of Miss Salasny?
16 ·	A	I believe it was the idea, probably, of Mr.
17		Mammino, who was her supervisor, and was charged
18		with work in the area of organic photoconductors.
19	DQ138.	What was Miss Salasny's position at the time?
20	Α	Research Aide; Mr. Mammino's assistant under his
21		supervision.
22	DQ139.	Is it correct to classify her as a laboratory
23		technician?

i	Α.	Yes, that would be quite right.
2	DQ140.	I will then again call your attention to the
3		writing which says, "10 Micron Film of one to one
4		PVK: TNF", and ask you to explain what those
5		abbreviations mean.
6	Α.	Certainly.
7		MR. HONE: I object to the question as
8		calling for a conclusion by Dr. Weigle.
9		MR. WALSH: Dr. Weigle is an expert in
10		this field, well capable of drawing this
11	- 1	simple conclusion.
12		MR. HONE: Dr. Weigle has not been
13		called as an expert; he has been called as
14		a fact witness. If you want to elicit facts
15		please do so, but don't call on him as an
16		expert to interpret notebook records. If
17		you asked Dr. Weigle if he had any under-
18		standing at the time of this entry as to
19		what the meaning of that entry was, please
20		do so, but don't ask him to interpret it.
21		MR. WALSH: I will ask Dr. Weigle what
22		those symbols mean.
23		MR. HOME: I object and instruct him

9

			•	Dr. John Weigle
1			not to answer.	You are here to elicit facts
2			from Dr. Weigle	e, not expert opinion.
3		MR.	WALSH:	The meaning of those symbols
4			is a fact.	
5		MR.	HONE:	His understanding of what
6			they meant on t	this notebook page at the
7			time they were	entered and at the time he
8			saw them might	be a fact; his interpretation
9			of what they me	ean is not, it's opinion.
10		MR.	WALSH:	His understanding is really
11			very secondary	and irrelevant. The impor-
12			tant point is	what is the meaning. I will
13			ask him again.	
14	DQ141.	Dr.	Weigle, I will sp	olit the question up. When
15		the	expression, "one	to one" is used, what is
16		mean	t?	
17		MR.	HONE:	Used by whom, Mr. Walsh?
18		MR.	WALSH:	Used by Miss Salasny on this
19		•	page.	
20		MR.	HONE:	As of 1963?
21		MR.	WALSH:	What was meant at that time.
22		MR.	HONE:	I will let Dr. Weigle answer
23			as to what his	understanding was. If you

r

will turn to Exhibit "29".

- A. It was, I believe, attached, and it refers directly to the same work. Well, you will see that it is substantially "one to one" by weight of trinitrofluorenone-- PVK.
- DQ142. No, no, please. Spell it out.

  MR. HONE: It says "PVK".
- A. It says "PVK".
- DQ143. I want the record to show very clearly that the
  "TNF" does, in fact, mean trinitrofluorenone and
  "PVK" does, in fact, mean poly-n-vinylcarbazole,
  so I'll ask you again, Dr. Weigle, what was your
  understanding as to the meanings of these abbreviations?
- A. Very clearly that which is factually stated on Exhibit "29", "0.5475 grams of TNF and 0.55 grams of PVK".
- DQ144. And what is "TNF"?
- A. 247 trinitro (9) fluorenone.
- DQ145. And what is "PVK"?
- A. Poly-n-vinylcarbazole.
- DQ146. Is that a polymized vinylcarbazole compound?
- A. Yes, sir.

	•		Dr. John Waigle
,		it, we will pro	duce 1t.
2		THE WITNESS:	The original notebook will
3		show it. I am	sorry, it ran off the end
4		of the page.	
5	DQ153.	Does Miss Salasny sti	ll work for Xerox?
6	A	Miss Salasny's marrie	d name is Jvirblis, and she,
7		again, works for Xero	x after some years of not
8		having worked for Xer	·ox.
9	DQ154.	In calling your atter	ation specifically to the
10		material containing	equal weights of PVK and TNF,
11		the one: one by weight	, do you know whose sugges-
12		tion it was to use the	nat specific composition?
13	A	I can only speculate	. Thinking back, I am quite
14		sure that it was not	mine and I can tell you why,
15		if necessary.	
16		MR. HONE:	You are not required to
17		speculate, Dr.	Weigle.
18		THE WITNESS:	Am I permitted?
19		MR. WALSH:	I have no objections.
20		THE WITNESS:	I believe it was probably
21		Mr. Mammino's.	
22 .	DQ155.	Could you explain th	e basis for your belief that
23		it was Mr. Mammino's	sucrestion?

	Dr. John Weigle
Α.	Yes.
DQ156.	Would you, please?
A.	The prime objective of this project was directed
	to novel compositions of great mechanical strength,
	based upon materials other than PVK, and sufficientl
	transparent to be useful as a Xerographic microfilm
	for direct projection, and our prime objectives,
	then, were to fabricate to innovate and to
•	fabricate materials which were mechanically strong,
	self-supporting and useful for transparency pro-
	jections. These materials were really outside the
	prime objectives of the project.
	MR. HONE: When you say "these materials",
	what do you mean, Dr. Weigle?
	THE WITNESS: The materials which fall
	I'm sorry, the materials in the general
	range of one to one by weight PVK to TNF
	compositions, and similar compositions which
	we are discussing here today, were somewhat
	outside the scope of the project and of its
	main objectives, and therefore, of relatively
	casual interest to us at that time.
DQ157.	This doesn't connect it, at least I don't see how

		Dr. John Weigle
1		it connects it to Mr. Mammino.
2	A.	Mr. Mammino, as project leader, was free to take
3		reasonable excursions as his interest dictated
4		and as a research man and research product leader
5		would be expected to.
6	DQ158.	But this work was done under your supervision,
7		is that correct?
8	Α.	That is correct.
9	DQ159.	Who else would have knowledge of this work at this
10		time? Specifically, was there any intermediate
11		leader or manager between Mr. Mammino and you?
12	Α.	There was none.
13	DQ160.	Would other group leaders have knowledge of it?
14		MR. HONE: What do you mean by "other
15		group leaders"? Outside Dr. Weigle's group?
16		MR. WALSH: Well, all right, outside of
17		Dr. Weigle's group, yes.
18	Α.	At the time, as best I can recall, this was a
19		very brief excursion and one which we did not take
20		very seriously, and I don't know whether it was
21		widely discussed.
22	DQ161.	Would, for example, Dr. Martel have had knowledge
23		of this?

## Dr. John Weigle

(Whereupon,	the	Reporter	marked	for	identification	
Shattuck, e	t al	Exhibit	"45")			

DQ233. Turning to the first page of Exhibit "35", you will note that apparently it is a continuation of page 91, which is the prior page here. On the bottom of this page, on the left hand side, it has "50/50 PVK/TNF" from 5-5-64. What is the significance of that notation, Dr. Weigle?

MR. HONE:

As you understood it at the

time.

- DQ234. As you understood it at the time, and if you understand it differently now, please let us know.
- A. I believe that it means that it is equal weight proportions of PVX and TNF, and the coating as those described previously--probably identical to them.
- DQ235. And the upper portions of this, are these actual pictures made using that photoconductive composition?
- A. In the original notebook, they are actual pictures made from a test target in an enlarger at a series of exposures, constant light bulb setting, constant current setting, variable aperature and time.

		Dr. John Weigle
1		The apertures have been noted as "F" stops.
2		The times are noted in seconds. What this whole
3		series does as a group is to provide an idea of
4		the photosensitivity of this particular combina-
5		tion of materials or this
6	DQ236.	The other notations on this page refer to other
7		varying ratios of PVK and TNF, is that correct,
8		on the right hand side?
. 9	Α.	Yes. They actually fall outside of the count.
10	DQ237.	The date of this page is May 5, 1964, is that
11		correct?
12	Α.	Yes, sir.
13	DQ238.	In summary, therefore, Shattuck, et al Exhibit
14		"35" shows a legible electrographic copy of a
15		document copied using as a photoconductor a
16 -		composition consisting of equal weights of poly-
17		vinylcarbazole and trinitrofluorenone, is that
18		correct?
19	Α.	That's correct.
20	DQ239.	The symbol on the extreme left hand side is a
21		negative sign with a circle around it. What is
22		the significance of that?
23	Α.	I don't know for sure.

4		Dr. John Weigle
1	DQ240.	Shattuck, et al Exhibit "36", the next page, once
2	•	again the lower left hand corner shows equal
3		weights of PVK and TNF. I'll ask you, is the
4		image on the top of the page a Xerographic copy
5		prepared using that composition as the photo-
6		conductor?
7	A.	Yes, as I said before, this whole series is a
8		series of images made quite clearly with the one
9		to one by weight PVK: TNF plate, and it was done
10		in an attempt to find the optimal exposure.
11	DQ241.	The important work the important fact I am
12		trying to get at, Dr. Weigle, is that these are
13		actual legible copies made using this composition
14		as a photoconductor, is that correct?
15	Α.	I can read them.
16	DQ242.	And this work was done on May 5, 1964, is that
17		correct?
18	Α.	Yes, sir.
19	DQ243.	All right. Do you recall when you first saw this
20		work?
21		MR. HONE: Do you mean the work recorded
22	•	on these pages?
23		MR. WALSH: No, either the work recorded

# ANTHONY W. KARAMBELAS 97

1		MR. HONE: I will answer for him. No,
2		he did not, and I, as his attorney, did not.
3		MR. WALSH: I will ask him to answer the
		question.
5	DQ255	Did you bring the documents?
6	A	No, I did not.
7	DQ256	I'll call your attention to document 8. It says
8		"revised application draft, PVK/TNF." Did this
9		document specifically concern a patent application
10		relating to work done in the United States prior to
11		August 1, 1964?
12	A	Yes, I believe it did.
13	DQ257	This was the work done by people in Weigle's group?
14	A	Yes, I believe so.
15	DQ258	Is that statement also true in regard to document 2,
16		"Draft Patent Application, PVK:TNF"?
17	A	Yes, I believe so.
18	DQ259	Wars thase applications ever filed?
19	A .	No, they were not.
20	DQ260	Why not?
21		MR. HCNE: Objection. The reasons why or
22		why not applications were filed are privileged
23		and calls for an attorney's conclusions, calls

1		for all kinds of things that you are not
2		entitled to.
3	DQ261	I'll call your attention to document 12 entitled
4		"Draft Affidavit." I will ask you what this
5		affidavit pertains to?
6		MR. HONE: Objection, the contents of that
7		affidavit is a privileged matter.
8	DQ262	Did it relate to work done in the United States
9		under the direction of Dr. Weigle prior to August 1,
10		1964?
11		MR. HONE: Well, if it hadn't, it wouldn't
12		have been on this list.
13		MR. WALSH: Mr. Hone
14	Α .	Yes. The answer is yes.
15		MR. WALSH: I want the witness to answer
16.		the questions, please.
17	DQ263	I didn't hear your answer, I'm sorry.
18	A .	I beliave so. I believe so.
19	DQ254	For whose signature was that affidavit drafted?
20	A	Can I have a minute?
21		MR. WALSH: Sure.
22	(The wit	mess confers with Mr. Hone.)

MR. HONE: I am going to object to any

Zealand or the one from Great Britain or the one from any other foreign country you might care to name? I think the first time that I became aware of those is when I received papers from you and you listed the foreign counterparts. I believe that was the 6 first time I was aware of them. 7 In connection with your becoming aware of the 8 DQ279 composition of the IBM photoconductor I'd like to refresh your memory again. 10 MR. HONE: If he's aware of it. 11 MR. WALSH: I'd like to attempt again to 12 refresh his memory -- not your memory, Mr. Hone, 13 14 his. I'll tell you that on March 20, 1970, representatives 15 DQ280 of IBM informed representatives of Xerox what the 16 composition of the proposed IBM photoconductor would 17 be in the copier which was put on commercial sale 18 the following month, April, 1970. I will ask you 19 again, did you or did you not, very shortly -- say 20 within three months of that date, know the compo-21 sition of the IEM photocopier -- the photoconductive 22 23 composition in the copier?

2174 Pholine

List of Privileged or Work Product Documents in the Xerox Files Relating to Interference No. 98,047 Between Hoegl et al and Shattuck et al in the United States Patent Office Which Were Prepared on or Before November 7, 1972 and Which Relate to Work done in Connection With the Subject Matter of the Interference Prior to August 1, 1964:

0			
Originator	Recipient/Distributees	Date	Subject
J. Weigl	A. MahasselJ. Mammino	4/2/70 ✓	Battelle Work on Heavily Doped PVK.
Patent Department			Draft Patent Application PVK/TNF.
H. Hoegl	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambelas, H. Hoegl, G. Barchietto, B. Dousse, M. Vimic.
G. Barchietto	A. W. Karambelas	9/14/72	Meeting attended by A. W. Karambelas H. Hoegl; G. Barchietto, B. Dousse, M. Vimic
J. Weigl	A. W. Karambelas	9/5/72	Capsule history of interactions with H. Hoegl (Aug'62-Sept'64)
J. Mammino	J. Weigl	3/26/70 <	Invention proposal: High Speed Organic Photoconductor
Peter H. Kondo	Francis J. Hone - A. A. Mahassel J. J. Ralabate	4/10/70	Coatings.  Transmittal of information and documents.
Patent Department			Revised Application Draft PVK/TNF
Patent Department			Handwritten notes (10pages) re: PVK/TNF work
Patent Department		<b></b>	Correlation between Mammino work and Fig. 2 of IBM Paten
P. H. Kondo			Draft of "Request for Interference."
Patent Department			Draft Affidavit.
Patent Department		•	Typed and handwritte notes and questions me: PVK-TNF work (2 pages).

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.,

v.

Movants,

Patent Interference 98,047

HOEGL ET AL.,

Respondents.

# SUPPLEMENTAL AFFIDAVIT OF CLYDE C. METZGER

STATE OF NEW YORK ss.: COUNTY OF NEW YORK )

CLYDE C. METZGER, being duly sworn, deposes and says:

- 1. I am a member of the Bar of the State of New York, the Court of Appeals for the Second Circuit, and of the firm of Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, counsel for Movants, Meredith D. Shattuck and Ulo Vahtra ("Shattuck et al."), in the above-captioned action.
- 2. On information and belief, the following documents annexed to the Supplemental Memorandum submitted herewith are true and correct copies of the originals thereof:
  - Exhibit E Pennie & Edmonds file copy of Hoegl et al. CIP Declaration and Claims (application Serial No. 108,548, filed January 21, 1971);
  - Exhibit F Weigl deposition, April 24, 1974, pages 74-77, 80-82, and 109-112.
  - Exhibit G Karambelas deposition, April 14, 1974, pages 97, 98, and 106.

Exhibit H - Shattuck et al. Exhibit 27.

Subscribed and sworn to before

me this 29th day of April 1974

Notaley in Bub Licias No. 41 2333153 Oneon Cert. Left of the lock of Term 1 .... ..... 10. 1975 IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL., :

Movants, :
Patent Interference 98,047
v. :

HOEGL ET AL., :
Respondents. :

SUPPLEMENTAL MEMORANDUM OF HOEGL ET AL IN OPPOSITION TO THE SHATTUCK ET AL REQUEST FOR PRIVILEGED AND WORK PRODUCT DOCUMENTS

#### I. INTRODUCTION

During the April 30 argument on this matter before the Court, Shattuck et al submitted a supplemental memorandum and presented oral statements containing erroneous factual presumptions and assertions, and including unsupported arguments in an attempt to obtain access to the privileged and work product documents identified in the files of Dr. Weigl. By leave of Court, Hoegl et al submit this supplemental memorandum to set the factual record straight and to refute the further arguments presented by Shattuck et al.

#### II. FACTUAL CHRONOLOGY OF PERTINENT EVENTS

#### A. The Activities of Hoegl and Barchietto

<u>July, 1964</u> - PVK/TNF (1:1) plates (not overcoated) were prepared and found to have substantial absorption indicating

significant photoconductivity (Letter-Report No. 19, Exhibit D hereto).

October, 1964 - PVK/TNF (1:1) plates were tested and found to be useful photoconductors with or without overcoating (Letter-Report No. 21, Exhibit E hereto).

March, 1965 - The utility of PVK/TNF (1:1) plates with and without overcoating was described and illustrated (Comprehensive Progress Report No. 6, Exhibit F hereto).

January 6, 1966 - Hoegl et al filed its original patent application describing PVK-TNF 1:1 plates both with and without overcoating.

January 21, 1971 - Hoegl et al filed the CIP application involved in this interference, including a Declaration (Exhibit C to the original Hoegl et al Memorandum herein), stating that they believed themselves to be the original and first inventors of a photoconductor comprising PVK-TNF (1:1).

August 16, 1972 - The Patent Office declared this interference with two counts and accorded Hoegl et al the benefit of the January 6, 1966 application as to both counts (Exhibit G hereto).

November 7, 1972 - Hoegl and Barchietto signed the Preliminary Statement in this interference asserting that they had made the PVK-TNF 1:1 invention in July, 1964 (Exhibit B to the original Hoegl et al Memorandum).

December 18, 1972 - Shattuck et al filed a motion to deny Hoegl et al the benefit of the January 6, 1966 application (Exhibit H hereto).

July 20, 1973 - The Patent Office Interference Examiner denied the motion of Shattuck et al with respect to Count 1 (the present interference count) and granted that motion with respect to Count 2 (Decision on Motions, Exhibit I hereto).

August 9, 1973 - Shattuck et al filed a petition to the Commissioner of Patents charging abuse of discretion by the Examiner and seeking a reversal of the Examiner's denial of the Shattuck et al motion with respect to Count 1 (Exhibit J hereto).

September 28, 1973 - The Commissioner of Patents denied the Shattuck et al petition (Exhibit K hereto).

#### B. Activities of Weigl's Group at Xerox

October 29-30, 1963 - At the direction of Mammino,
Salasny prepared a 1:1 solution of PVK/TNF which was spread on
a plate and tested. Comparison with selenium showed a poor
response (Salasny notebook records, Exhibit L hereto).

April 23-24, 1964 - At the direction of Mammino,
Salasny prepared a series of plates containing various PVK/TNF
ratios from 90/10 to 30/70. Comparison with selenium showed a
poor response (Salasny notebook records, Exhibit M. hereto).

May 5, 1964 - Images were made from PVK/TNF plates including 1:1 plates to determine optimum exposure (Salasny notebook records, Exhibit N hereto).

August 15, 1964 - Mammino and Salasny issued a report on PVK/TNF plates and concluded that the optimum concentration of TNF was 20% (Exhibit A to the original Hoegl et al Memorandum).

March 26, 1970 - Pursuant to a prior request by

Xerox attorneys that Dr. Weigl-review records relating to

PVK/TNF work and transmit information to them for consideration

as to whether any action might be taken to provoke an interference, Mammino prepared a summary of the 1963 and 1964

PVK/TNF activities in the form of an "Invention Record"

(Privileged document la) (Weigl deposition, page 125, Exhibit O hereto).

April 2, 1970 - Pursuant to the request of the Xerox attorneys for information, Dr. Weigl submitted two memoranda, one transmitting and commenting on the Mammino "Invention Record" (Privileged document 1) and the other commenting on the Battelle Geneva work of Hoegl and Barchietto (Privileged document 1c).

# A. The Xerox Work Was Not An Invention

Considering first the experiments conducted in Dr.
Weigl's group at Xerox, the failure of Mammino and Salasny and
others at Xerox to recognize any invention in the PVK/TNF 1:1
formulation in 1963 and 1964 shows an utter lack of conception
of the invention and deprives those involved of any right to
claim those experiments as evidence of invention. This aspect
is fully discussed in the original Hoegl et al Memorandum filed
on this matter.

Shattuck et al argue, however, that the preparation of an "Invention Record" by Mammino in 1970 and the preparation of a draft application relating to that work indicates that Xerox attorneys believed the early work to represent an invention of the subject matter of this interference. As Dr. Weigl has testified, however, (pp. 126-127 of the Weigl transcript, Exhibit P hereto), an "Invention Record" at Xerox is not a request for a

patent application and such documents are prepared and submitted to Xerox attorneys for their consideration regardless of the patentability or legal effect of the work described. The draft application which is not here in issue, but is referred to in the Shattuck et al memorandum (Items 2 and 8 in the List of Privileged and Work Product Documents from the Xerox Patent Department files, Exhibit H to the Shattuck et al Supplemental Memorandum) was drafted before any determination had been made by the Xerox attorneys as to the legal effect of the work done at Xerox.

Contrary to the assertions in the Shattuck et al memorandum, therefore, neither the "Invention Record", nor the draft application has any significance with respect to whether Xerox attorneys considered the prior work to be an "invention". In fact, after the draft application had been prepared, the conclusion was reached that the prior work did not constitute an invention of the subject matter and no further work was done in connection with the preparation of a patent application.

Even if a patent application had been filed in 1970, however, it could not have been based on work done in 1963 or 1964 and, therefore, could not have supported the view that that work represented an invention. It is well established that an unexplained delay of many years between experimental work and the filing of a patent application directed to that work is evidence that the original work was merely an abandoned experiment and the applicant cannot rely upon that work as the basis for his invention. For example, in *Gyromat Corp. v. H. G. Fischer & Co.*, 167 USPQ 326 (N.D. Ill. E. Div. 1970), the court held that experiments conducted six years before the filing of a patent application cannot be considered a reduction to practice of the invention, but constitute only an abandoned experiment, stating (page 333):

"During the four-year period after the 1953 experiments nothing of consequence was done to commercially pursue the alleged invention. Six years passed before any application for a patent was filed by Mr. Walberg (the 'grandparent' application No. 827,587, filed July 16, 1959). And an application sufficiently broad in scope to include the 'Attachment B' gun structure (the 'parent' application No. 211,006) was not filed until July 19, 1962, some nine years after the alleged reduction to practice. There is some evidence that for a time after the 1953 experiments it would not have been financially practicable for Mr. Walberg to commercially produce his alleged invention. That fact would not, however, explain his failure to seek the protection of a patent. It has been held that one's failure to file an application covering the invention in issue for a number of years after the last experiments raises a strong presumption that the results of those experiments were not considered satisfactory, and is therefore evidence against the finding of a reduction to practice. Birmingham v. Randall, 171 F.2d 957, 960, 80 USPQ 371, 373 (CCPA 1948). Accord, Conner v. Joris, supra, 241 F.2d at 951, 113 USPQ at 61-62.

Similarly, in affirming a holding by the Board of Patent Interferences that certain experiments conducted long before the filing of an application were not evidence of prior invention, the Court of Customs and Patent Appeals stated:

Breen v. Richmond, 366 F.2d 482, at 486-487 (CCPA 1966):

"In reviewing the testimony and exhibits we have been concerned not only with the burden of the appellants as junior party to prove their case by a preponderance of the evidence, but also with appellants' delay of over six years, after the allegedly successful reduction to practice, in filing the application here in issue. There are substantial reasons of sound public policy why such a delay is a factor to be considered in a case such as the present and we think the board properly took note of this conduct and the lack of any explanation therefor."

Clearly, even if the experiments of Mammino and Salasny in 1963 and 1964 were held to show an understanding of the invention by them at that time, the early experiments by them could not be relied upon as evidence of any prior invention or prior art activity, but could only be considered as abandoned experiments. Because no application relating to that work was, in fact, filed, there is no possible basis for any assertion of prior art activity at Xerox in connection with this subject.

#### B. Hoegl and Barchietto Are Entitled to Claim PVK/TNF (1:1) As Their Invention

Because there was no invention or other prior art activity involved in the work at Xerox, Hoegl and Barchietto whether or not they knew of that work were entitled to assert in their Preliminary Statement that they had made the PVK/TNF (1:1) invention in 1964, and to state in the Declaration for their CIP application that they believed themselves to be the original and first inventors of that subject matter.

Memorandum, based upon the List of Privileged and Work Product
Documents in the files of the Xerox Patent Department which are

not here in issue, that Hoegl and Barchietto did know about the
prior work at Xerox constitutes an erroneous interpretation of
the document identification in that list (Exhibit H to the
Shattuck et al Supplemental Memorandum). The description of the
List of Privileged and Work Product Documents in the Xerox Patent
Department files belies the Shattuck et al interpretation since
it shows that the documents are not limited to work done in Dr.
Weigl's group, or at Xerox, but include the work done by Hoegl and
Barchietto in Switzerland. The schedule of documents attached to

the subpoenss served on Xerox attorneys by Shattuck et al, which ultimately led to the identification of the privileged and work product documents in the Xerox Patent Department files, also contradicts the assertion by Shattuck et al that those documents are restricted to work done at Xerox, since the schedule is not so limited (Exhibit Q hereto, the Shattuck et al Deposition Notice, includes a copy of the schedule).

In view of this, Hoegl and Barchietto are legally entitled to claim the subject matter as their invention and could not have made any fraudulent statement in their Preliminary Statement or the CIP Declaration.

IV. SHATTUCK ET AL HAVE NOT ESTABLISHED SUBSTANTIAL NEED OF THE PRIVILEGED AND WORK PRODUCT DOCUMENTS

Shattuck et al do not challenge the assertion of privilege and work product with respect to the documents here in issue which were prepared by or on behalf of the attorneys for Hoegl et al, or their representatives, in anticipation of, and in preparation for, this interference.\* Instead, Shattuck et al merely contend that disclosure of the privileged and work product documents is required because the documents may contain relevant factual information.

Rule 26(b)(3) of the Federal Rules of Civil Procedure relating to discovery, provides:

"Subject to the provisions of subdivisions (b) (4) of this rule, a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b) (1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by

<sup>\*</sup> The only persons who received copies of these documents, other than attorneys for Xerox, are certain research managers who are normally consulted by Xerox attorneys for technical advice in connection with their determination of the legal effect of Xerox research activities.

or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the sub-stantial equivalent of the materials by other means." (Emphasis added)

At the oral argument relating to this request, it was pointed out on behalf of Hoegl et al that these documents are not required by Shattuck et al because Shattuck et al now has all of the factual information relating to work done at Xerox regarding the subject matter of this interference which is contained in these documents. In response, counsel for Shattuck et al acknowledged that there is no substantial need for the documents, stating that Shattuck et al believes it now has all of the evidence necessary to support its charges.

In the circumstances, Rule 26(b)(3) clearly precludes production of these documents to Shattuck et al.

#### V. CONCLUSION

The documents in the Weigl files, as to which claims of privilege and attorney-work product have been made, could not support the Shattuck et al fraud charges and are not needed by Shattuck et al. The request for access to these documents should, therefore, be denied.

Respectfully,

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

Dated: May 3, 1974

Francis J. Hone Attorneys for Respondents 30 Rockefeller Plaza New York, New York 10020

(212) 489-3326

#### Of Counsel:

Elliott Horton, Esq. Harris, Beach & Wilcox 2 State Street Rochester, New York 14614 Tel. (716) 232-4440

Ronald B. Hildreth Brumbaugh, Graves, Donohue & Raymond 30 Rockefeller Plaza New York, New York 10020

Anthony W. Karambelas, Esq. Xerox Corporation Xerox Square Rochester, New York 14644

#### CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Supplemental Memorandum of Hoegl Et Al In Opposition To The Shattuck Et Al Request For Privileged and Work Product Documents, together with exhibits, was served this day by mailing a copy thereof, postage prepaid, to Robert J. Kadel, Esq., Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, and to Joseph G. Walsh, Esq., International Business Machines Corporation, Monterey & Cottle Roads, San Jose, California 95114.

Dated: May 3, 1974

Attorney for the party

Hoegl et al

THE STUDY OF FUNDAMENTAL ASPECTS RELATED TO THE PHOTO-CREATION AND MOBILITY OF THEE . CHARGE CARRIERS IN ORGANIC MATERIALS

Letter-Report No. 19

EXEROX CORPORATION Research & Engineering Center

800 Phillips Road

Webster

New York, USA

Ciacono Barchiotto, Helmut Hoogl, Gilbert Hochstrasser, Paul Ra Adolf Steinemann and Domokos Tar. ....

This latter-report describes the work done during the month of July 1964. 

Invostigations have been concerned primarily with PVK films.

Optical absorption and emission spectra, EPR spectra, electrostatic and photoconductivity measurements have been carried on.

With NIPC single orystals conductivity measurements have been continued.

Detailed results of measurements will be presented in the next comprehensive progress report due in Soptember 1964.

# Optical measurements with PVK filmst

Absorption spectra of 5.5 \mu thick PVK films, cast on quartz glass; and doped with increasing concentrations of some electron acceptor have been measured, spectral range 320 to 850 mm; (Beckman Recording Spectrophotometer Model DK).

With increasing concentrations of 2,4,7-trinitro-9-fluorenone (THE a broad absorption band at 412 mm becomes increasingly stronger.

With tetrachlorophthelic anhydride (TCPA) as a depent a band appear at 380 mm, but with less intensity than with The.

We have verified all the absorption spectra of PVX films measured to date and have found that they are correct with regard to the error introduced by fluorescence emission. No differences in the spectra were observed with the samples situated just before the PDS photo cell and at a distance of about 15 cm from it. This proves that the intensity of emitted light from the sample (fluorescence) and collected by the photo cell is negligible compared with the light passing through the samples.

With the Aminco-Bowman spectrophotofluorometer emission spectra of some PVK films (pure and doped) were mensyred. As is already known, departs quench the fluorencomes of PVK.

## EPR measurements !

With a number of TVK cauples mensuroments were nade in the dark and under exposure to a meroury high pressure lamp. The followin results wore obtained:

Pyk (purc)

PVK (+ 1% p-chloranil)

PVK (+ 1% 1,2-benz-

"anthraquinone = BA) : ..

·PVK (+ 10% p-chloranil).

PVK (+10% THF)

. DAK (+ 70% BV)

: PVK (+ 10% TCPA)

PVK (+ 10% tetracyano-

quinodinethane - TCNQ)

· PVK (+ 50% p-chloranil).

PVK (+ 50% THF)

. PYK (+ 50% BA)

· Pyk (\* 50% TOPA)

Pyk (+ 50% reng)

no EPR signal

1 woak signal.

в и 2.0026 АН и 3.55 gauss disappears on illumination

ino signal .

1 very strong signal

# g = 2.0033 ΔH = 1.56 ganos

the amplitude diminishes upon illusination ..

...l signal

В н 2.0026 Ан н 3.5 gausa

implitudo diminishos upon

.illumination

one signal

2 vory strong, superposed signal

"E .w 2.0033 △112 " 2.5 gauna

to help to me. m. . it's

: .. Ang .. 3 garen

A discussion of these results will be given in our next · Comprehensive Raport.

# 3. Mectrostatic measurements : ... ......

:. These have been continued with PVK films of varying dopant .concentrations. Efforts were made, too, to simplify the methe of step-wise exposure as used till now. Also, measurements we made with strongly absorbed light to check the applicability .. Li's and Regensburger's theory to organic polymer films.

# . 4. Dark- and photo-conductivity of PVK films i

Measurements were continued with the emphasis on investigati : electrode effects (NESA glass, indium, silver, tin, load and Samples used for these studies have been restricted to pure and PVK doped with 1% THE and 1% BA.

# 5. Patent literature study of organic photoconductors 1

**第一年点** 

A list of organic materials patented for application in ele static imaging systems has been made, which is being copied will be sent to XEROX. This literature study was intended : .. check the possibilities for the syntheses of new materials hero not been used until now for xerography.

Geneva, August 24, 1964 III/isch/Z-502 W. Geneva, August 24, 1964 :. MI/icch/2-502

THE CUUDY OF FUNDAMENTAL ASPECTS RELATED THE TO YELLEGON OM HOUTANNO-OTOMY OF PRINC CHARGE CARRIERS IN ORGANIO HAPTERALS

XEROX COMPORATION Research & Engineering Center 800 Phillips Road

Webston
How York, WA

Giacomo Barchietto, Holant Hoegl, Adolf Stoinemenn and Pemolies Par-

This latter-report describes the work fone during the meating of annotate billion

The tork we did who concerned uninky with the fellowing points:

- Proparation of himsly consistive PYM layers strongly absorbent in the UV and visible regions of the opentrum.
  - Continuation of managements of dyc-sensitived IVK layors.
  - Plus reacence noncurements on various IVE films.
- Thermolyminecoonce measurements on pure FVK films.

#### 1. Highly sensitised NYK

As mentioned in our latest letter-report, No. 20, we have propared double layers of both FVI and 2.4.7-trinitrofluoreness (THF)(in Lucite 2046 resin binder). These double layers showed very rapid photo-induced and slow dark decay. We observed that a westdual charge stayed on the plates, and that the sucurt of it depended on the thickness of the top Lucite 2046 resin layer.

We made a number of experiments to reduce the thickness of the Lucite top layer by the dip conting techniques. We found that the solvent removes too much of the base coating, and that it is too difficult to prepare films of less than 10<sup>-4</sup> on thickness.

For those reasons, we next used the glow discharge polymerization process" to evercent strongly deped PVK layers of about 5...8 m thickness, we obtained very satisfactory results with this technique. Mighly deped FVK layers that show too fact a dark discharge may thus be evercented with a very thin insulating film, which reduces very effectively the dark discharge of the photoconductive layer; however, these layers are not sufficiently thick to cause significant residual charges upon illumination.

We made emperiments with two types of leyeur:

- PVI + TIP (1:1, nolar ratio 6:5) and
- FVE + p-chloranil [pd4] (10:1, nolaw ratio 15:1).

and A. Bradley and J.P. Masmos, J. Electrochem. Soc. 110 (1969), 154,

These photoconductive layers were evereented with a polymer obtained by glow discharge relymerimation of nothylmethnoryhate. (Another experiment was made with othyleilicate, but the results with methylmethnoryhate were much better, obviously ewing to much better insulating properties.)

Absorption and emission spectra of these photocondustive films were measured. Both the IVE/TEP and EVE/pGA levers are strongly absorbent between 350 and 800 m/m, where pure FVE practically does not absorb at all. No fluorescence of phosphoroscence was observed up to 700 m/m.

Dark and photo-induced discharge characteristics were neasured.

As the decay of the voltage follows over a wide range that expected for telesic behavior, we have used the well-known equations for condensors to calculate the data listed in the following tables:

Febla 1

Layort PVK + SNF (1:1), overcoated with glow discharge polymerisca methylmethacrylate. Sample No. 50.

Thiolmose: 7.0 x 10°4 cm.

	Dark (V)	430 10 /4	Licht 550 n/n	640 m/2
In Light intensity (watt com-2)  Fractonbresption A  to (see,), half-time  Cohn-len-1)  Cohn-len-1	500 6 × 10 <sup>-26</sup>	3.3 × 10 <sup>-6</sup> 1  0.5  2 × 10 <sup>-13</sup> 4.5 × 10 <sup>7</sup>	4.15 = 10 <sup>-5</sup> 0.9 0.27 7 = 10 <sup>-13</sup> 2.7 = 10 <sup>7</sup>	4.35 x 10 <sup>-1</sup> 0.45 0.5 4 x 10 <sup>-13</sup> 1.4 x 10 <sup>7</sup>
Onin .	•	0.007	0.06	0.044

Toblo 2

bayer: PVK = ptA (1:1), overcented with glow discharge polymerical mathylmethnorylate, Sample No. 51. Thickness: 7.5 x 10 ...

		Durk (D)	Light		
				375 n/n	500 nm
T.	.		7.3 × 20-5	7.2 :: 10-5	4.2 :: 10-5
Prestocias A		•	0.8	0.33	0.4
pu (202.)		106	5.5	4.6	1,2
6 (		1.7 = 10-15	5.3 = 10-14	4 × 10-14	1.5 :: 20-2
6'r.					
60 12		•	4 :: 205	3.7 × 205	2.1 × 10 <sup>4</sup>
Jain .			0.0076	0.005	0.023

These results show again what E. Lell and J. Weigl already have pointed out; namely, that THF is the best CT sensitiver found so for for FyK.

We believe that the process of everceating expanse photoconductive films with glow discharge polynomiaed than films will be very useful. These top films can be used both to enhance the insulating properties of the base layers and act as protection against photo-chamical degradation.

#### 2. Dyrunconfficed Pon

we have continued absorption, emission, and electrostatic messurements on the series of PVK layers sensitized with increasing concentrations of Rila blue A.

There measurements are consulated complicated by the fact that the dye is used in form of its salt with sulfurie sold. PVK being a bace. Disciple profess their case, it reason to a santian and at ruth a subtracte acid, temperature, to a small entent, the free dye base is formed, and therefrom the lemcobase, when hile place A is added to that Therefore, on sensitioning PVK with Kile blue A (or any other dye peachtimes), we have both the dye call and the lemcobase to complete in

In Table 3 below, results are given of fluorescence measurements of PVN complet sensitized both with OT and dye sensitizer. For comparison, results are given for the sulfate of kile Divo A and its levestage.

#### 9'r 1:7 0 3

Samples: PVK films, 5 x 10-4 on thick, with doponts.

Apparatus: Anines-Bownen, slit arrangement No. 1.

Excitation wavelength: 355 mm.

Fluorescence: 405 m m in all cases, no shifting with increasing depent concentration observed.

Pluorescence intensity: compared with quining sulfate solution in 0.1 H H2204 (307/x1) = 0.025.

Dopant	- Relative fluorescence intensity: Depart concentration (in noise,) *)			
	•	0.02 .	0,1	1
None Nilo Bluo A salv	0.270	0,192	0,159	0,120
Mile Blue A Leucobase	-	0.195	0.087	0.010
1.2-Benwanthraquinone		-	0.075	0.006
Picryl chlorido	-		0.100	0.024
THE	•	-	0,073	0.005
Totrachlorophthalic anhydrics	-	-	0.105	0.015

<sup>\*)</sup> At 10 mole-% dopant concentration, Thus reserved completely quenched in all cases.

## 3. Therealuninecourse of Pak

Measurements are being made at present with pure 17% layers. The reproducibility of peak height is now quite satisfactory after some changes having been made in the heating system. The wavelength of the emitted light has not been determined so far. The peak temperature is 160° M.

at liquid nitrogen temperature.

Ceneva, Movember 25, 1964

PROPERTY OF XEROX CORPORATION

THE STUDY OF FUNDAMENTAL ASPECTS
RELATED TO THE PHOTO-CREATION
AND MOBILITY OF FREE CHARGE
CARRIERS IN ORGANIC MATERIALS

for

XEROX CORPORATION
Research & Engineering Center
800 Philips Road
Webster
New York/USA

by

Giacomo Barchietto, Helmut Hoegl, Paul Rathgeb,
Adolf Steinemann, and Domokos Tar

March 1965

BATTELLE MEMORIAL INSTITUTE
International Division
7, route de Drize
Geneva

### c) Conclusions

The  $dV/dt \sim V_0$  relationship measured for three pure PVK plates charged positively is shown in Fig. 9 and charged negatively in Fig. 10.

This has also been measured for two thick (35µ) plates of pure PVK, where the same behavior was observed (see Fig. 11). From these measurements, we conclude that the theory of Li & Regensburger is not applicable to pure PVK.

# C. Double layer PVK films by glow discharge overcoating

### a) General remarks

The sensitivity of photoconductive organic materials (of conductivities lower than 10<sup>-14</sup> Ohm<sup>-1</sup> cm<sup>-1</sup>) generally is very low in the visible region. Doping with suitable materials allows the absorption to be extended into the visible region. As has been outlined in our latest CPR, addition of sensitizers on the surface of PVK also results in an increase of sensitivity of these layers.

In following up the above-mentioned observations, we have made experiments to overcoat PVK layers with other layers containing CT sensitizers, especially with TNF 1:1 by weight in Lucite 2046 resin binder. Dark brown films are obtained which show strong optical absorption from about 300 up to 800 nm. We have prepared these films in varying thicknesses. In the dark, they discharged extremely slowly, but on exposure to light very rapidly. Yet we observed that there remained a residual charge even on prolonged illumination, the amount of which depended on the thickness of the Lucite layer. We were not able to reduce the thickness of the top layer by conventional coating techniques so markedly that the residual charges were negligible.

We therefore made an experiment with the so-called high-frequency, or glow-discharge, polymerization technique (2).

### b) Sample preparation

Two different base layers were used:

- 1) PVK + TNF, 1:1 by weight, i.e. molar ratio 6:5, and
- 2) PVK + pCA, 10:1 by weight, molar ratio 15:1.

For PVK + TNF, a 12 % solution was prepared in a 1:1 (v/v) solvent mixture of toluene and tetrahydrofurane. Layers were made of 4 to 8 \mu thickness according to the dip coating technique.

From the composition PVK + p-chloranil, a 7 % solution in the above solvent was used for coating; thickness: 5 to  $8\mu$ .

PVK used was thermally polymerized monomer, see CPR 4.

The glow-discharge polymerization was performed under the following conditions:

(a) Polymethylmethacrylate overcoating:

Monomer: methyl methacrylate (purum), stabilized with 1 % hydroquinone, from Fluka A.G., Buchs, Switzerland.

Discharge: 15 mn at 300 kHz.

Current intensity: 30 mA, peak to peak.

Starting pressure: 2.8 x 10-1 mmHg

Electrode distance: 70 mm Electrode surface: 145 cm<sup>2</sup>

Sample area treated simultaneously: 50 cm2.

(b) Polymethylacrylate overcoating:

Monomer: methyl acrylate, 99.5 % of Fluka.

Discharge: 10 mn at 300 kHz.

Current intensity : 50 mA.

Pressure: 3.5 x 10<sup>-1</sup> mmHg.

(c) Poly-n-butyl-methacrylate overcoating:

Monomer: n-butyl methacrylate, pract. grade, Fluka.

Discharge: 10 mn at 300 kHz.

Current int. : 60 mA.

Pressure: 3 x 10<sup>-1</sup> mmHg.

(d) Poly-ethyl-silicate overcoating:

Monomer: ethyl silicate, pract., Fluka.

Other conditions as under (c).

After glow discharge, the layers showed a slight opalescence owing to the presence of a thin film, the thickness of which could not be measured exactly with a Leitz Lichtschnittmikroskop (probably about  $0.5\,\mu$ ).

## c) Optical measurements

The absorption spectra of the above-mentioned films before and after glow discharge coating have been measured in the 350 to 850 nm region (see Figs 12 and 13). As can be seen, the optical absorption of the original PVK + dopant films is practically not affected by the above treatment; only ethyl-silicate seems to form surface compounds with the base layer.

The spectrum of the composition PVK + TNF (see Fig. 12) extends broadly in the visible range from 350 to 650 nm with an intense CT band at 417 nm ( $\epsilon$  = 2760), in which region neither PVK nor TNF absorbs significantly.

The spectrum of the PVK + pCA 10:1 (see Fig. 13) compositions is also situated in the region from 350 - 800 nm, but the absorption is much weaker (less pCA, owing to lack of solubility), and the CT band is at 567 nm ( $\epsilon$  = 320).

No fluorescence has been observed in either case from 350 to 700 nm, nor any thermoluminescence of PVK + TNF, both of which are completely quenched.

### d) E'ectrostatic and quantum yield measurements

Photo-induced discharge measurements showed that the dark discharge of the layers is weaker when the doped PVK layers are overcoated with thin insulating layers (see Figs 14 and 15) where

PMMA = poly-methylmethacrylate

PES = poly-ethylsilicate

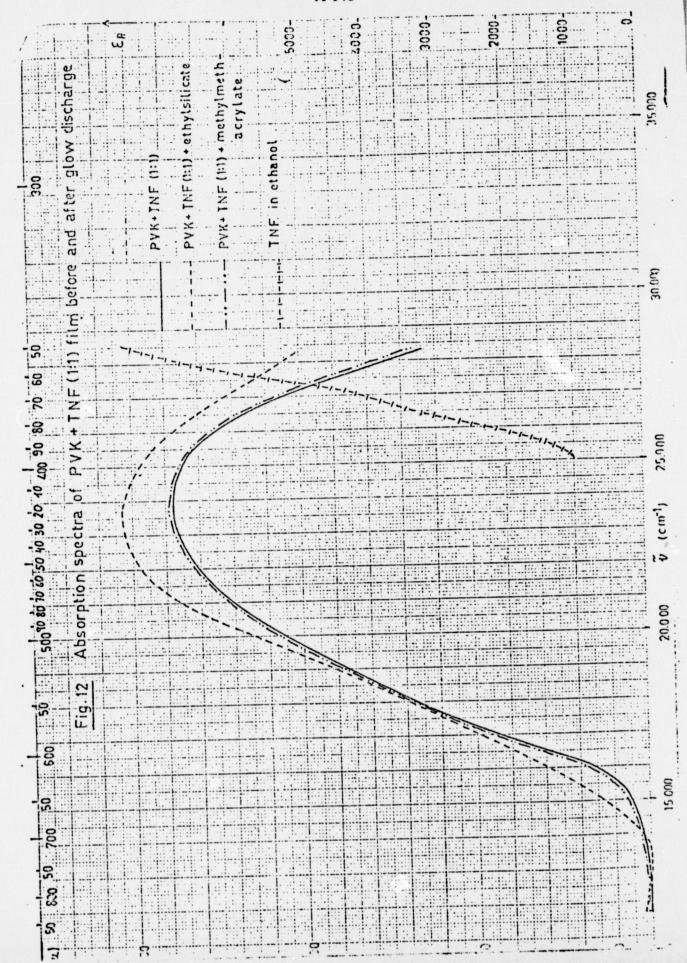
PBMA = poly-N-butyl-methacrylate and

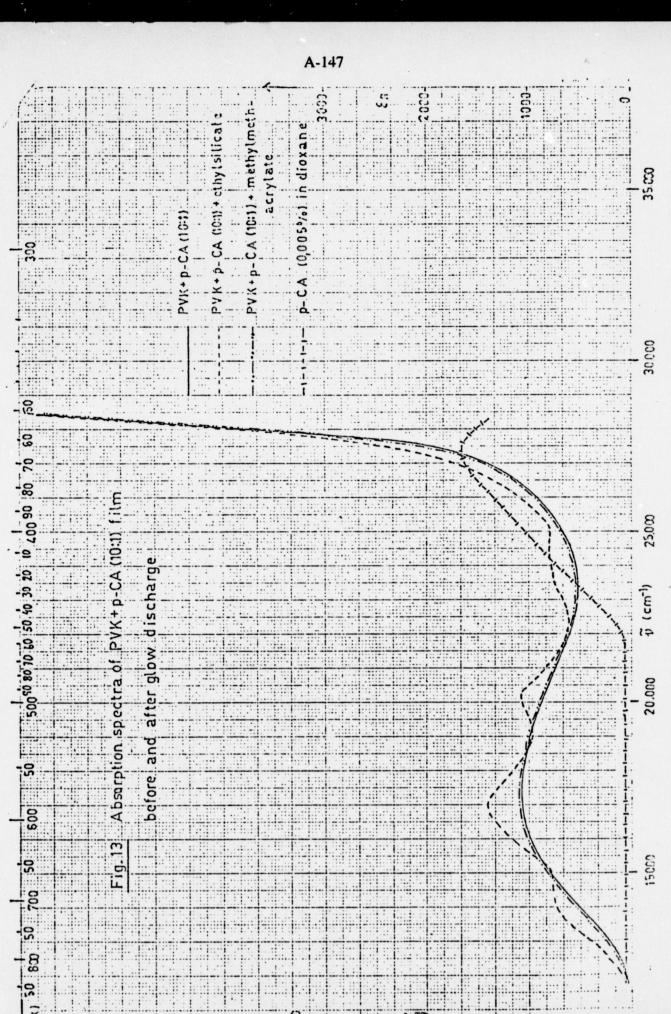
PMA = poly-methacrylate.

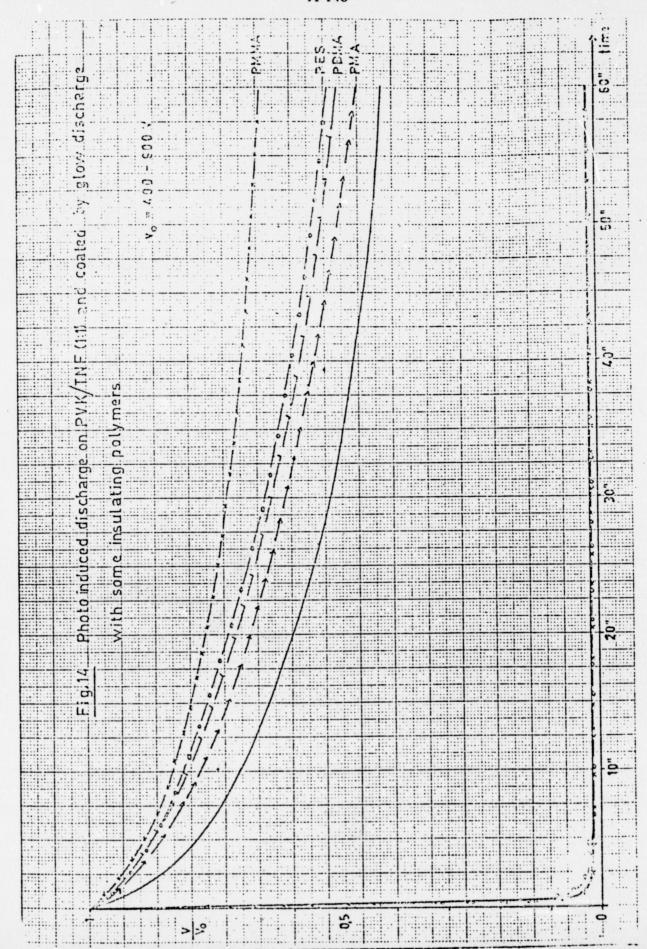
The measured effective quantum yields for PVK + TNF (1:1) and PVK + pCA (10:1) (both overcoated with PMMA) are given in Tables 5a and 5b. Fig. 16 shows them plotted as a function of wavelength.

### e) Conclusion

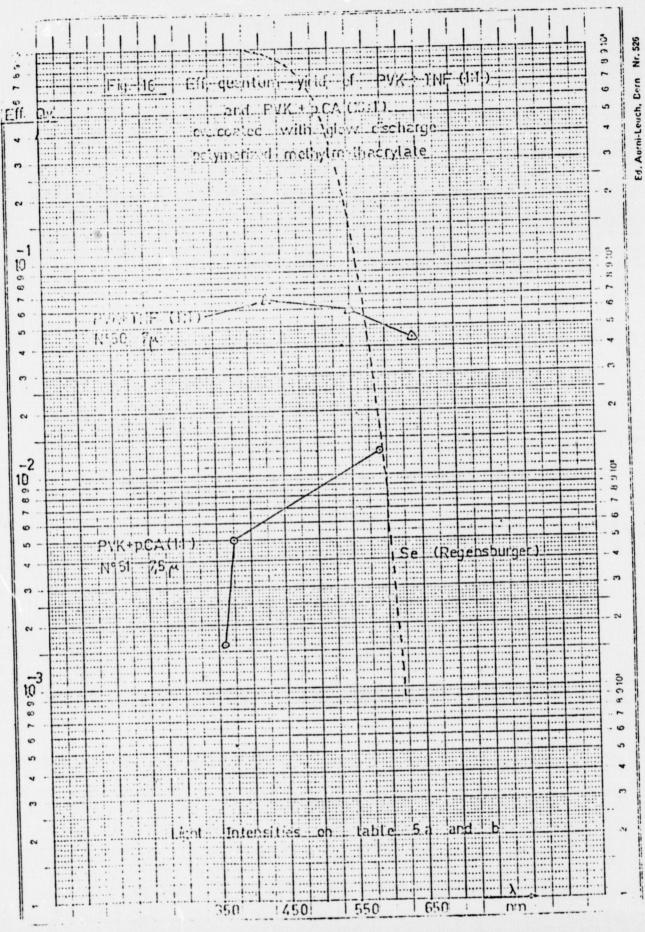
These measurements on PVK + TNF (1:1) + PMMA gave us the highest quantum yield values up to about 7 %. In Fig. 16 we have also plotted, for comparison, the effective quantum yield values for selenium as given in the work of Regensburger (1). As can be seen, they are still well below those of Se up to about 550 nm, but at longer wavelength they are higher.







		1			.,										-
		1 2		E E	á	<del> </del>			<b>!</b>	1				1	1
		1													
		*		. []	1				11					4	. 6
		-		11	1			<u> </u>	<b> </b>				1-1-		
	5.			11			l : i::	11111					1	11	
	005-008 = %	[]		1-	ĵ.								<b>^</b>	13	-
P		- i		·	<b>†</b>	+				1		ļ	1.1		
and coated	- 20	-   \d		I;	<b>?</b>		1			1::::		i i i i	1		-
ers		×		11	ļ	<b> </b> ::::	ļ	<u> </u>				I		131	5
		- Ļ-		[j-		<del> </del>				-		<u> </u>	1	- ]	
01,				11						<u>                                     </u>				1.5	
D:1		-[:		1 1											
0		-j:	-  i	1				-						[ ]  -	
S to		Ĵ									<b>::::i</b>		i î	19	
uced_discharge_on_PVK_p-CA (10:1) and co discharge_with_some_insulating_polymers		-j -		1				l					lî	1	17
≥∈		1		-7			/						<b>^</b>	-19	
ე — ლ > ი		×	11.	1									7	1.9	
So So		*	1-1-				-/-	<b> </b> ;:					1		
duced discharge on PVK discharge with some in		<u> </u>	i iji	-[-			-/-						À	17-	-
- KK			i i										1		30"
Sch			- 1 9 -	]			<b>/</b> ::							71	2
ש ב	<u>-</u> -ţ		1,1	f			1						Î	- <u>i</u>	-
5 G	L L			)									<b>^</b>		
d:			1			/-							<b>,</b>	17	
3	ij		r 1			7							<b>}</b>	13-	
Photoin by glow	Į.		71 1			/							<b>À</b>	1	20"
Ph by	₩ <u>Ī</u>		11 1			<i>!</i>							<b>}</b>	100	~
	IJ	7	1 1		1								1	1 !!!	
-15		4.//	1		_/_								7	171	
6	j	-11	7		/				4				†	61	
11::::::::::	Ĭ	1;	1	1									î	-	
	ĵ.	11.1	1	/						T is					100
	$i \mid j$	17	1												-
	1 :	1	1/											- 4	
	101		/										*		•
-       × j	10	/											/	7	
Tirli,				+++								ĵ	1		•
Ĩ-				=	- L						- x			1	
	1			0 !			50						1	: 0	



Logar. Elision | 1-10000 Unité | 62,5 nim



Parent C

ENT OF COMMERCE

Address Only: Continuous of the Paris Washington, D.C., Policit

13/5/-1

James J. Ralabate Kerox Corp., Korox Square Rochester, W. Y. 14603

Accorded benefit of Ser. No. 519,081 filed Jan. 6, 1986 now Pat. No. 3,607,258

Applicant:		
1100	al_et_al.	
Ser. No.	0	
103,54	o .	
Filed	0	
Jan. 21	1071	1 10/2
For	9-171	
For ELECTROPHO	TOGRAPHIC	
PLATE	U.S.	1.17 THE TOTAL
	M.C.	********

The case referred to above has been forwarded to the Board of Patent Interferences because it is adjudged to interfere with other cases hereafter specified. The question of priority will be determined in conformity with the Rules of Practice. The interference will be identified as No.

98,047

By direction of the Commissioner of patents and as required by Public Law No. 87-831 (76 Stat. 958), approved October 15, 1962, notice is hereby given the parties of the requirement of that law for filing in the Patent Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

The attention of all parties is directed to the fact that this interference is declared under the Rules of Practice as amended effective July 1, 1965, and as further amended effective September 2, 1969. The amendments appeared in the following publications:

Federal Register of May 14, 1965 (30 FR 6644) and of August 2, 1969 (34 FR 12629-32); Patent, Trademark and Copyright Weekly Reports for May 24, 1965 at page IV; The Official Gazette for May 25, 1965 and June-1, 1965 (Complete copy) 814 OG S1, and 815 OG S1, and in the Patents leaflet for June 15, 1965, 815 OG S1, and The Official Gazette for September 2, 1969, 866 O.G. 1.

The preliminary statements (Rutes 215 et seq.) must be filed and opposing parties notified of its filing by

(It should be filed in a scaled envelope bearing the name of the party filing it and the number of the interference.)

The preliminary statements must be served on each opposing party from whom a notice of filing a preliminary statement has been received by

If you expect to obtain the benefit of a prior application filed in this or any other country you must file a motion under Rule 231 (a) (i) unless you have been accorded such benefit in this notice. Rule 224.

Motions under Rule 231 must be filed by 570 18 1974

The interference involves your explication, claims 3(a) and 4(s) identified above and:

AUG 21 1972

PHIL - /4 . 1 - 8 . 1

Scrial No. 108,548

### Patentees:

Meredith D. Shattuck and Ulo Vahtra

Addresses: 2002 Mayfield Avenue, San Jose, Calif. 95130

1643 Nord, San Jose, California 95125

Pat. No. 3,484,237 granted Dec. 16, 1969

Ser. No. 556,932 filed June 13, 1966

For: ORGANIC PHOTOCOMDUCTIVE COMPOSITIONS AND THEIR USE IN ELECTROPHOTOGRAPHIC PROCESSES

Assignee: IEM Corp., Armonk N. Y., a corp. of New York

Attorneys: Hanifin and Clark and Edward W. Brown

Patent Operations, IEM Corp Monterey and Cottle Roads San Jose, Calif. 95114

The relation of the counts of the interference to the claims of the respective parties is as follows:

COUNTS	Shattuck et al.	Hoegl et al.		
1 2	1 5	3(s) 4(s)		

- After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims 1-10 will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

THE CHANGE

Counts compared /dam

Patent Interference Examiner

IN THE UNITED STATES PATENT OF ICE
BEFORE THE BOARD OF PATENT INTERFERENCES

SHATTUCK ET AL	} .			•
v.	{ .	Interference	No.	98,047
HOEGL ET AL	;			

MOTION UNDER RULE 231(a)(4) TO DENY HOEGL ET AL THE BENEFIT OF EARLIER APPLICATION SERIAL NO. 519,081

The party Shattuck et al hereby moves to set aside the fit of the parent application Serial No. 519,081, filed Januar : 1966, accorded to the party Hoegl et al in the Notice of Declaration of Interference. The ground for this motion is though et al is not entitled to rely upon such parent application.

because of their failure to comply with the provisions of 35 U.S.C. § 120.

Shattuck et al, accordingly, further move to dissolve to interference as to both Counts I and II (all the Counts) on the ground that, since Hoegl et al are not entitled to rely upon their parent application Serial No. 519,081, the Shattuck et al British patent No. 1,122,458, published August 7, 1968, while corresponds to Shattuck et al patent No. 3,484,237 in this interference, is a statutory bar under 35 U.S.C. g 102(b) to the currently pending Hoegl et al application Serial No. 108,548 filed on January 21, 1971, which application is at present involved in this interference. A copy of the Shattuck et al. British patent No. 1,122,458 is attached.

### The Subject Matter Of This Interference

This interference is between the Shattuck et al Unite.

Latent No. 3,484,237 and the Hoegl et al application Seri.

108,548. The two Counts in the interference are:

### Count Shattuck et al

- Claim 1. An organic photoconductive composition comprising from about 1.49 to
  about 1.23 moles of 2,4,7,trinitro-9-fluorenone per
  monomeric unit of a polymerized vinylcarbazole
  compound.
- Claim 5. An electrophotographic process comprising
  the steps of:
  forming an electrostatic
  image on a photoconductive element comprising
  from about 0.49 to about
  1.23 moles of 2,4,7-trinitro-9-fluorenone per

merized vinylcarbazole compound, and developing the electrostatic image.

monomeric unit of a poly-

### Hoegl et al

Claim 3. An organic photoconductive composition comprising one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole.

Claim 4. An electrophotographic process comprising the steps of:

forming an electrostatic image on a photoconductive element comprising one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinyl carbazole, and

developing the electrostatic image.

# The Hoegl et al Parent Application Serial No. 519,081 Does Not Support The Counts

It is submitted that the Hoegl et al parent application
Serial No. 519,081 does not support the Counts. On the contrary,
it discloses and teaches that the organic photoconductive composition of the counts (i) is merely one of many "unuseable" polymerLewis Acid combinations, and (ii) is useful as a photoconductive
composition only in combination with an overcoating comprising a
layer of an insulating organic polymer. The Counts are not
directed to this combination and do not require the overcoat.
It is therefore submitted that their parent application cannot
support any claim not limited to the presence of such an
overcoat.

Referring specifically to the Hoegl et al parent application Serial No. 519,081, that application at page 2, line 23, to page 4, line 2, discusses the prior art photoconductive compositions and how these compositions are "unuscable", particularly when high proportions of Lewis acid are employed:

"Many different photoconductive insulating materials are known for use in electrophotographic plates. \* \* \* It has recently been found that the electrical photosensitivity of various inherently photoconductive organic materials can be increased by doping them with Lewis Acids, thereby forming charge-transfer complexes. Still more recently, it has been found that certain nonphotoconductive organic polymers form highly photosensitive charge-transfer complexes when doped with Lewis Acids. Examples of photoconductive charge-transfer complexes produced by mixing two nonphotoconductive materials are further described in detail in copending applications, Ser. No. 426,409 and 426,401, both filed Jan. 18, 1965, and now U. S. Pat. Nos. 3,408,183 and 3,408,181 respectively. \* \* \* Where a high proportion of Lewis Acid is used, the plate will be highly photosensitive. However, such a plate would have such a high rate of discharge in the dark as to be unuscable in conventional imaging systems. Even where the proportion of Lewis Acid is lower, the dark decay may be so rapid as to require that the plate be charged, aged and developed in very rapid succession to produce useful images. It is necessary in conventional imaging that a plate hold a high electrostatic charge in the dark with little leakage and then quickly dissipate the charge when exposed to light." (emphasis added)

At page 5, lines 13-17, Hoegl et al, after discussing all the objects of the invention, point out the gist, or essence, of their invention:

"The foregoing objects and others are accomplished in accordance with this invention, fundamentally, by providing an electrophotographic plate which comprises a photoconductive layer comprising a polymer and a Lewis Acid and a thin coating on said layer of an insulating organic material. \* \* \*"

And at page 7, lines 2-11, Hoegl et al disclose the innumerable conventional prior art photoconductive compositions which can be overcoated according to the invention:

"Any suitable organic polymer may be mixed with a Lewis Acid to form the photoconductive charge transfer complex to be overcoated forming the plate of this invention. Polyvinylcarbazole, formaldehyde polymers, polycarbonates, polystyrenes, epoxy resins, phenoxy resins, polyurethanes and mixtures and copolymers thereof, have been found to produce especially desirable results and, therefore, are preferred. Any other suitable polymer may be used where desired.

"Any suitable Lewis Acid may be utilized with the above-mentioned polymers \* \* \* "

A-156

In order to illustrate a typical "unuscable" prior art conventional photoconductive composition wherein a high proportion of Lewis Acid is used,\* Hoegl et al set forth in their Examples I and IX a photoconductive composition comprising equal parts by weight of a polymer (polyvinylcarbazole) and a Lewis Acid (trinitrofluorenone). This "unuscable" prior art composition is then compared with the remaining Examples which do employ the Hoegl et al alleged invention, that is, the overcoat layer, which must be applied to any of the prior art photoconductive polymer-Lewis Acid compositions referred to in the application.

It is therefore evident from the entire specification and from the prior art referred to in column 1 that Hoegl et al regarded polyvinylcarbazole and trinitrofluorenone to be typical prior art examples of a polymer and a Lewis Acid that could be used in combination with their overcoat. It is also evident that Hoegl et al did not consider the use of equal parts by weight of polymer to Lewis Acid to constitute invention. For example, column 13, lines 45-50, of patent No. 3,408,183 (referred to at page 3, line 19 of the application by its Serial No. 426,409,) states that:

"While a useful photoconductor will result from mixtures comprising from about 1 to about 100 parts of resin for each one part Lewis Acid, for optimum sensitivity and reuseability it is preferred that from about 1 to about 5 parts of resin be mixed with each one part Lewis Acid."

The fact that Hoegl et al was required to alter their specification so radically when they filed the present continuation-in-part application Serial No. 108,548 is evidence that the parent application was grossly deficient. For instance, the parent application discloses that the composition of Examples I

<sup>\*</sup> Hoegl et al have asserted that their Examples I and IX do indeed employ a high propertion of Lewis Acid. See page 2 of their amendment filed January 26, 1972 in the Hoegl et al application Serial No. 108,548 involved in this interference.

and TX, using a high proportion of Lewis Acid, is "unuseable in conventional imaging systems" without the overcoat (page 3, line 27) and the dark discharge properties "undesirable" (page 14, lines 15-16). The continuation-in-part application, at pages 6 and 7, now describes the same composition as "acceptable."

A side-by-side comparison of certain portions of the Hoegl et al parent application, and the present continuation-in-part application, highlights some of the changes that were apparently deemed necessary to provide a "full, clear, concise, and exact" disclosure.

### Hoegl et al Parent Appln.

### page 5, lines 13-19

"The foregoing objects and others are accomplished in accordance with this invention, fundamentally, by providing an electrophotographic plate which comprises a photoconductive layer comprising a polymer and a Lewis Acid and a thin coating on said layer of an insulating organic material. The coating may be formed as discrete, small, closely spaced dots, so as to produce a plate capable of copying broad, solid image areas."

### page 8, lines 27-29

"The effect and advantages of the thin overcoating on a photoconductive layer may further be understood by reference to the drawing wherein:"

### page 10, lines 24-26

"As can be seen from FIG. 1, the dark discharge of the unovercoated photoconductive charge transfer layer is relatively rapid."

### Hoegl et al C-I-P

### page 4, next to last paragraph

"The foregoing objects and others are generally accomplished by providing an electrophotographic plate which comprises a photoconductive layer comprising about one part by weight of 2,4,7-trinitro-9-fluorenone per about one part by weight of polyvinylcarbazole."

### page 5, second paragraph

"The effect and advantages of the photoconductive layer of this invention may further be understood by reference to the drawing, wherein:"

### bottom of page 6

"As can be seen from Fig. 1, the slope of dark discharge curve of the unovercoated photoconductive charge transfer layer is relatively shallow and an acceptable charge is retained by the plate even after 60 seconds."

## page 14, lines 14-16

"As can be seen from FIG. 3, this uncoated plate has excellent light discharge characteristics but undesirable high dark discharge.

## page 7, end of first paragraph

"As can be seen from FIG. 2, this uncoated plate has excellent light discharge characteristics, particularly within the first 10 seconds after charging."

35 U.S.C. § 120 sets forth the statutory requirements which must be met in order for an applicant to be entitled to the benefit of the filing date of an earlier-filed United States application. This statute provides that:

"35 U.S.C. 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, \* \* \* " (emphasis added)

The first paragraph of 35 U.S.C. g 112 states:

"35 U.S.C. 112. Specification.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The requirement of 35 U.S.C. § 112 is applicable, of course, whether an applicant seeks to rely on an earlier application for interference purposes, antedating a prior art reference, etc. Fields et al v. Conover et al, 172 U.S.P.Q. 276 (CCPA, 1972); In re Smith, 173 U.S.P.Q. 679 (CCPA, 1972).

It is to be noted that the Court of Customs and Patent Appeals has laid down stringent requirements as to the disclosure required by the first paragraph of 35 U.S.C. g 112 and has stated that the recent cases "have significantly tightened up on the application of the description requirement of the first para-

graph of 35 U.S.C. 112, ..." In re Arklev et al, 172 U.S.P.Q. 524, 527 (CCPA, 1972). In <u>In re Smith</u>, 173 U.S.P.Q. 679 (CCPA, 1972), the Court held at page 633:

"In re Risse, supra, relied upon by appellant, involved, inter alia, the question of 'support' for a claimed subgenus in the disclosure of a parent application. The court did not speak in terms of the description requirement of § 112, and it is since Risse that this court has focused on the express language of the statute. The recent cases suggest a more stringent requirement for a description of the claimed invention than may nave been previously applied in cases wherein the issue was framed in terms of 'support' for claimed subject matter.

\* \* \*

"From this passage emerges the rule relied upon by appellant to the effect that the disclosure of a genus and a species of a subgenus is a sufficient description of the subgenus. We do not now feel that such a rule is consonant with either the letter or spirit of the description requirement of § 112."

The "tightened" requirements have, of course, been applied in interferences. Fields et al v. Conover et al, 170 U.S.P.Q. 276 (CCPA, 1972).

It is also to be noted that in order for Hoegl et al to rely upon their parent application, that parent application must satisfy the requirements of the first paragraph of 35 U.S.C. § 112 in regard to the invention now defined by the Counts. As stated in In re Smith, supra, at page 682:

"The principle question involved is whether or not appellant is entitled under 35 U.S.C. 120 to the benefit of the filing date of his 1947 application for the subject matter presently claimed. To comply with § 120, the prior application must satisfy 'the disclosure requirements of the first paragraph of § 112 \* \* \* with respect to the subject matter now claimed.' [cases cited]" (emphasis in text)

In the case of Fields et al v. Conover et al, 172 U.S.P.Q. 276 (CCPA, 1972), the Court stated at page 280:

"\* \* \* If Conover is allowed to copy Fields' claims merely because the application is sufficient to teach how to make and use the subject matter thereof and points indistinctly and ambiguously in the general direction

A-160

of that subject matter, the socially valuable incentive to further research and development provided by the opportunity to obtain subservient patents will be considerably diminished."

It seems clear that, even though there may be language in the Moegl et al parent application which could be construed as reading on the Counts, the parent application does not even point "indistinctly and ambiguously" in the general direction of the invention defined by the Counts and such a disclosure does not satisfy 35 U.S.C. § 112.

See also Larsen Products Corp. v. Perfect Paint Products, Inc.

128 U.S.P.Q. 326 (D. Maryland, 1961) wherein the Court, in an
infringement action, denied the patentee the benefit of his
earlier-filed application because the continuation-in-part application differed substantially from the earlier-filed application.

The Court stated at page 337:

"For the purposes we are now considering, however, the important point is not that the 1952 application was inaccurate, but that in this respect the 1952 application is so different from the 1954 statement and Claims that it did not disclose in 'full, clear, concise and exact terms' the invention claimed by claims 4 to 8 of the patent in suit."

It is a fundamental rule in the patent laws that a patent disclosure must be read as a whole in determining whether there has been compliance with 35 U.S.C. § 112. In <u>In re Long</u>, 151 U.S.P.Q. 640 (CCPA, 1966), the Court noted, after discussing the requirements of 35 U.S.C. § 112, that:

" \* \* \* We emphasize that the specification as a whole must be considered in determining its sufficiency and that such consideration must necessarily depend on the facts of each case."

Relevant also is <u>Hall v. Tavlor</u>, 141 U.S.P.Q. 821 (CCPA, 1964), wherein the Court of Customs and Patent Appeals stated that:

"We have considered the precedents cited by appellant

\* \* \* We find in the Draeger opinion what we consider

the key to determining whether a disclosure supports a

claim for interference purposes - the key which appel
lant himself recognizes - viz., does the disclosure

teach the dist of the invention defined by the

claim?" (p. 824) (emphasis in text)

A-161

Moegl et al contend that the "unuscable" composition of EXamples I and IX discloses and teaches the art the invention defined by the present Counts. It is submitted that they do not. Certainly this written description of the "unuscable" composition cannot possibly constitute a written description of "the invention" as required by the first paragraph of 35 U.S.C. g 112.

Hoegl et al cannot, of course, rely on the <u>new matter</u> set forth in their C-I-P application wherein for the first time they recognized and appreciated that the composition set forth in the Counts actually could produce a useful photoconductive plate <u>not</u> in combination with their overcoat.

This recognition and appreciation of the invention defined by the Counts undoubtedly occurred as a result of the issuance of the present Shattuck et al patent No. 3,484,237 on December 16, 1969 and/or the publication of the corresponding Shattuck et al British patent No. 1,122,458 published August 7, 1968 and New Zealand patent No. 149,083 issued on June 13, 1967. Claims directed to the invention of the Counts were not even attempted to be introduced into the parent application until their "Supplemental Amendment After Examiner's Answer" was filed in the Patent Office on August 6, 1970.

It may be noted that the Canadian Patent Office has refused to allow the addition of claims similar to the Counts of the present interference to a Canadian patent application corresponding to Hoegl et al's parent application. The Canadian Examiner held that "even if the claims are patentable they cannot be added to the claims already existing in this application since they are directed to different subject matters which are set out to solve entirely different problems." Although this finding in a foreign jurisdiction has no legal effect in the United States, it is the unbiased opinion of a patent examiner in a patent system similar to that of the United States and it does indicate that such a

person skilled in the art does not interpret the invention set forth in the Counts of the present interference as relating to the invention set forth in the Hoegl et al original application.

It is submitted that Hoegl et al never appreciated, nor recognized, and never would have presented claims to the composition of Examples I and IX, had it not been for the issuance of the Shattuck et al patent involved in this interference and/or the corresponding Shattuck et al British or New Zealand patents. For reasons such as these, the Court of Customs and Patent Appeals is particularly reluctant to permit an applicant to copy claims from a patent and "all doubts must be resolved against the copier."

Drevfus and Harrison v. Sternau, 149 U.S.P.Q. 63 (CCPA, 1966);

Jepson v. Coleman and MacCracken, 136 U.S.P.Q. 647 (CCPA, 1963);

Rainer et al v. Unger et al, 142 U.S.P.Q. 23 (CCPA, 1964).

Since Hood et al Arc Not Entitled to The Benefit Of Their Parent Application The Counts Are Unpatentable To Hood et al

The Shattuck et al British patent No. 1,122,458 (which corresponds to the Shattuck et al patent No. 3,484,237 in this interference) is a statutory bar under 35 U.S.C. § 102(b) to the currently pending Hoegl et al application Serial No. 108,548, filed January 21, 1971 (which application is presently involved in this interference).

Accordingly, the interference should be dissolved under Rule 231(a)(1) as to both Counts I and II (all the Counts) on the ground that, since Hoegl et al are not entitled to rely upon their parent application, the Counts are unpatentable to them under 35 U.S.C. g 102(b).

### CONCLUSION

It is respectfully submitted that Hoegl et al should be denied the benefit of parent application Serial No. \_519,081 and the interference should be dissolved under Rule 231(a)(1) on the ground that the Counts are unpatentable to Hoegl et al.

Respectfully submitted,

Joseph G./ Walsh (Reg. 1 Attorney for the Party Shattuck et al (Reg. No. 18,178)

JGW:mm

All commonly afford to specified the commonly the transfer and name of parties.



U.S. PERADTERETT OF COMMERCE Pater s Chilen

Address Only: COMMISSIONER OF PATENTS Washington, D.C. 2004)

. ALLO LOW ARTIS

Paper No. 31

Interference up. 20,047

Chattuck et al. Moegl of al.

Please find below a communication from the EXAMINER in this case. .

Commissioner of Patents.

protection on horions of S. Missil Calif. The notion by the party Shattuck et al to set spice the benefit of the parent application Serial No. 519,461, accorded to the party Hosgl et al, is DESITED As to count I and is GREATED as to count 2. It is considered that the subject composition and utility thereof are supported in Examples HII and HIER of that perent application. Ecwaver, as to equat 2, the subject process is not described in parent application Sarial 110, 519,031.

Accordingly, the motion to diesolve the interference as to count 2 on the ground that count 2 is ampotentiable over Shattuck Eritish Patent 1,122,450 published August 7, 1968 is GRANTED.

C. E. VAN HORMiraj

C.E.Van Horn CHARLES E. VAN HORN EXAMINER GROUP ART UNIT 10%-

Vobsonus

Laslic H. Caston Desciner of interference IN THE UNITED STATES PATERT OFFICE BEFORE THE COMMISSIONER OF PATERTS

Shattuck et al.

v. Interference No. 98,047

Hoegl et al.

### PETITION TO THE COMMISSIONER

The party Shattuck et al. respectfully petitions the Honorable Commissioner of Patents to exercise his supervisory authority pursuant to Rule 244(d) and rectify the manifest abuse of discretion by the Primary Examiner in his Decision on Motions, dated July 20, 1973, in denying the motion of the party Shattuck et al. to deny the benefit of a parent application to the party Hoegl et al. as to both counts of this interference.

The portion of the Primary Examiner's decision complained of reads as follows:

"The motion by the party Shattuck et al to set aside the benefit of the parent application

Serial No. 519,081, accorded to the party Hoegl et al.

is DENIED as to count 1 and is CRANTED as to count 2.

It is considered that the subject composition and utility thereof are supported in Examples XII and XIII of that parent application. However, as to count 2, the subject process is not described in parent application Serial No. 519,081."

The party Shattuck et al. complains of only that part of the decision which denies the Shattuck et al. motion with regard to Count 1. That decision of the Primary Examiner is submitted to be a manifest abuse of discretion for the following reasons:

<sup>\*</sup> Copy attached

### A-166

- The decision is inconsistent since there 1. is no more support in Hoegl et al. earlier application, Ser. No. 519,081 for Count 1 than for Count 2 (which the Examiner rightfully found unsupported and unpatentable over the British counterpart patent [No. 1,122,458] of the Shattuck et al. patent in interference.)
- 2. Examples XII and XIII of the Hoegl et al. earlier application do not support Count 1 and not even Hoegl et al. in its brief ever contended that they do. Hoegl et al. relied on Examples I and IX.
- 3. The Hoegl et al. earlier application fails to support either of Counts 1 and 2.

### Introduction and Fackground

This interference is between the Shattuck et al. United States patent No. 3,484,237 and the Hoegl et al. application Serial No. 108,548. The two Counts originally in the interference are:

### Count Shattuck et al.

- 1 Claim 1. An organic photoprising from about 0.49 to trinitro-O-fluorenone per monomeric unit of a polymerized vinylcarbazole compound.
- 5 Claim 5. An electrophotographic process comprising the steps of: forming an electrostatic

image on a photoconductive clement comprising from about 0.49 to about 1.23 moles of 2,4,7-trinitre-C-fluerenone per monomeric unit of a polymerized vinylcartazole compound, and

developing the electrostatic image.

### Hoegl et al.

Claim 3. An organic photoconductive composition com- conductive composition comprising one part by weight about 1.23 moles of 2,4,7,- of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole.

> Claim 4. An electrophotographic process comprising the steps of:

forming an electrostatic image on a photoconductive element comprising one part by weight of 2,4,7-trinitro-9-fluorenone per one part by weight of polyvinylcarbazole, and

developing the electrostatic image.

As is apparent, the only difference between the two counts is that Count 2 defines an electrophotographic process of utilizing the photoconductive composition of Count 1. The process of Count 2 comprises forming an electrostatic image on the photoconductive composition of Count 1 and developing that electrostatic image. The Primary Examiner correctly found that Count 2 was unsupported by the Hoegl et al. earlier application. He dissolved the interference with regard to Count 2 as being unpatentable over Shattuck et al. British patent 1,122,458, published August 7, 1968, which corresponds to the Shattuck et al. patent in this interference, because of the statutory bar under 35 U.S.C. §102(b). It is submitted that it was abuse of discretion, however, not to have reached the same conclusion with regard to Count 1. Consequently, Shattuck et al. brings this petition seeking the exercise of the Honorable Commissioner's supervisory authority pursuant to Rule 244(d).

# The Hoegl et al. Earlier Application, Serial No. 519,081, Does Not Support The Counts

It is submitted that the Hoegl et al. parent application Serial No. 519,081, now patent No. 3,607,258, does not support either of the Counts. On the contrary, it discloses and teaches that the organic photoconductive composition of the counts (i) is merely one of many "unuseable" polymer-Lewis Acid combinations, and (ii) is useful as a photoconductive composition only in combination with an overcoating comprising a layer of an insulating organic polymer. The counts are not directed to this combination and do not require the overcoat. It is therefore submitted that their parent application cannot support any claim not limited to the presence of such an overcoat.

Referring specifically to the Hoegl et al. earlier application, Serial No. 519,081, that application at page 2, line 23, to note k, line 2, discusses the prior art photocondutive

compositions and how these compositions are "unuscable," . particularly when high proportions of Lewis acid are employed:

"Many different photoconductive insulating materials are known for use in electrophotographic plates. \* \* \* It has recently been found that the electrical photosensitivity of various inherently photoconductive organic materials can be increased by doping them with Lewis Acids, thereby forming charge-transfer complexes. Still more recently, it has been found that certain nonphotoconductive organic polymers form highly photosensitive charge-transfer complexes when doped with Lewis Acids. Examples of photoconductive charge-transfer complexes produced by mixing two nonphotoconductive materials are further described in detail in copending applications, Ser. No. 426,409 and 426,401, both filed Jan. 18, 1965, and now U. S. Pat. Nos. 3,408,183 and 3,408,181 respectively. \* \* \* Where a high proportion of Lewis Acid is used, the plate will be highly photosensitive. be highly photosensitive. However, such a plate would have such a high rate of discharge in the dark as to be unuseable in conventional imaging systems. Even where the proportion of Lewis Acid is lower, the dark decay may be so rapid as to require that the plate be charged, aged and developed in very rapid succession to produce useful images. It is necessary in conventional imaging that a plate hold a high electrostatic charge in the dark with little leakage and then quickly dissipate the charge when exposed to light." (emphasis added)

At page 5, lines 13-17, Hoegl et al., after discussing all the objects of the invention, point out the gist, or essence, of their invention:

"The foregoing objects and others are accomplished in accordance with this invention, fundamentally, by providing an electrophotographic plate which comprises a photoconductive layer comprising a polymer and a Lewis Acid and a thin coating on said layer of an insulating organic material. \* \* \*"

And at page 7, lines 2-11, Hoegl et al. disclose the innumerable conventional prior art photoconductive compositions which can be overcoated according to the invention:

"Any suitable organic polymer may be mixed with a Lewis Acid to form the photoconductive charge transfer complex to be overcoated forming the plate of this invention. Polyvinylcarbazole, formaldehyde polymers, polycarbonates, polystyrenes, epoxy resins, phenoxy resins, polyurethanes and mixtures and copolymers thereof, have been found to produce especially desirable results and, therefore, are preferred. Any other suitable polymer may be used where desired.

"Any suitable Lewis Acid may be utilized with the above-mentioned polymers \* \* \* "

In order to illustrate a typical "unuseable" prior art conventional p....oconductive composition wherein a high proportion of Lewis Acid is used, Hoegl et al. set forth in their Examples I and IX a photoconductive composition comprising equal parts by weight of a polymer (polyvinylcarbazole) and a Lewis Acid (trinitrofluorenone)\*. This "unuseable" prior art composition is then compared with the remaining Examples which do employ the Hoegl et al. alleged invention, that is, the overcoat layer, which must be applied to any of the prior art photoconductive polymer-Lewis Acid compositions referred to in the application.

It is therefore evident from the entire specification and from the prior art referred to in column 1 of the resulting Hoegl et al patent No. 3,607,258, that Hoegl et al. regarded polyvinylcarbazole and trinitrofluorenone to be typical prior art examples of a polymer and a Lewis Acid that could be used in combination with their overcoat. It is also evident that Hoegl et al. did not consider the use of equal parts by weight of polymer to Lewis Acid to constitute their invention. For example, column 13, lines 45-50, of patent No. 3,408,183 (referred to at page 3, line 19 of the application by its Serial No. 426,409), states that:

"While a useful photoconductor will result from mixtures comprising from about 1 to about 100 parts of resin for each one part Lewis Acid, for optimum sensitivity and reuseability it is preferred that from about 1 to about 5 parts of resin be mixed with each one part Lewis Acid."

The fact that Hoegl et al. was required to alter their specification so radically when they filed the present continuation—in-part application Serial No. 108,548 is evidence that the parent application was grossly deficient. For instance, the parent application discloses that the composition of Examples I

<sup>\*</sup> Hoegh rely on Examples I and IX and not EII and XIII, relied upon by the Examiner.

and IX, using a high proportion of Lewis Acid, is "unuseable in conventional imaging systems" without the overcoat (page 3, line 27) and the dark discharge properties "undesirable" (rage 14, lines 15-16). The continuation-in-part application, at pages 6 and 7, now describes the same composition as "acceptable."

A side-by-side comparison of certain portions of the Hoeglet al. earlier application, and the present continuation-in-part application, highlights some of the changes that were apparently deemed necessary to provide a "full, clear, concise, and exact" disclosure.

### Hoegl et al. Parent Appln.

### page 5, lines 13-19.

"The foregoing objects and others are accomplished in accordance with this invention, fundamentally, by providing an electrophotographic plate which comprises a photoconductive layer comprising a polymer and a Lewis Acid and a thin coating on said layer of an insulating organic material. The coating may be formed as discrete, small closely spaced dots, so as to produce a plate capable of copying broad, solid image areas."

### page 8, lines 27-29

"The effect and advantages of the thin overcoating on a photoconductive layer may further be understood by reference to the drawing wherein:"

### page 10, lines 24-26

"As can be seen from FIG. 1, the dark discharge of the unovercoated photoconductive charge transfer layer is relatively rapid."

### Hoegl et al. C-I-P

### . page 4, next to last paragraph

"The foregoing objects and others are generally accomplished by providing an electrophotographic plate which comprises a photoconductive layer comprising about one part by weight of 2,4,7-trinitro-9-fluorenone per about one part by weight of polyvinylcarbazole."

### page 5, second paragraph

"The effect and advantages of the photoconductive layer of this invention may further be understood by reference to the drawing, wherein:"

### bottom of page 6

"As can be seen from Fig. 1, the slope of dark discharge curve of the unovercoated photoconductive charge transfer layer is relatively shallow and an acceptable charge is retained by the plate even after 60 seconds."

### pare 14, lipes 14-16

"As can be seen from FIG. 3, this uncoated plate has excellent light discharge characteristics but undesirable high dark discharge."

### pare 7, end of first paragraph

"As can be seen from FIG. ?, this uncoated plate has excellent light discharge characteristics, particularly within the first 10 seconds after charging."

In its brief in opposition to the Shattuck et al. motion, Hocgl et al. never relied upon Examples XII and XIII, but relied upon Examples I and IX, of their earlier application, as supporting the counts. The Examiner has, on his own initiative, improperly concluded that as to Count 1, the "subject composition" and utility thereof are supported in Examples XII and XIII of that parent application." However, examination of these examples reveals that both are directed to the overcoated plate having the continuous insulating film (Example XII) or spaced dot pattern of insulating polymer (Example XIII) which characterizes the earlier Hoegl et al. application. This is so manifestly clear that there can be no room for argument about the point. Thus no matter what utility can be said to be shown for these examples, they show no utility for the subject matter of neither of the original counts, and especially not for Count 1. Just as clearly they do not disclose the subject matter of Count 1. The Examiner manifestly abused discretion in holding otherwise.

# Hoegl et al. Have Not Complied With 35 U.S.C. §120 or 35 U.S.C. §112

35 U.S.C. §120 sets forth the statutory requirements which <u>must</u> be met in order for an applicant to be entitled to the benefit of the filing date of an earlier-filed United States application. This statute provides that:

"35 U.S.C. 120. Penefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the conner provided by the first paregraph of recolor of the United First in an application previously Tired in the United States by the rare inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, \* \* \* "

35 U.S.C. \$112, first paragraph requires that:

"The specification shall contain a written description of the invention... to ... use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." (E-phasis added)

Thus to be entitled to a filing date the specification must disclose:

- (1) the invention, and
- (2) how to use the same, and
- (3) the best mode contemplated by the inventor of carrying out his invention.

It is not enough that the specification teach how to make the subject matter. Hoegl et al. have premised their case on the myoptic argument that because they may have complied with another requirement of the first paragraph of Section 112, they have complied with the statute. Fulfilling possibly one out of four requirements of the statute is not compliance. They have complied with none of the three requirements set forth above.

1. The Earlier Hoegl et al. Application Does Not Disclose "The Invention"

While the earlier Hoegl et al. application may disclose how to make the subject matter of the counts, it does not disclose the invention. Examples I and IX cannot constitute a disclosure of the invention defined by the counts when the specification as a whole says that these examples are "unusable in conventional imaging systems" (page 3, line 27). Examples XII, XIII and the other remaining examples deal only with the overcoated compositions. The specification never gets around to describing an imaging system or any other system, conventional or otherwise, that would be useful or workable with the mixtures of the two examples. The only thing that Hoegl et al. teach is that an essential particular overcoat layer applied over the mixtures of Examples I and 1%, might make suitable photoconductors. This is not the invention defined by the present counts.

Hoegh et al. at page 2 of their opposition to the original Shattuck et al. motion sought to gloss over the clear inadequacies of their earlier application with such self-serving, contradictory assertions that the compositions of the Examples I and IX are "preferably employed" with an overcoating, when clearly no suggestion whatever appears in the earlier specification that the compositions of the two examples could be used without the overcoating.

At page 3 of their opposition to the Shattuck et al. motion, Hoegl et al. sought to sugar coat the lack of supporting disclosure in their earlier application by suggestions that because of "rather" rapid dark decay, "it would therefore be best to take special measures in view of that property." But nowhere is any special measure recommended other than to produce a different product. Nowhere is it shown that the compositions of the two unsatisfactory examples can be made to work by themselves.

It is consistent with the facts recited above to speculate that the party Hoegl et al. probably always charged their plates positively. (The Hoegl et al. application is completely silent in regard to the sign of the charge.) As shown in Fig. 3 of the drawings of Shattuck et al. patent, it is when negative charges are employed that useful electrophotographic plates are obtained with equal weights of TNF and PVC without resorting to an insulating overcoat. The party Hoegl et al. fails to disclose this teaching.

The Earlier Hoegl et al. Application Fails to Disclose A Utility For The Invention of Count 1

The earlier Hoegl application fails to comply with the requirement that it disclose a utility for the invention. The invention here being that defined by the counts of the interference. Hoegl et al. must disclose a use for that invention. Hoegl et al. fail to disclose a use for that invention. Hoegl et al.

Recause of the high rate of discharge in the dark attributed to the compositions of Examples I and IX of the earlier application, they were said to be "unusable in conventional imaging systems." Hoegl et al. teach no system of imaging or otherwise with which the mixtures of the two examples can be used. Yet, it is well known that to be useful it is essential that the photoconductor hold the electrostatic charge in the dark with very little leakage, but provide rapid discharge where portions of the photoconductor are exposed to light. Clearly, Hoegl et al. taught that the products of the two examples could not be used.

As to any usefulness, it was necessary for Hoegl et al. to produce a new product, namely the combination of Lewis acid and certain polymers with the particular overlay. This was usefulness of a different product, not the product of the invention defined by the counts.

The Earlier Hoegl et al. Application Fails to Disclose The Best Mode Contemplated For Carrying Out The Invention Of The Counts

The Hoegl et al. earlier application not only fails to disclose the best mode contemplated for carrying out the invention of the counts of the interference, but it fails to disclose any mode. Indeed, the Hoegl et al. earlier application teaches one not even to try to use the products of the present invention, but to cast them aside and produce a different product having the particular overlay coating of the application.

The entire thrust of the earlier Hoegl et al. application is that only an overcoated product has any use. Hoegl et al. rather eloquently and forthrightly summarized the very limited aspects of their invention at page 2 of the appeal brief filed on October 17, 1969 in their earlier application, Ser. No. 519,081:

### "The Invention

"Appellants' invention lies in the utilization of a single insulating layer in conjunction with a hardward ineffective photoconductive member both to minimize dark decay as well as provide a technique for obtaining good solid area coverage in the resulting image. Appellants' have found that by placing a thin layer of an insulating material in a dot pattern on the outer surface of a photoconductive layer it is now possible to not only produce acceptable images from materials heretofore felt to be deficient in their photoconductive properties but in addition to produce high cuality images raving good solid area coverage." (Emphasis partially added)

Since Hoegl et al. taught the art that the products of Examples I and IX are "unusable," "unacceptable" or "ineffective," they are not in a good position to suggest now that they have complied with the best mode requirements of Section 112 for those examples.

Hoegl et al. Now Seek A Patent Dealing With An Invention Entirely Different From That Disclosed In Their Earlier Application

Hoegl et al., by the present interference, seek to contest priority to an electrophotographic plate made from an equal weight mixture of PVC and TNF. The Hoegl et al. earlier application taught one that this type of electrophotographic plate could not be used alone and that it was necessary to combine it with an overcoat layer. Thus Hoegl et al. seek to obtain a patent directed to a two-component system, whereas the invention which they disclosed in their earlier application is a three-component system, the latter being described by Hoegl et al. as essential and the two-component composition said to be unusable. The courts have specifically frowned on efforts such as this. On all fours is the case of In re Moreton, 312 F.2d 954, 136 U.S.P.Q. 479, (CCPA 1963), wherein the Court held that the

applicant was not entitled to the benefit of a parent application disclosing a three-component system where all of the components were said to be essential, while a continuation-in-part application related to a two-component system. At page 482 of the decision, the Court stated:

"Therefore, viewed in the light of the disclosure in Serial No. 28,521, we are convinced that that application discloses an invention directed to a three-component hydraulic fluid and lubricant but not an invention directed to a two component hydraulic fluid and lubricant, i.e. one consisting of a mixture of a particular phosphorus compound and a particular chlorinated hydrocarbon.! On that basis we find that appellant is not entitled to the benefit of the filing date of Serial No. 28,521 for the appealed claims." (Emphasis in original)

Thus, the Moreton case specifically forbids what Hoegl seeks to accomplish.

Indiana General v. Krystinel Corporation, 297 F.Supp.
427, 161 U.S.P.Q. 82 (S.D.N.Y. 1968), also specifically forbids
efforts to reach back into an earlier application which thereby
alters "the substance of the invention or makes the composition
an invention for the first time." This is another authority
which denies Hoegl et al. the benefit of its earlier filing date.

et al. applications is shown in the foregoing argument of Shattuck et al., particularly at pages 5 et seq. As pointed out therein, Examples I and IX of the earlier application are said to be "unusable in conventional imaging systems" without the overcoat layer (application page 3, line 27) and the dark discharge properties of those examples were said to be "undesirable" (page 14, lines 15-16). Yet, the application of Hoegl et al. in interference (at pages 6 and 7) now describes the same examples as being "acceptable." Clearly, Hoegl has altered its position 180 degrees. Even this was possible only because of knowledge by Hoegl et al. of the contribution made by Shattuck et al.

More it not for Shattuck et al., the discovery of the invention of the interference would have been lost. It was only after Hoegl et al. became aware of the Shattuck et al. patent disclosures that they had any appreciation or recognition of the present invention. Indeed, as pointed out from the portion quoted above of the Hoegl et al. appeal brief in the parent case, Hoegl et al. still believed as late as October 1969, that the two-component mixtures of Examples I and IX were conventional prior art and "unusable" and "ineffective." Thus the subject matter of the present interference is entirely different from that disclosed in the earlier Hoegl et al. application.

#### The Law

The Court of Customs and Patent Appeals had laid down stringent requirements as to the disclosure required by the first paragraph of 35 U.S.C. \$112 and has stated that the recent cases "have significantly tightened up on the application of the description requirement of the first paragraph of 35 U.S.C. 112, ...", In re Arkley et al, 172 U.S.P.Q. 524, 527 (CCPA, 1972).

This has taken place since 1971 starting with In re Ahlbrecht, 435 F.2d 908, 168 U.S.P.Q. 293 (CCPA 1971). In 1972 the C.C.P.A. overruled the pertinent parts of its decision in In re Risse, 578 F.2d 940, 154 U.S.P.Q. 1 (1937) on sufficiency of disclosure of the invention where there is disclosure of how to make.

This outright overruling appears in In re Smith, 458, F.2d 1329, 1395, 173 U.S.P.Q. 679, 683 (1972).

As stated in the Smith case (458 F.2d 1394):

"In re Risse, supra, relied upon by appellant, involved, inter alia, the question of 'support' for a claimed subjectus in the disclosure of a parent application. The court did not speak in terms of the description requirement of § 112, and it is since Risse that this court has focused on the express language of the statute. The recent cases suggests a more stringent requirement for a description of the claimed invention than may have been previously applied in cases wherein the issue was framed in terms of 'support' for claimed subject matter. Compare Martin v. Johnson, supra; Fields v. Conover, 443 F.2d 1386, 58 CCPA 1366 (1971); In re Lukach, supra; In re DiLeone, 436 F.2d 1033, 58 CCPA 934 (1971); In re DiLeone and Lucas, 436 F.2d 1404, 58 CCPA 925 (1971); In re Ahlbrecht, 435 F.2d 908, 58 CCPA 924 F.2d 949, 47 CCPA 709 (1960). Doubt as to the continuing vitality of Risse in light of the subsequent 'description requirement' cases has already been cast in Lukach and Fields v. Conover."

The Court then went on to overrule Risse.

Wagoner et al. v. Barger et al., 175 U.S.P.Q. 85 (C.C.P.A. 1972) affirms the conclusions in In re Smith, supra.

Another very recent case on the point of disclosure of the invention is In re Welstead, 463 F.2d 1110, 174 U.S.P.Q. 449 (CCPA 1972). In that case, the original claims defined a composition by specifying four subgenuses which they covered. The applicant then sought to delete one of the subgenuses from the claim. The Patent Office held, and the Court affirmed, that although this was an attempt to limit the scope of the claims by deleting one of the subgenuses, the disclosure did not support such a restriction. There was no question as to whether the specification taught how to make, but it was held that there was no disclosure to support the newly defined invention. Hoegl finds itself in an even worse predicament. Hoegl seeks claims broader than their original disclosure.

In the Ahlbrecht case, supra, the Court carefully dissociated the requirement of written description of the invention
from the requirement to disclose how to make and, in that case
held that although there was disclosure how to make, there was no
disclosure of the inventi

Hoegl et al. while it may disclose how to make, fails to disclose the invention. Instead it discloses as the only viable thing that might be an invention, the combination of the mixture with the essential overlay.

Attempts, such as that of Hoegl et al. here, to reach back to a parent application by expanding on its limited invention disclosure have been denounced by the courts. As the court held in <u>Indiana General</u> v. <u>Krystinel Corp.</u>, <u>supra</u>, [affirmed 164 U.S.P.Q. 321 (2nd Cir. 1970)]:

"A continuation-in-part application is not entitled to the benefit of the earlier filing date of its parent application where the changes included within the subsequent application is 'new matter' which either alters the substance of the invention or makes the composition an invention for the first time, as opposed to the situation in which the subsequent application merely contains either a language change not affecting the meaning of the prior application or a specification which narrows the scope of that which was previously claimed." (citing authorites) (Emphasis added)

The courts have also proscribed efforts to lift a portion out of context from an earlier application, so as to seek an earlier filing date. The entirety of the disclosure must be considered. In In re Moreton, supra, p.482, the Court held:

"Our decision as to whether the board was correct in finding that the claimed invention was not entitled to the benefit of the filing date of appellant's application Serial No. 28,521 requires a careful analysis of that earlier application as a whole to see what invention is disclosed therein. 35 U.S.C. 120 states that 'An application for patent for an invention disclosed \* \* \* in an application previously filed in the United States by the same inventor shall have the same effect as to such invention, as though filed on the date of the prior application, \* \* \*.' [Emphasis ours.] If appellant's invention as claimed in the appealed claims is not disclosed in Serial No. 28,521, he is obviously not entitled to the filing date of that application for the appealed claims." (Emphasis in original).

by Hoegl are admitted in the earlier application to describe something that will not work and something to be avoided, they can hardly be characterized as disclosing the invention of the present counts. Only the particular overcoat taken in combination with admitted prior art mixtures of Lewis acids and certain polymers can be said to be the invention described in the earlier Hoegl application.

In the case of Fields et al v. Conover et al, 172 U.S.P.G. 276 (CCPA, 1972), the Court stated at page 280:

"\* \* \* If Conover is allowed to copy Fields' claims merely because the application is sufficient to teach how to make and use the subject matter thereof and points indistinctly and ambiguously in the general direction of that subject matter, the socially valuable incentive to further research and development provided by the opportunity to obtain subservient patents will be considerably diminished."

It seems clear that, even though there may be language in the Hoegl et al. parent application which could be construed as reading on the Counts, the parent application does not even point "indistinctly and ambiguously" in the general direction of the invention defined by the Counts and such a disclosure does not satisfy 35 U.S.C. § 112.

See also <u>Larsen Products Corp.</u> v. <u>Perfect Paint Products</u>, <u>Inc.</u>, 128 U.S.P.Q. 326 (D. Maryland, 1961) wherein the Court, in an infringement action, denied the patentee the benefit of his earlier-filed application because the continuation-in-part application differed substantially from the earlier-filed application. The Court stated at page 337:

"For the purposes we are now considering, however, the important point is not that the 1952 application was inaccurate, but that in this respect the 1952 application is so different from the 1954 statement and Claims that it did not disclose in 'full, clear, concise and exact terms' the invention claimed by claims 4 to 5 or the patent in suit."

It is a fundamental rule in the patent laws that a patent disclosure must be read as a whole in determining whether there has been compliance with 35 U.S.C. § 112. In <u>In re Long</u>, 151 U.S.P.Q. 640 (CCPA, 1966), the Court noted, after discussing the requirements of 35 U.S.C. § 112, that:

"\* \* \* We emphasize that the specification as a whole must be considered in determining its sufficiency and that such consideration must necessarily depend on the facts of each case."

Relevant also is <u>Fall v. Taylor</u>, 141 U.S.P.Q. 821 (CCFA, 1964), wherein the Court of Customs and Patent Appeals stated that:

"We have considered the precedents cited by appellant \* \* \* We find in the Draeger opinion what we consider the key to determining whether a disclosure supports a claim for interference purposes - the key which apellant himself recognizes - viz., does the disclosure teach the gist of the invention defined by the claim?"

(p. 624) (emphasis in text)

Under the circumstances, it is submitted that the earlier Hoegl et al. application fails to disclose the <u>invention</u> of either count.

It is submitted that Hoegl et al. never appreciated, nor recognized, and never would have presented claims to the composition of Examples I and IX, had it not been for the issuance of the Shattuck et al. patent involved in this interference and/or the corresponding Shattuck et al. British or New Zealand patents. For reacons such as these, the Court of Customs and Patent Appeals is particularly reluctant to permit an applicant to copy claims from a patent and "all doubts must be resolved against the copier." Dreyfus and Harrison v. Sternau, 149 U.S.P.Q. 63 (CCPA, 1966); Jepson v. Coleman and MacCracken, 136 U.S.P.Q. 647 (CCPA, 1963); Rainer et al v. Unger et al, 142 U.S.P.Q. 23 (CCPA, 1964).

Since Hoogl et al. Are Not Entitled To The Benefit Of Their Farent Application The Counts Are Unpatentable To Hoogl et al.

The Shattuck et al. British patent No. 1,122,458\* (which corresponds to the Shattuck et al. patent No. 3,484,237 in this

<sup>\*</sup> Copy attached

interference) is a statutory bar under 35 U.S.C. \$ 102(b) to the currently pending Hoegl et al. application Serial No. 108,546, filed January 21, 1971 (which application is presently involved in this interference).

Accordingly, the interference should be dissolved under Rule 231(a)(1) as to both Counts 1 and 2 (all the Counts) on the ground that, since Hoegl et al. are not entitled to rely upon their parent application, the Counts are unpatentable to them under 35 U.S.C. § 102(b).

#### Conclusion

It is submitted that this Petition, requesting the Honorable Commissioner of Patents to exercise his supervisory authority, should be granted.

Respectfully submitted,

the Farty Joseph

Attorney for the Shat Vuck et al.

#### CERTIFICATE OF SERVICE

I hereby certify that I have forwarded one copy of the foregoing "PETITION TO THE COMMISSIONER, via first class mail this Community day of August, 1973 to Anthony W. Karambelas, Esq., c/o James J. Ralabate, Albert Mahassel and Peter H. Kondo, Xerox Corp., Xerox Square, Rochester, N.Y. 14603.

- Holdwald



U.S. C -ARTELLIST OF COLLABOR Patent Gilles

Address Only: COMMISSIONER OF PATENTS Washington, U.C. 2003

פונו פודווססק

Interference No. 50,047:

Shattuck of al.

Moore of al.

Cn Potition

The purty shatthe's et al. has filed a petition for the charains of presentably methodity with respect to the decision on members by the spinery demander insolve as it could petitioner's notion to deny the party Hosel et al., benefit of his parent application. The petition is opposed.

:

The harden of the petition expects to be that the part of the desisten of water the petition complains was an abuse of discretion in relying an enables AII and mixture in the parent method at al. emplication, now an issued patent, while the parent head at the parent heads et al. relied upon his enables I and IA, and further that the parent heads et al. cissberges indicates that the two-component composition of process count I is now useful unless used with an evenceating, having it a three-component composition.

The merits of the question of benefit of the parent Hoogl et al. care may be reviewed at final hearing and on appeal if desired, and will be reviewed on petition only to the entent of determining whether the decision complained of involved abuse of discretion or manifest error.

No such abuse or error is found in the reliance by the Primary The siner on different entertles from those proviously reliad upon by the marty heard of al. The question which the Racelsey hast cacked in whether apport is found in the payent case, not thether arguments by the opposing party in icase the best dischasure in that case.

Neither is the necessary abuse or error found in the fact that the enterples relied upon in the decision disclose three-compants compositions. The case of In re Horeton, 50 Con San, the rest to the fact that the period when the transfer at the period upon in the period as not remove autitionaria realition since in that case and count includes the limitation "consisting escentially of" while the product the limitation "consisting escentially of" while the product count upos the browns term "considered that the decision by the Primary Lucainar involved either almost of discretion or manifest error, and the emercise of supervisory authority would not be justified. Petitionar will therefore be left to the normal avenue of review indicated above.

The petition is denied.

C: Nes W. 7.000

George W. Doys Chairman Board of Patent Interferences

Acting pursuant to authority delegated by the Commissioner of laborts under hale heligh; as revised Harch 7, 1970, as set forth in the nessorandum dated Pebruary 3, 1972.

Hanifin and Jancin
Patent Operations,
IBN Corporation
Monterey and Cottle Roads
San Jose, CA 95114

(for Shattuck et al.)

James J. Relabate Kerok Corneration Kerok Square Rochester, N.Y. 14603

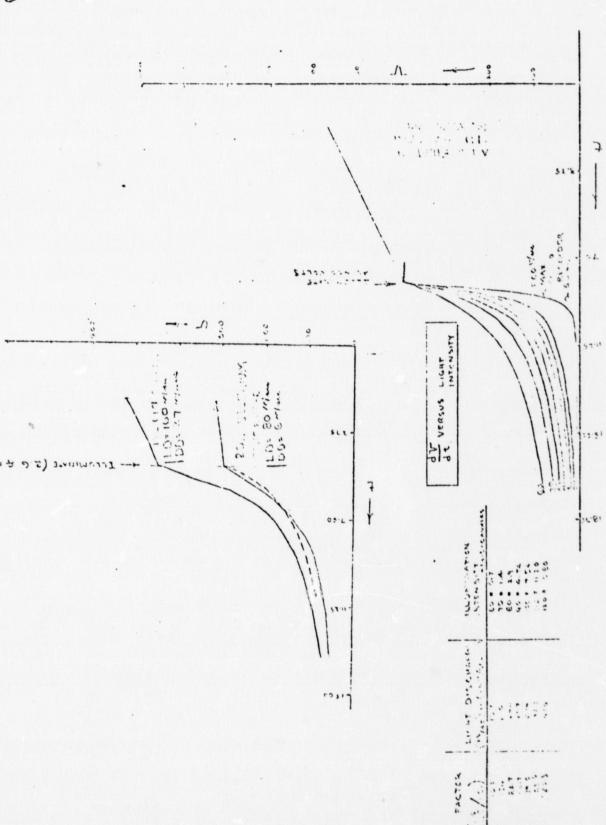
(for Hoogl et al.)

### XEROX CORPORATION

DATE 10-11-01 SUBJECT A	PROJECT No.
The southfully of a 10 pur	- I run gill a somethy would
so that were to the winter with	Lattel.
Sheet on the start of the start	led volters, ert Kan est wer as Steen of 104° PMF
- Unmerlite election in	a test offer tout withou
24 Main obying.	delemin = 100 + 1070 = 2.05 x 1/1.45 = 4.1 5.
Anitial Pat275, mild Syst hight disordance - 151 M/sec de l'extende desay - initial. Où 8 M/sec Graidand potential10, mild Allemination (fc) - 2,18.c. [-2ta [40/24(4)-44/240] - 72 teinburse (mingray) - \$10, m	
a selement son remen	
1 1 interest of the 1	
1 1 1 1 1 1 - 187 Man	
What washer withing to 5 There	
Schlaufet - 189  Little - 189  Little - 2-1+c	20
ITNESSED AND UNDERSTOOD	WORK AND RECORD
IGNED Vein W. assorti	SIGNED Lord of Andreway
ATE Oct. 30, 1862	DATE 12-27-03

62-1574

Stidlah dal 2,25



The Dante

· :: 7 - 1577

Stutante dal & 27

## XEROX CORPORATION

DATE 10-8001 SUBJECT (19:1) (PAIR: TRIE) " MELLA PROJECT NO. 11

Farm 7 1 48

10.54750 thouse for the comme is to see the post of the contraction of the original to the contract of the con

The How ( involving of the on about war for the state of the state of

WINESOFD AND UNLERSTOOD

: :::: 1)

vo. 2. / .

WORK AND RECORD

SIGNED

DATE: "" ' . ". ..

Station et al 30

62 -1074

### XEROX CORPORATION

or which will be the second	OTT THEIR
PATE //-/2-63 SUBJECT / Complete int	( - (n -1) PROJECT No.
EVIT + con flying	
- Electronate lette juffmend 11-8	
(1-1) ven-int under with -t	lane to abmost celation -
I mitial falential = -350 met  (1/21) Light towchange = 135 m/sec  (1/21) Louis dischange = C M/sec  prilestatial 0.9170  "Mummitted 11.2 & c  from "1/47 mit 135/11.2 = 12  The work solition was pollection of  Antesmed L'a majority of the TNF sure  sie page 51 for electrometer tiste on  original secting. I feed fear secreased in  [A 400, 11.2 xc, and tight = 320 m/sec]	t. 9 Jany 10 1/2
use Lestinger as surstances lights polo chan	ge · · · ·
E I To LE	
Justial Patien - 230 m  LD = 40 m/sic  DD = 26.7 m/sic  DD intend = Confined = 00 hrs 0.565 are  Missilant = 1.10 m  Missilant	70
TINESSED AND UNDERSTOOD	WORK AND RECORD
CNED	SIGNED Stary of Starte !
ATT.	DATE

## XEROX CORPORATION

There completing gover agree ingo to some and クンパーアンド ハリーン・ WORK AND RECORD SIGNED .

DATE II

# OF THE XEROX CORPORATION

DATE SUBJECT PROJECT No. 20 26 30

" P. 15 5 :. · · · · · 50 / 50 123 - 23 - 23



0.00157 57/70 PVA/711F (B)

1 Yas	15	. · · · · · · · · ·	
	217,100		. 1
	1.5		
. c.		[	 
S PIBER	1	TANK T	
(A) 50 . Ca	0-11TV		FDac.d
,	300 400	co 0/0	t/6 .

WITNESSED AND UNDERSTOOD

Honeld toomle SIGNED

DATE

WORK AND RECORD

SIGNED Mily 20 Statement

# XEROX CORPORATION 1726- 85

ATT WASHING SUBJECT	15	226.	260.00			DJECT No.	
10					"		30
		LIGHT	DARK	~e	THICK.	A LCcook	FACTO
MATERIAL TESTED	7/0	4V/4T	4V/4T			TELOTTIN.	I-ACTO
מוד/אועין ייין י	1 400	47.5	3.3	40	23.0	0. 2015	1000-
(~)	- 200	52.04	1.5	45			130.7
tites purclause	. 3.5	્રેહના	خالم	2.0	210,00	•	241.0
(*)	- 540	700.0	414	rc.	•	•	C413."
		-	•	1			
: Tio PURTICLE	÷175	50.00	3.5	15	210-15	•	1500
(.,)	-240	106.6	5.0	10	-	•	300.1
-140 PUNTAGE	+1145	13.5	13.2	š .	25/	•	2520
()	- 290	133	4.70	10		-	Q 54.0
	'						
Specials of the	+ 136	98.6	4.1	10	210,11		293
(")	-230	153.3	4.4	5		•	4-18
		·	,				
tilus putilras	+11.0	73.3	13.5	0	25/2	-	7 m
(")	- 420	1.50	4.3	5		•	54.5
							32 32
Will braine	+90 -100 1000 -+-0	200	6.7	0	35%		ş.
("' .	- 400	, 50.5	3.6	3		-	2-1
	1000	-10.5	4.0	30	550%	<i>y</i> .	10:10
·	- + -7	.3.4	ıa. t	110		••	2.5 1
	•	•	•	•			

doorsandani osta i

WORK AND RECORD

SIGNED .....

DATE

A-193

Strattick Nal 2 33

90 -1720

## XEROX CORPORATION

DATE 4/4/4 SUBJEC	CT	· * *	• • •		P	ROJECT NO	o. 7
・・・・ もっぱっていたい	•••••			20		24	
		LIGHT	DARK	1		1 400 A	
MATERIAL TESTED	₹.	4V/JT	4V/4T	-VA		ILLUMIN.	FACTOR
Person sur 1 per	4-4.	ر، ومن الله	S & 10	154/030	~		
goles pulling	+210	0.6	1.8	1 25/40		0.0633	42.0
•	-210	3.5	1.5	110/20			113.5
•							
Tolke PIRITHE.	+330	19.6	271		2102	•	267
•	-360	26.7	3.1	120/10	•	•	373
			•				
70150 PYTTINA	+170	13.3	2.4	65/40	210-150		172
	-190	16.0	20.5	70/30	•		2.53
				. • .			
Goldo Pricting	1190	17.8	2.7	55/10		•	234
	-246	22.3	21.	60/20	•	•	336
			*				
50/50 FITTINE	+100	21.8	2.1	solve		•	312
	-210	26.7	1-8	30/10		•	395
							'
actoo poutrie	1110	12.5	E.9	1015	25,2	••	1046
	-315	33.4	2-2	25/10	•	••	493
30110 PANTER	7150	160	2.4	25/10	25 %	••	150
	-175	14.2	1.8	40/10	-	••	10%
Pison son delanin	+115	41.1	2.5	20/00	250.	•	767
	-440	26.7	( (	1 00/130			216

WITNESSED AND UNDERSTOOD

Horald J. Goods SIGNED

DATE

WORK AND RECORD

SIGNED July and Lander

# XEROX CORPORATION 1726- 91

DATE \$/24/64 SUBJECT 1, 90 soutimest PROJECT No.53241 1015 V. " Notice the systallization of TNF (1) on the 30/20 and 40/60 (VIT/TNE) drying a 270 c No orystallization was absented when Siel at sock Phyrna for libery piro to tate 30/20 made and Mandes this hoh. 80/20

WITHESSED AND UNDERSTOOD

SIGNED Hovallt book

DATE May 6 1364

SIGNED Sait D. Salassy,
DATE 4/2 4/62

Stuttain et al \$ 35

## XEROX CORPORATION 1796- 17

CATE 5/5/64 SUBJECT S (Ast. P.91) (	Puit Test on
SALE STORY STORY STORY FOR	PROJECT No. 53.
and the	
Kone. May	IRLINOS STOWNEY SECTION
	ACCOL SIZEUNDO JETUVEN SACOL SIZEUNDO JETUVEN SACOL SI
and the state of t	Server 19 Server Harris Manager Control of the Server
	A SANON BLANCH
All allower dearway	ma D GOOKENNOPORNI ATANA
Particular and	The developer used to develop
Talante Worksham	toely large particle s to grant a
treven strongers	ponder, the larger gr. maker d approx-mately 30 Dune ron-
NOME THATES	1 rticks o carrier se ve to
turna ant. k/cinidand	The novel carries
particle se granufi	TONER
illipall   in larger gr. hulate   in larger g	CARRIER
carrier se ve to	PLATE
	GC 137 1.1
TONER	
CARRIER.	i e
EXPOSTL	
SUBJECT SUBJECT	and the second
	uitroses
67.	Q 60ARG Q \$ 4.5 6-5-64
WWW.	80/20 PURITWE
50-50	act 20 (potential)
9 047 - 700	\$ 10 pro 10 f 4.5
. 5-5-64	(80.20) PIK/ING
O PAK-LME	
6-6-64	-
5-5-64	OPVACINE
5-6-64	Calabara Fair
6-5-64	(80/20) BUNKNE
5-5-64	(80-20) EUM-INE
	80-20 PUH TNG
C 50120	
6-5-64	0 20/20 QUICHNO
5-5-64	84201000 MINE
	5-4-64
There there also	Satisfacione State Con 11 1
TO AND UNDERGTOOD	WORK AND RECORD
" . Would I. Comb	SIGNED
They 6, 1914	DATE TO STATE

A-196 Stottle dal & 36

DRPORATION 1701- 177

Print Test on PROJECT NO. 51-71

..... HILLYWAY CERTIAN A THE MUTICIPAL PROPERTY ALCOHOMS THE AVENUE TO THE ACCOUNTY ACC . . ahali manu mreavale fielesting 7 - develor used to develop 1 .t. lage particle s le granuil | miler, the larger gr Gulin-10.10g darpere mately 30 Emissions er carrie particles 07 -TONER\_ CONCENT 15 sec A \$ 4,5 60-50 PVK -TWF 6-6-64 5-5-64 5-5-64 5-5-64 5-5-64 @ 50150 PURITNE 6-5-64 5 - 5 - 64

The statement of the st HILD IGHIJKENINOPORSI INTENZZA .h. Jef." plimnopy turnayzah letahukhina The developer used to develop tively large particle's to granula 1 .. sider, the larger gr. nular : 1. dapproximately 30 Finicrons I rticles o carrier se ve to I the coa ser carrier particles. - to per mond rarens CARRIER PLATE 5.-5-64 60,000 Q 9 4.5 80/20 BAKKINE 3.00 --- 64. \$ 10 peop = 4.5 (80.20) PVK/TWE @ PVHITHE (80/20) BUNKNE (80-20) PUT. THE 3 NT 719 05-03 0:-- ~ ... 3 -5 -1,4 \$0/20 EVICTING 5-4-64

oddinim whois in 7 in

SIGNED Juil A. . Oleans

5 - 5 - 1. ..

WORK AND RECORD

WITNESSED AND UNDERSTOOD
SIGNED
DATE

They 6, 1764

Schuluh stal Ep 37

A-197

DRPORATION

Print Test on PROJECT NO. A. S. A.

An observed assurance of the control	The developer used to the larger grand approximately at the consistency of the consistenc
<b>B</b>	
10 ALO 194.5	(80.20) PAKIME
6 20- 20	()
DOK-141	0000
5-5-64	OPVHITHE
5-5-64	(80/20) BUNKAN
6-5-64	(88/20) 65 17 101
5-5-64	(80-20) PUR. TN
@ 50/50	80-50 BAKLING
PUTITNE	
5-5-64	0 20/20 QUELINE
VITNESSED AND UNDERSTOOD	5-4-64 WORK AND RECORD

Double S. Cons

Thay 6, 1764

IGNED

PATE

NOPORC (PIN) marayah lelahi iman rused i develop article » te granula arger gr. nulur : nately 30 Pinicrons arrier se ve to r carrier particles. or moud raise... ... TEELEUT ... 5.-2-64 NV . . - . . . 11

WORK AND RECORD SIGNED - with the white your

DATE

Statutabel Ep 38 A-198 1796- 11 RPORATION

5-5-64

Print Test on PROJECT NO.

	The state of the s
	ACOUNTY TO THE TOTAL PROPERTY OF THE TOTAL P
ARCON CONTROL PROVIDED AND ARCON CONTROL PROVIDE	The developer used to develop to ely large particle site granula powder, the larger granula it disprosimately 31 Dancrons it ticles o carrier serve to the coaser carrier particles.  TONER CARRIER CONCENT PLATE EXPOSTI MACHINE 31 31 32 33 34 35 36 36 36 37 38 38 38 38 38 38 38 38 38 38 38 38 38
TION OENS	€ 60,20 PAR/1ME
5 pre a sar	(80.20) BAKLIME
€ 50-50 € 50-50	OPVALTME
5-5-64	(80/20) BUNKNE
6-5-64	(80-20) EUM -TN:
6-5-64	0 20/20 EVICHNE
` 5 - 5 - C4	
WITNESSED AND UNDERSTOOD	WORK AND RECORD
SIGNED Would S. Coming	SIGNED July 12. Colored
DATE They 6, 1964	DATE 5 - 5 - 5 - 5 - 5

Slather dal Sy 39

## RPORATION

Print Test on PROJECT NO.

	100000 H	22. 10. 10. 10. 10. 10. 10. 10. 10. 10. 10
	MANUEL STATES	ABCORPANIAL AND ADDRESS OF ADDRESS OF ABCORPANIAL AND ADDRESS OF ADDRESS OF ABCORPANIAL AND ADDRESS OF ABCORPANIAL AND ADDRESS OF ABCORPANIAL AND ADDRESS OF A
	EXTRECOLOGINA SATURDADA	the developer wood
		inch large particle and advantage in a paper and approximate it is a particle of factor of the case of a particle of the particle
	Const.	RATION
	verse hore	OLTS FRE ATION DENS.
	ETTE OF	
l a.a	254.5	

EPNH - THE 5-5-64.

5-5-64

@ 50150 PUTITNE 6-5-64 ....

" HI SSED AND UNDERSTOOD Noul S. Comis They 6, 1964

	. *
1	Imme anyon.
"Ir	The state of the s
11	obidely dismoperious problems in the state of the state o
1	to the second se
11	THE
	HE TO GOOKENNOPORS HITENDEN
Ш	Millilli dimnopo ducerayzale lejenjeme
Ш	The developer used to develop
11	ingle large particle s se granule
111	1 Illimit B
111:	8 depures mately 30 Pinterons
111	rticles o carrier se ve to the coa ser carrier particles.
ıll l	the cost of carrier
	6 5 6 6 6 6 6 6 6 6 6 6 6 6 6 6 6 6 6 6
11.	TONER
III	CARRIER.
11	GOUCENT
-11	PLATE EXPOSTE
H	in a line in the second of the
1	[36 : 2]
	M 411 1111 8 6
	The state of the s
. 1	in the second se
	<b>1</b>
1	
iil	2
111	ie a constant
iil	
111	
11.	Active and a second of the sec
11	F. 5-4
11	1 LOACE Q 5. 4.5
1	
1	80/20 PURITHE
1	E
1	
1	\$ 10 pro m + 4.5
1	(80.20) PINITHE
1	(**
1	
8	
1	OPVALINE
4.	O bottlin.
1	
1	(80/20) Brukul
1	(00)
1	
1	(80-20) PUR. TIN.
1	(00 30)
1	EV-30 - 11 1 1 1 1 1
i	0 0/20 846/11
!	0
	60/20 Suchia
	84201.11111

5-4-64 Militaring office with WORK AND RECORD 

45 - 5" . . in

DATE

Statuck dial & 40 A-200 1796- 11. RPORATION

Print Test on PROJECT NO. NO.

	The control of the co	Acceptance of the control of the con	develops and a popular to the popula	
· · ·		25.6		
. 0	50- FO	ME		

5-5-64

5 - 5 - 64

	1 . 1 · 1 · 1 · 1 · · · · · · · · · · ·	
1	aproprié speradoles, sectores et la commentante de la commentante del commentante del commentante de la commentante de la commentante del commentante del commentante de la commentante del comm	
	Marie Million House House Control	
	1 31111111111	
	ALUVARY SELECTION OF THE PROPERTY OF THE PROPE	
١	BED GROKENKOPORS APPENDING	
	.halehit plannopy turun vanh leftingtima	
	The developer used to develop	
:	tively large particle s te granule	
l	1-wder, the larger gr. nular	
۱	11 Silling 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1	
١	a dapprosemately 3C Amicrons	
۱	1 rticles o carrier se ve to	
1	t the coa ser carrier particles.	
1	1 - de per nond carres	
	16 1631 1631 1 . 22 1	
1	TONER	
	CARRIER,	
	SONGENT	•
	PLATE	•
	d dexpostd	_
	1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1	_
	3F 1// ///////// 3	-
		-
	The state of the s	
		-
į	{ t = 1	-
	Y gr	_
1	· · · · · · · · · · · · · · · · · · ·	
į	1 be	
1	[발발] [18] [18] [18] [18] [18] [18] [18] [18	
į	THE THE PARTY OF T	
1		
	1 1 1	
	where I was a second of the second of	
	Toring the second state of the second	
	= 60 ARD CR \$ 4.5	
	0	
	81/20 PURITUE	
	\$ 10 proper 4.5	
	(80.20) PVK/TWD	
	A overi	r
	OPVALTME	
	Goodin	
	(80/20) BUNKNE	
	(80/20) BUTTOF	
	(0-1)	
	בווים דווים	
	. (80-20) PUR-TNF	
	80-20 PUT TNG	
	3-5-64	
	O MAIN DULL HALE	
	0 80/20 EVECTING	
	INCLASED A PROPERTY OF THE PARTY OF THE PART	

5-4-64 Minima 2/sec 322

SIGNED J. O. J. J. J. C. Mary

DATE

5-5-00

. 10 2 1 mon 21. 20 . 2 . 2 . 1.6. NITNESSED AND UNDERSTOOD Donall S. Conts WINED 1hay 6, 19:4 TATE

6-5-64 ....

@ 50/50 PUR/TNF

A-201 Shalled Add & 41

201	Julian		4	
RPOF	RATION	,	17794-	•

• •	
	Accept the same and the same an
	The developer used to develop to sely large particle site granula powder, the larger gr. malar and approximately 30 fluidrous
	TONER.  CARRIER.  CONCENT  PLATE  EXPOSTE
The state of the s	) is the second of the second
RATION OLTS RE ATION OENS.	D 60ACO CR 5 4.5 5-5-64
	80/30 PURITUR
CALLS OF ACRESCED TO	(80.50) by 1/1ME
1 se 1 + 8	OPVHITHE
€ 50-50 PUR -TNF 5-5-64	(80/20) BUNKNE
@ 50/50 PUR/TNF	(80-20) PUR-THE  50-20 PURTHE  50-20
5-5-64	0 20/20 EVECTIVE
10 1 20 mon 21. 20 2 16 . 4	5-4-64
NED Would J. Conta	SIGNED

DATE

They 6, 1964

10

Shatland shal & 42 RPORATION

Print Test on PROJECT NO. A.C.

ADLE OF ACRIESTMENT	TONER CARRIER SONCENT PLATE EXPOST MI TONER CARRIER SONCENT PLATE EXPOST MI TONE
(3 50-50 ·	(80/20) ev

1 1		
Apple Same Sum See	opidale. spinosbou. om el sepi	
ANDRE IN TO		
Timini.	and Alexander of the pro-	
	- Hat'D 'GNJKEZINOPOS halefa' klamone tuenavza	
	The developer used	
	tively large particle	
	ard approximately	36 Pinicrons
	1 rticles o carrier	
4	1 23 I the cou ser carr	
	1 3 1 miles me inv	d care
	ا قتا	
	TONER	
	SOUCENT	
	EXPOSTU	
	MATTER NO.	
<b>1 4//</b> /////////	90 Hot	
<b>₹ ₹//</b> /////////	in	
1. 1	<b>A</b>	
	ie:	
	1 9:	
	1 16	
	K	
		X.X.X.X
۲.		
	· · · · · · · ·	
41041		
3		
	10 - 10 - 10 - 10 - 10 - 10 - 10 - 10 -	5-5-64
	0 ARG @ \$ 4.5	0.201
0		
	80/20 PURTURE	
i		<u></u>
	\$ 10 per no + 4.5	
	(80.20) PURITIONS	
l		
:		
Ÿ	201-0	•
1 0	PVHITHE	
1		
·	(80/20) BUNKNI	
	(80)	
	7. 74 US 111 C = 193	17.
	(80- 50)	
60-20	(80-50) EUK .7	
00 -00	1 po 1 + c 3 5	
	80/20 everin	
	20/20 evichin	v.
	(8450) - 411 11111	

Arthum Where in 11

SIGNED \_ mig di molicina

WORK AND RECORD

11/1/100 There a 216. WALL AND UNDERSTOOD

PUR /TWF 5-5-64

6-5-64 ....

5-5-64

PUTITNE

@ 50/50

Monaled J. Combis Thony 15, 1964

A-203 Shillinhold & 43 RPORATION

Print Test on PROJECT NO. S. S. VILL

A CONTRACTOR OF THE PARTY OF TH	TATION STREET THE STREET STREE	TONER CARRIER CONCENT PLATE CARRIER CONCENT PLATE CARRIER CAPUSTION OF CAPUSTION	ure h
	· lace A 7 16	(80/20) 6	2
-	0 pv7 -TNF		
1	o pvi	(80-20)	604

5-5-64

5 - 5 - 64

Doubl J. Conts

Thrag 6, 1964

650150

PURTTNE 6-5-64 ....

SED AND UNDERSTOOD

· **./ ** ( ) ( ) ( ) ( ) ( ) ( ) ( ) ( ) ( )		
		IRIMNO HITWEL -
1 1 1 1 1 1 2		provobedd, sandespreas and second
Append Land to See 1		HIELMNOR INTIVERED GT SA GOL
2.4 m 1 m	obrdelg .	bleaspars' emspired to the second
	41.	Brighton Heineleben me
Tamen		Movement area a
1 111111111111111111111111111111111111		MANYON TELEVISION TO COL
R 1000000000000000000000000000000000000		GMIKENNOPORN' AFTENS
		Klauppy tumavzali letali simes
3	. 11	e developer used to develop .
3 4111111111 1		
A 1001111111111111111111111111111111111		ely large particle s ze granul4
	. 1.	wder, the larger gr. malar i
		d approximately 30 Pinicrons
a sillilli / / B		
1 °1999 11 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1		rticles o carrier se ve to
	1 17 1	the coa ser carrier particles.
	133	- las per would rarres
	33	
[		
16 4597 MMB V	TONER_	
16 19 11 IIIIIII 2	CARRIER;	
	CONCENT	f . C
B 9 II III III P 8	PLATE Y	' '5.
	EXPOSTE	
1 4 11 1111111111 3	M. TITI	'N
11: 4 11 111111111111111111111111111111	3E : 37	t *** ·
1 1/1 //////// 4		
11 1/1 ////////////////////////////////	1: 1	
I Jumini B	- 1	
1	F4:	
1	L 1	
<b>4</b>	Ed:	
1::	h 1	
	9:	
	36	
	16.	
	ide i	
_uuit't	1	<b>X.X.X.</b>
4 1		
• 1	1	•
• • •	1	
-14.242	L	A
<b>*</b>		
1. A		
" Agrico de l'entire mais italis e et		6-5-64
ععماما ج	a S	4.0
(-)		
80/20	0	11/WE
80120		0111101
	•	
		3-0 "
		3-0 "
	10-10 F	4.4
	10-10 F	4.4
	10-10 F	3-0 "
	10-10 F	4.4
(10.	20) 1	4.4
(10.	20) 1	4.4
	20) 1	4.4
(10.	20) 1	4.4
O PVKIT	20) F	14.4 NK/1WD
O PVKIT	20) F	14.4 NK/1WD
O PVKIT	20) F	4.4
(80/	20) 6 NF	U.Y NK/TWD
(80/	20) 6 NF	U.Y NK/TWD
(80/	20) 6 NF	U.Y NK/TWD
(80/ (80/	20) 6 NF	4.4 NK/TWD
(80/ (80/	20) 6 NF	4.4 NK/TWD
(80) (80) (80)	1NE 20) 6	4.4 004/146 004/146
(80) (80) (80)	1NE 20) 6	4.4 NK/TWD
(80) (80) (80)	1NE 20) 6	4.4 004/146 004/146

Mainicalore milli WORK AND RECORD SIGNED JOHN AND RECORD 

A-204

Stillet dal & 44

RPORATION

1796- 97

HAT GHIJKEMNOPORY! IT I

Print Test on

PROJECT No. 3

	- 1	ALTONO D GROWN COM DE COMMENT OF THE PARTY O
	5 7-5 E 1 1 1 T	
		A PORTE ALE LE TALES D
- Mais 1116 - 11-E	2. T	
* Intra-		
1 - 1 - 1 - 1		
Alling 1 . C		THE RESERVE OF THE PARTY OF THE
	· · · · · · · · · · · · · · · · · · ·	
7-fin_11112 5	-11	Televisian
Tarkeniles 2		
# : : : : : : : : : : : : : : : : :		
Et Turnet And I T		
		***************************************
1 1	·	
1.5 - 6 /////		
	/	
1-4 1-14 Dilling - 1	Amy of Mit	
** TON BUILDING		Education of the second of the
Protest Million - C		
Serie Million to		
		I was a second of the second of the second of
Sa 5 Hilling 9		TOTAL CORP.
Eras Inninin . A		
i wi million		
		7
B1.01 Z 10.44 - 27.0		The state of the same of the s
<b>5</b>		A Transaction of the Control of the
**** · · · · · · · · · · · · · · · · ·	* * * * * * * * * * * * * * * * * * * *	E. 7712 - 11 20
		LA TANCH CAN THE VEHICLE
		The same of the sa
		to the said of the said of
. 70-		
122		1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1

| Suc (A f 22 (C) 50/50 PUR/TNF 16-5-64 ...

Triffinger These was 16.

They c, 1964

	and bounded marks and a thought and
	11.e developer used to develop
113 41111111111111111111111111111111111	the developer used to develop
113 11111111111111111111111111111111111	tively large particle - te granule
	1 -wder, the larger gr. nultr
	1. dappros mately 36 Dinierons
III SHEET I B	a delignos matery se simerons
	" in ticles o carrier se ve to
III di III II	1:23 1 the coa ser carrier particles.
IN Justil I Miles I	1 - 1 1 - how per pond racross
110 2000 / Millian R	1.19
	L 47   "
II 4 7/ // III	; TONER
11 4 11 1111111111111111111111111111111	CARRIER,
H a II IIIIIIIII H	CONCENT :
16.3 !! !!!!!!!!! ¥	PLATE V
H 7 // // // 1	EXPOSTE .
11 4 // //////// 3	MARTIEID IN
11 411 11111111111111111111111111111111	GO TO A TO
11: 4// ////////////////////////////////	
If VI IIIIIIII 4	[1: ]
1 I	
	M:
9	kv. 1 · · · · · · · · · · · · · · · · · ·
<b>6</b> 21177111111111111111111111111111111111	je:
	96 81
-	41
salve and the sold	bri I
	te.
	Ma !
1.41.48 T	
• • •	1
-	L
3	
, want	· F'- C-C
- 6000	- 0 2 11 5 0 5 1
E COA	a a \$ 4.5
901	
90/	70 0115-17-16

\$ 10 brown + 11.2

OPVALTHE

(80/20) BUNKNE

60-20 PUT 719 05-03

O co/20 EVECTING

5-4-64
WORK AND RECORD

SIGNED ST - 57 - 14

A-205 Shalluh et al & 45

RPORATION 1726- 97

Print Test on	PROJECT No. 5324/2
	20
	A LIRLANDO IBSTUVNEV VECDEFONE  BENDENGEN - MENTANCE -
	The developer used to develop to ely large particle size granula to ely large particle size granula to electric size granula to electric size granula to electric size electric size electric size electric size electric particles.  Toner  Carrier  Carrier  Concent
	EXPOSTIC MATURITY OF THE PROPERTY OF THE PROPE
6 COAC.	
1 0	0.20) PVK/TWC
0000	THE
	olog onkar
E0-20 PUL	2/TNG 604-TNG
0 00	120 ENETINE
· · · · · · · · · · · · · · · · · · ·	5-4-64 in 2/vic in 7/1
SIGNED	Al wollowing

line af32 50/50 PURITHE

27 5.5 mon 701. 19 - 12 21.6 . 4

NESSED AND UNDERSTOOD

NED

#### Dr. John Weigle which appeared to us at that time to matter most. By hindeight, that judgment may or may not be correct. Dr. Weigle, I'll call your attention to Shattuck, DQ285. es al Emblbit "20". This is the page discussing privileged documents -- allegedly privileged documents that Mr. Hone gave us during the middle of your previous deposition taking. Do you have a copy to put MR. HCHZ: 10 in front of Dr. Weigle? Yes, I do. 11 IR. MALCH: . 12 THE WITHESS: C.K. During previous testimony I asked you a question 13 10236. concerning documents "1A" prepared by J. Hammino 14 and sent to you on March 26, 1970. I call your attention to the fact that it was written by a 16 non-attorney to a non-attorney, and Mr. Hone 17 stated that it was propared at the request or 18 under the instructions of an attorney. I will 19 ask you if you know the identity of that attorney. 20 21 Yes. 1. The was that atterney? 22 D0237. 23 J. J. Halabate. A .

DO288. I will ask you, also, concerning document "1", the subject matter is identified as "Invention Record". That expression has different meanings in different places. I will ask you, what does it mean here? Was this in the nature of a disclosure submitted to the Patent Department, a proposal that a patent application be drafted? What was it? Will you please characterize what you have called "Invention Record"?

MR. HOME: Dr. Weigle, I'll permit you to describe the type of document that an Invention Record is without specifically referring to the contents of this--of the particular Invention Record here at interest.

- A. An Invention Record here at Xerox or an Invention Proposal is a statement by a person who has conceived an idea or observed results which he believes may have sufficient merit as an innovation to be considered for a patent application by Xerox Corporation.
- DQ289. May we then draw the conclusion that on the date of April 2, 1970, Mr. Marmino was proposing that a patent application based on his work be filed?

### Dr. John Veigle

٨.	No, sir.
DQ290.	Why not?
A. '	He was proposing that some old work of his be
	considered as to whether it would have merit in
	terms of utility, value to Xerox, innovation,
	and all the things which go into judgment for
	proceeding with a patent application. It is our
•	custom at Xerox to request inventors to submit
	things regardless of any aspect of patentability
	or other legal matters.
DQ291.	So Mr. Hammino was making this submission in
	April specifically, on April 2, 1970, is that
	correct?
Α.	That's what the record says.
DQ292.	Was it on a form entitled, "Invention Record"?
	Was that a title presented on a form?
۸.	I'm sorry, I don't recall about this particular
	one. Whether it was on a form or not, it would
	have disclosed the innovative idea or results.
	It would have been signed and witnessed and under-
	stood.
	MR. WALCH: Well, I really don't know
	how I can proceed to ask questions in regard
	DQ291.  A.  DQ292.

1 25.112 2 E21.111.15

## IN THE UNITED STATES PATENT OFFICE

1971.700 15 TX HEC!

BEFORE THE BOARD OF PATENT INTERFERENCES

Shattuck et al )

v. )

Interference No. 98,047

Hoegl et al

#### NOTICE OF TAKING DEPOSITION

TO: Anthony W. Karambelas, Esq. Xerox Corporation

Xerox Square Rochester, New York

Attorney for the party Hoegl et al

SIR:

PLEASE TAKE NOTICE that pursuant to the Federal Rules of Civil Procedure, commencing at 10 o'clock in the morning, on the dates stated below, at the offices of Wiser, Shaw, Freeman, VanGraafeiland, Harter & Secrest, 700 Midtown Tower, Rochester, New York 14604, the party Shattuck et al shall take the deposition upon oral examination of each of the following persons:

Giacomo Barchietto	Montrigone, Borgosesia, VC, Italy	February 1974	20,
Helmut Hoegl	25 chemin des Palettes 1212 Grand-Lancy, Switzerland	February 1974	20,
John W. Weigl	534 Wahlmont Drive West Webster, N. Y. 14580	February 1974	20,
Peter H. Kondo	Xerox Corporation v Xerox Square Rochester, N. Y.	February 1974	21,
Anthony W. Karambelas	Xerox Corporation Xerox Square Rochester, N. Y.	February 1974	21,

The depositions shall continue from day to day until completed.

You are invited to attend and to examine the witnesses.

Pursuant to Rule 45 of the Federal Rules of Civil Procedure, a subpoena duces tecum shall be served upon each witness. The designation of the materials to be produced by each witness pursuant to such subpoena is attached to this notice as Schedule A.

Dated: February 11, 1974.

JOSEPH G. WALSH, ESQ.
Attorney for Party Shattuck et al
Monterey and Cottle Roads
San Jose, California 95114
Tel.No. 408-227-7100

Schedule of Documents for Subpoena Duces Tecum.
To Be Served on Witnesses Identified in the
Accompanying Notice

All documents referring to work done before August 1, 1964, that comes within the terms of the Count (i.e., claim 1 of Shattuck et al. United States Patent No. 3,484,237) of Interference No. 98,047 between the parties Hoegl et al and Shattuck et al now pending before the Board of Patent Interferences in the United States Patent Office.

#### PROOF OF SERVICE

I hereby certify that on February 11, 1974, I served a copy of the foregoing Notice of Taking Deposition upon Anthony W. Karambelas, the attorney for the party Hoegl et al, by mailing a copy thereof to him at his address as set out in the Notice.

Dated: February 11, 1974.

Joseph, G. Walsh

SHATTUCK ET AL.,

Movants,

V.

HOLGE ET AL.,

Respondents.

Patent Interference 98,047

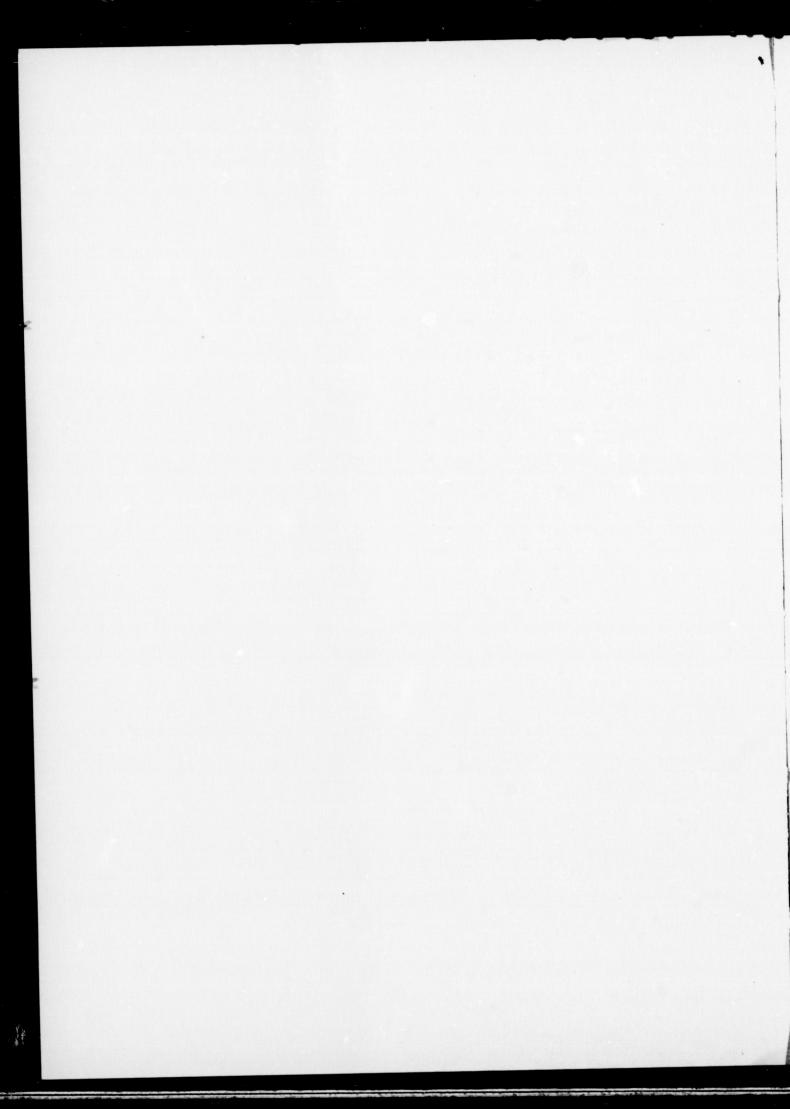
SUPPLEMENTAL MEMORANDUM OF HOEGE ET AL IN OPPOSITION TO THE SHATTUCK ET AL REQUEST FOR PRIVILEGED AND WORK PRODUCT DOCUMENTS

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

30 ROCKEFELLER PLAZA

NEW YORK, N. Y. 10020

212-480-3300



#### A-215

## ITEM No. 9

LEPLY 10 OFFICE OF GENERAL COUNSEL XI ROX CO. I ORATION XUROX CODARE ROCHESTER, NEW YORK 14644

May 3, 1974

Hon. Harold P. Burke United States District Judge United States District Court Western District of New York United States Courthouse State Street Rochester, New York 14614

Shattuck, et al. v. Hoegl, et al. Re:

Your Honor:

Enclosed herewith please find a brief in response to the supplemental memorandum in support of an order to show cause filed by the party Shattuck, et al.

In addition, because of the seriousness of the charge of fraud raised at the oral presentation by Joseph G. Walsh, counsel for the party Shattuck, et. al. and IBM at the hearing conducted before your Honor on April 30, 1974 accusing the Nerox Patent Department of perpetrating a fraud on the United States Patent Office, a very brief memorandum is being submitted responding specifically to this accusation.

We believe that the briefs will show that the charge of fraud is frivolous and is made only for the purpose of piercing the attorney-client privilege and of permitting carte blanche inspection by TBM of confidential records of a competitor.

Since the issue is so important to the parties and with respect to the doctrine of privilege in the Second Circuit, we will move the Patent Office now for an extension of time so that you may study the briefs at your convenience within the ambit of your normal schedule, should you so desire.

Respectfully submitted,

authory W Karantelin Anthony W. Karambelas

Attorney for the Party Hoegl, et al.

and Xerex Corporation

Enclosures

MEMORANDUM OF LAW SUBMITTED ON BEHALF OF PARTY HOEGL ET AL. IN RESPONSE TO FRAUD ACCUSATION AND IN OPPOSITION TO MOTION OF PARTY SHATTUCK ET AL. FOR FURTHER DISCOVERY

# MEMORANDUM

On April 30, 1974 before this Court, Joseph G.

Walsh, attorney for the party Shattuck et al. and IBM, the real party in interest, reiterated certain allegations of fraud and in addition stated in substance that he considered this to be fraud perpetrated by the Xerox Patent Department.

The party Hoegl et al. considers this to be an ill informed, irresponsible and completely erroneous accusation which must be separately addressed. It is respectfully submitted that the following chronological review of pertinent events which clearly refute this spurious accusation will clarify the acts involved and put into proper perspective the accompanying memorandum with regard to Privileged Documents.

In 1963 and 1964 Mammino and Salasny, employees of Xerox, conducted certain experimental work using PVK and TNF in a wide range of proportions that spanned the ratio that is the subject matter of this interference. This work was not considered by them or their superior to be of any significance, and was not reported to the Patent Department at that time. (Note April 5, 1974 deposition of John Weigl, page 81, A. to DQ156, page 82, A. to DQ160.)

In 1964 Hoegl and Barchietto, completely unaware of any work done by Mammino and Salasny (or by any others), independently conducted certain tests using 1:1 PVK and TNF, and recognized the utility of their composition as a xerographic photoconductor. This work was reported to the Patent

<sup>1/</sup> Pages 21 and 22 of transcript attached.

<sup>2/</sup> Pages 81 and 82 of Weigl transcript attached.

Department, and a patent application was prepared and filed in January, 1966. At that time Hoegl and Barchietto believed themselves to be the original, first and joint inventors, and so did the Patent Department.

In 1970, six to seven years after the Mammino and Salasny work and after issuance of the Shattuck and Vahtra patent, the Patent Department and the cognizant technical people conducted a diligent review of all available records to determine if Xcrox might have a prior claim or right to the invention defined in that patent. This is a normal, proper and expected activity of any patent conscious organization. As a result of this review, the work of Mammino et al. came to the attention of the Patent Department for the first time and the pertinency of the pending patent application of Hoegl et al. was determined. Immediately, parallel considerations were undertaken to assert the Xerox rights either through the Mammino et al. work or the Hoegl et al. application. An application was then drafted based on the Mammino work in order to permit prompt action, in case it was determined that Mammino had made a patentable invention.

brought forth the recognition that the Mammino et al. work done in 1963 and 1964 had been ignored as of no significance for six to seven years---until 1970. Under the foregoing facts, and under the long established doctrine in Patent Law going back to Mason v. Hepburn, 13 App. D.C. 86 (App. D.C. 1898), the Mammino et al. work was an abandoned invention or abandoned experiment of no effect with respect to a

<sup>3/</sup> Cited at page 34 of Lorenz v. Finkel, 142 USPQ 26 attached.

subsequent worker who independently makes the same discovery, recognizes its significance, and proceeds with reasonable diligence to the filing of a patent application. (also see 35 U.S.C. 102(g)).

Recognizing these facts, and the law, the Xerox

Patent Department attorneys (and outside counsel) concluded

that as between Mammino et al. and Hoegl et al., Hoegl et al.

was at the time of filing his original application, and

remains forever the original and first inventor under the

law of the issue of this interference. In fact pursuant

4/

to P. O. Rule 201(c) it became the obligation of the

Patent Department to make this legal determination.

patent application as the result of their independent work, their continuing assertion that they are the original and first inventors of all claims supported by that application is proper under the patent law, and is not in any way even tainted by fraud, regardless of whether or not at some date subsequent to their original filing they learned of the abandoned work of Mammino et al. The Patent Office has already ruled twice (first by the Primary Examiner and later on Petition to the Commissioner of Patents) that the original Hoegl et al. application supports the issue of this interference.

Xerox resists IBM's efforts for discovery so

vigorously in this proceeding because IBM is a competitor

of Xerox and it should not be allowed to pierce the attorney-client

<sup>4/</sup> Copy of Rule 201(c) attached.

privilege through a conclusory and frivolous argument of fraud. That the argument is frivolous is shown not only by the above chronology but is confirmed by previous action of the Patent Office in denying IBM's discovery on this very same broad allegation of fraud in its decision of December 20, 1973, a copy of which is attached.

Anthony W. Karambelas

Attorney for the Party Hoegl, et al.

and Xerox Corporation

<sup>5/</sup> Copy of Patent Office decision December 20, 1973 on motion by Shattuck, et al. for discovery, see page 2 especially, first full paragraph.

cally refer to the prior work of Mammino, otherwise they wouldn't have been listed there. That was a list of documents which do refer to that work. Obviously if the men write memoranda referring to the work they must have known about it. These memoranda were written before they signed their Preliminary Statement. They were written before they signed their substitute declaration in Harch, 1973. That March, 1973 supplemental declaration specifically said they are the first inventor.

Mr. Here seems to be basing some defense on the fact that the specific words "first inventor" aren't in the Preliminary Statement. For whatever comfort he can get from it, let him have it but they are in the substitute declaration which was signed.

that the frond hore was occudeted by a the Yeron fator a Department. With hereigned at the book on which the tar

had requested a patent application to
be filed on which they had made two
drafts of an application, with knowledge
of all that work done before, the work
in Switzerland, they allowed these atakements to be signed by the people in
Suitzerland and never called it to the
attention of the Patent Office.

I submit that the public interest demands a full disclosure of this. The only way to have the full disclosure is for your Honor to order production of these allegadly privileged documents.

Thank you, your Honor.

THE COURT: Are you going to have your brief by Friday?

. MR. HOME: Yes, I will.

THE COURT: I will dispose of its promptly.

HE. HOUE: Thank you very much.

MA. VATOR: Thank you very buch,

your Toron.

The Coulds Torday will be the !!

er mer en etter vint eller et till.

A. Yos.

10

11

12

13

15

16

17

181

10

20

mass. Mould you, please?

to nevel compositions of this project was directed to nevel compositions of proat acclanical attempts, based upon retariols other than IVS, and sufficiently transportant to be usuful as a Newscaphie ricrofile.

for direct projection, and our prima objectives, then, were to fobpleate— to imposite and to fobpleate— to imposite and to fobbleate which were rechanged by troop, cell-supporting and useful for temperatury progestions. These raterials were really outside the prime objectives of the project.

in. man; then you say "there materials",

what do you ween, he. Velgle?

The natorials which fall --

I'm corry, the materials in the general range of one to one by weight FVM to EMP expectations, and similar expectations which we see Commental home today, were conclude extend the means of the project and of its motor of protect, of relatively.

to the tree with our time at, no learns I found our held

		, de 6 L/
1		15 composts 15 to Er. Assales.
2	Λ.	He. Themine, as project lender, was free to take
3		reasonable excurcious as his interest distated
4		and the a response and response product lender
5 .		would by appoint to.
6	199253.	mus this work was done under your nupervision,
7		in that occurate
.8	Ď.	That is correct.
9	20159.	the olds veill have knowledge of this work at this
10		time? Apoctsheally, was there way intermediate
11		leader or manager between Mr. Massine and you?
12	۸.,	There was none.
13	20,260.	Would ether group leaders have boomledge of 167
14		in, now: Yhat do you room by "ether
15		group leaders"? Galaide Dr. Weighe's group?
16		in. valui: Well, all bight, cubble of
17		De. Weigle's group, yes.
18	٨.	At the time, as beet I can recall, this was a
19		very belief ermandica and one which we did not ballo
20 .		very grader by, and I don't have will ther it has
:1 -		
:		trace to the second of the sec

help since it establishes that while silicone release agents have been incorpo-rated in the mold, they are generally applied to the surface of the mold instead.

Rainer, as one who has copied claims from a patent, is subject to the rule that "all doubts must be resolved against the copier." Jepson v. Coleman, supra. As stated in Jepson, "\* \* It is not a question of whether one skilled in the art might be able to construct the patental's degree from the struct the patentee's device from the teachings of the disclosure of the application. Rather, it is a question whether the application necessarily discloses that particular device. See Crome v. Murrogh, supra."

Since we cannot find that Rainer's application clearly discloses the incor-poration of silicone release agents into the gosket composition, we are obliged to alirm.

52 CCPA

Court of Customs and Patent Appeals

LORENZ V. FINKL

Appl. No. 7125 Decided June 25, 1964 Rehearing denied Nov. 5, 1964

#### PATENTS

1. Board of Appeals - In general (§ 19.05)

Pleading and practice in Patent Office -In general (§ 54.1)

Under 35 U.S.C. 133 and 134, applicant need only prosecute application within six months after any action by Patent Office on application or he may appeal to Board from examiner's decision after any claim has been twice rejected; Congress did not intend that applicant should be able to prosecute application indefinitely before Office; orderly administrative process demands end to prosecution.

2. Abandonment-Application (§ 10.3)

Interference-In general (§ 41.01)

Pleading and practice in Patent Office -- In general (§ 54.1)

Following final rejection of claims on art, applicant did not appeal; instead, he filed amendment which examiner did not enter but which examiner stated would be entered, if requested, for purposes of appeal only; examiner did not regard

amendment to be a complete and proper response to rejection; hence, application was abandoned; examiner's subsequent actions (after expiration of appeal time) including suggestion of claim for interference did not revive abandoned application since authority for revival has not been delegated to examiner but is retained by Commissioner; since applica-tion was abandoned, applicant is not entitled to prevail in interference.

3. Interference - Issues (§ 41.45)

Question of whether application in interference is abundanced is ancillary to priority; question having been properly raised by opponent, Board of Patent Interferences has responsibility of deciding it.

Particular patents-Removing Gases Finkl, Method of Removing Deleterious application awarded priority against Lorenz application.

Appeal from Board of Patent Inter-ferences of the Patent Office.

Patent interference No. 91,231 between Albert Lorenz, application, Serial No. 750,167, filed July 22, 1983, and Charles W. Fink!, application, Serial No. 771,864, filed Dec. 2, 1958. From decision awarding priority to Fink!, Lorenz appeals., Affirmed; Rich, Judge, discenting with opinion; Smith, Judge, concurring with opinion. oninion.

BURGESS, DINKLAGE & SPRUNG, New York, N.Y., and MARTIN T. FISHER, Washington, D.C. (RALPH DINKLAGE, New York, N.Y., of counsel) for appellant.

PARKER & CARTER, JAMES G. STAPLES, and ARTHUR H. BOETTCHER, all of Chicago, Ill., for appellee.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

MARTIN, Judge.

This appeal is from the decision of the Board of Patent Interferences awarding priority of invention to the junior party Finkl in Interference No. 91,281 on the sole basis that the other application in the interference, serial No. 750,167, filed July 22, 1958 by the senior party Lorenz, is an abandoned application.

The record reveals that all the claims of the Lorenz application numbered 1 through 6 were finally rejected solely on art by the examiner on June 19,

1 The Finkl application involved in the interference is serial No. 777,664 filed on December 2, 1953.

1959.2 The end of the six month statutory period for response fell on December 19, 1959, and this being a Saturday, Lorenz had until December 21, 1959, to make such response as the condition of the case required.

On December 7, 1959, Lorenz submitted a paper requesting that certain amendments be made in finally rejected claims 1, 4 and 63 "to more succinctly define the present invention and to render the claims patentably definitive over the cited references." In that paper, he also argued patentability over the cited art. Lorenz did not file an appeal to the Board of Appeals.

On Deceember 23, 1959, the examiner sent a letter to Lorenz which is reproduced in toto as follows:

Responsive to amendment filed De-

cember 7, 1950.

Additional reference made of record: Vogt, 2,093,663, Sept. 21, 1927, 266-34 Vac. Dig.

The amendment dated December 7, 1959 has been considered. If and when requested, the amendment will be entered for purposes of appeal only.

For purposes of showing that the use of a closed unitary zone is an expedient of the art, Vogt is cited.

On May 20, 1960, the examiner in a letter to Lorenz suggested a claim,

2 The following claim appears illustrative of the finally rejected claims in the Lorenz application as of June 19, 1959:

1. The method of degasifying molten metal which comprises arranging the metal in the molten state in a container, exposing the upper surface of the metal to a pressure effective to cause gas dissolved in the molten metal adjacent said upper surface to escape from the molten metal, said pressure being inefective to cause dissolved gas in the molten metal remote from the upper surface to escape due to the weight of the metal, and introducing a gas into the molten metal a substantial distance below said upper surface in an amount sufficient to cause hubbling of the introduced gas through the molten metal and to circulate the molten nietal within the container causing portions thereof to move to adjacent the exposed surface, whereby improved degasification of the molten metal within the container metal within the container face,

3 With respect to illustrative claim 1 (see footnote 2) the amendment apparently involved charsing that claim so that the bithod of decasifying the molten metal is carried out in a "closed unitary zone" rather than in a "container" and also the introduction of the yes into the molten metal in the charact method is "in a connwardly inclined direction."

"found allowable," for purposes of interference. Thereupon Lorenz in an amendment of June 3, 1960 requested that the suggested claim 4 be entered for purposes of interference.

On August 16, 1960, the interference was declared. In the final paragraph of the letter of that date to Lorenz,

the examiner stated:

Claims 1-6 will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

On March 2, 1961 the interference examiner stated that Finkl alleged no date in his preliminary statement prior to the filing date of Lorenz and gave notice that judgment on the record would be entered against Finkl unless on or before May 17, 1961, he showed good and sufficient cause why such action should not be taken.

On May 17, 1961, Finkl filed a motion to dissolve the interference contending that "there has been such informality or irregularity in declaring the same as will preclude the proper determination of the question of priority of invention." Finkl urged that the "irregularity or informality in the declaration of the interference is based on the fact that the Lorenz application was abandoned long prior to the institution of this interference."

On October 12, 1961, the examiner 6 denied Finkl's motion to discolve stating:

\* \* \* The sole judge as to what

4 The suggested claim which is the count of the interference reeds:

ount of the interference reeds:

A method of removing deleterious gases from a confined volume of molten metal in a receptacle, said method including the steps of subjecting the surface of the confined volume of molten metal to a vacuum sufficient to degas the molten metal, and simultaneously passing a sufficient quantity of a carrier agent upwardly through the molten metal to induce a circulation entirely within the receptacle which brings substantially undegassed molten metal from remote areas in the receptacle to the surface.

5 Finkl also moved to dissolve on the basis that Lorenz has no right to make the claim in the interference. The examiner denied the motion to dissolve on that ground and the record indicates that Finkl did not appeal the examiner's decision on this point.

this point.

6 The record indicates that the same examiner was involved in the letter of December 23, 1960, the letter of May 20, 1850 suggesting the claim for interference, the decknation of interference on August 16, 1960, and the decksion of October 12, 1961.

constitutes "appropriate action" is the Commissioner of Patents and, through his delegated authority the examiner. It is obvious that the examiner had reversed his decision as to patentability of the Lorenz application after the presentation of the amendment dated December 7, 1959; that the emendment was responsive under Rules 113, 116 and 135 and that the application was in condition for allowance.

On November 21, 1961, Finkl petitioned the Commissioner of Patents to (a) set aside the examiner's decision of October 12, 1961, (b) declare the Lorenz application abandoned, and (c) direct the examiner to dissolve the interference.

The Commissioner on December 7, 1961 denied Finkl's petition stating:

Whether or not an application involved in interference has become abandoned is a question which is ancillary to priority and can be considered in due course by the tribunals passing on that question (Bain et al. v. Hasselstrom et al., 1948 C.D. 167, 35 CCPA 211, 76 USPQ 302). It is ordinarily desirable that this issue be considered in that matter and no sufficient reason is found for making an exception in the present case. Accordingly, the petition is denied without prejudice to the right of the petitioner to raise the issue of abandonment of the Lorenz application in subsequent proceedings in this interference.

The board then on September 28, 1962 held that the Lorenz application was abandoned and awarded priority of the subject matter in issue to Finkl. It stated:

It is apparent that the amendment [of Dec. 7, 1959] was refused entry and the final rejection was not withdrawn. It is also apparent that the examiner was not impressed with the proposed amendment since his action indicated that changing "a container" which necessarily operated under vacuum conditions to "closed unitary zone" presented no patentable change. The Vogt patent accordingly was cited as showing that the proposed change represented only an "expedient of the art."

It is clear that for the response to be such as the condition of the case required, the amendment should be such as to place the case in condition for allowance or better condition for appeal and if the latter, the filling of an appeal. These requisites should have been accomplished before the statutory period expired. Lorenz met neither of these requirements. It would seem in view of the plain requirements of Rule 116 that ordinary prudence would have dictated the filing of an appeal not later than December 21, 1959 if Lorenz intended to save the case from abandonment. In this connection it is to be noted that Rule 116(a) states (with respect to amendments placing the case in better form for consideration on appeal):

\* \* \* the admission of any such amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment under rule 135.

It is true, of course, that the examiner could reverse his opinion on patentability and withdraw the final rejection if the amendment of December 7th had placed the case in condition for allowance. The examiner action of December 23rd plainly shows he took no such action and the proposed amendment was not entered. Since no appeal was taken, it is believed manifest that Lorenz made no response within the statutory period such as the condition of the case required. \* \* \*

Referring to the examiner's letter of May 20, 1960, the board stated:

\* \* \* It is true that the examiner found allowable matter in the Lorenz application five months later when he suggested the present count on May 20, 1960, but we cannot agree that even then the case was in condition for allowance, since the case still contained six claims under rejection without appropriate action by Lorenz.

The board further stated that the "subsequent finding of allowable subject matter came too late since the examiner has no power to in effect revive an abandoned application."

Referring to a contention by Lorenz that Finkl is in effect attacking an action or ruling by the Commissioner, the board found it without merit stat-

\* \* \* The examiner has never held in the involved Lorenz application that the proposed amendment of December 7th was an "appropriate action." Under the circumstances there is nothing before us for review in this regard and the contention that we have no authority to review the

action of the Commissioner needs no comment other than to say we well recognize we have no such authority. This is not to say that we cannot review the examiner's action since his action manifestly was not the Commissioner's action.

Appellant urges that the December 1959 action could and did validly withdraw the finality of the rejection of the Lorenz application. Appellant contends that even if the December 23, 1959 action did not withdraw the finality of the rejection, it did not irreversibly spell out abandonment of the Lorenz application, and the May 20, 1900 action could and did validly withdraw the finality of the rejection. pellant further argues that the Boord of l'atent Interferences did not have the right to review the examiner's ac-

Appellee, on the other hand, argues that abandonment of an application is ancillary to priority and that the Lorenz application became abandoned December 21, 1959, by operation of law for lack of a complete and proper response to the final rejection of June 19, 1959. The appelles contends that the examiner has no discretionary power to waive the requirements of the rules

of practice.

The issue before us is whether or not the application of Lorenz is an aban-doned application. The determination of that issue is governed by the Patent Act of 1952.

[1] According to that Act, failure of an applicant to "prosecute" an application within six months after any action therein, of which notice has been given or mailed to the applicant, results in the application becoming abandoned.7 An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the board.8 Thus an applicant need

only "presecute" an application within six months after any action by the Patent Office on the application or he may appeal to the board from the decision of examiner after any of the claims had been twice rejected. We think it apparent, however, that Congress did not intend that an applicant should be able to "prosecute" his application indefinitely before the Patent Office. An orderly administrative process demands orderly administrative process demands an end to prosecution.

Rather, Congress authorized the Com-missioner to establish rules or regula-tions not inconsistent with law for the conduct of proceedings in the Patent Office.9 These rules include:

Rule 135 (in part):

135. Abandonment for failure respond within time limit. (a) an applicant fails to proscente his application within six months after the date when the last official notice of any action by the Office was mailed to him, \* \* \* the application will become abandoned.

(b) Prosecution of an application save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last of-ficial action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to say the application from abandonment.

Rule 113 (in part):

113. Final rejection or action. (a) 113. Final rejection or action. (a)
On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim (rule 191), or to amendment as specified in rule 116. \* \* \* Response to a final rejection or action must include cancellation of, or appeal from the rejection tion of, or appeal from the rejection

735 U.S.C. 133 rends:

133. Time for proscenting application Upon failure of the applicant to prosecuting application upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be recarded as abandoned by the parties thereto, unless it be snown to the antistaction of the Commissioner that such delay was unavoidmissioner that such delay was unavoid-

835 U.S.C. 131 reads;

1 DM. Appeal to the Board of Appeals An appleant for a potent, any of whose claims has been twice rejected,

may appeal from the decision of the primary examiner to the Board of Ap-peals, having once paid the fee for such appeal.

935 U.S.C. 6 reads:

§ 6. Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all daties required by law respecting the grenting and issuing of patents and the registration of trademarks; and he shall have character property belonging to the Potent Cifice. He may, subject to the unproval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. Patent Office.

of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form.

Rule 116 (in part):

116. Amendments after final action. (a) after final rejection or action (rule 113) amendments may be made canceling claims or complying with any requirements of form which has been made, and amendments present-ing rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amondment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to cave it from abandonment under rule 135. [Emphasis ours.]

[2] Applying the above rules to the factual situation before us, the action of the examiner on June 19, 1959 on the Lorenz application was a final action. Although an appeal was due on December 21, 1959 Lorenz did not ille an appeal. As of December 21, 1959, the end of the statutory period for prosecuting the application, we think the record shows that Lorenz had not filed an amendment which was a "complete and proper action as the cardition of the case may require" to save the application from abandonment. The claims stood finally rejected solely on art. The proposed amendment filed December 7, 1959 was not accepted as overcoming the art rejection by December 21, 1959 as is evident from the examiner's action of December 23, 1959, which indicated that the December 7 amendment, would be entered if and when requested for purposes of appeal only. If the examiner had regarded the amendment as a complete and proper response to the final rejection, he necessarily would have found the application allowable and there would have been no reason for the

Moreover, we think it clear from the December 7 amendment itself that Lorenz did not necessarily anticipate this amendment to be a complete and proper response to the examiner's final proper of them 19. In his removed to action of June 19. In his remarks accompanying that amendment Lorenz specifically recognized that an appeal

10 Although the record indicates that the examiner on October 12, 1961 in his decision on Finkl's motion stated, for the first time, that Lorenz's amendment dated December 7, 1969 was responsive and that the application was in condition for allowance, the record indicates that that maendment has never been entered in the application. cation.

might be necessary, using the following language:

In view of the foregoing reconsideration of the rejection and allow-ance of the claims as amended is respectfully requested. In any event entry of the instant amendment is urged as it is believed to place the application in allowable condition or at least in better condition on appeal. [Emphasis ours.]

Accordingly, since the clear import of the examiner's letter of December 23, 1959 was that the proposed emendment of December 7, 1959, did not constitute a complete and proper response to the examiner's final action of June 19, 1955, and since appellant did not file an appeal within the six month statutory time period, we agree with the board that the Lorenz application is aban-doned. As a result Lorenz is not en-titled to prevail in the interference.

We do not consider the examiner's letter suggesting a claim for interference on May 20, 1960 and his subsequent actions to have the effect of saving Lorenz's application from abandonment. Section 133 11 permits revival of an abandoned application when "it be shown to the satisfaction of the Commissioner," that delay in proceeding was unavoidable and no such showing was made. Authority for so reviving an application has not been delegated to the examiner but is retained by the Commissioner under Patent Office Rule 137.12

[3] We further do not agree with Lorenz that the board lacks the right to review the examiner's actions. The question of whether an application in interference is abandoned is ancillary to priority. That question having been properly raised by Finkl, the board had the responsibility of deciding it. Bain v. Hasselstrom, 35 CCPA 811, 165 F. 2d 456, 76 USPQ 202.

For the foregoing reasons, the decision of the board is a firmed.

RICH, Judge, dissenting.

The majority opinion, with all due re-

11 See footnote 7.

12 Rule 137 reads: 137. Revival of abandoned application An application abandoned for failure proceeds may be revived as a pend application if it is shown to the other tion of the Commissioner that the data was unavoidable. A petition to texter abandoned application must be accepanied by a vertical showing of causes of the delay, by the provinces on the delay, by the provinces filed, and by the petition fee.

spect, though full of the sound and fury of many statutes and rules, overlooks three significant factors.

#### ٨

Preliminarily, this is not a case in which an applicant is being held to strict compliance with the Roles of Practice of the United State Patent Office in the interest of preserving sound procedural requirements.

This is a case in which an applicant, who has proceeded entirely to the satisfaction of the Patent Office, I and has become involved in an interference due to procedures initiated by the Patent Office, is losing an award of priority to another inventor who, on the record, is the later inventor—a Junior Party.

This Junior Party, attempting to avoid the contest on priority which the Patent Office set up and maintained through the decisions on motions, is raising a hue and cry based on a technicality having no bearing on the public interest or on the maintenance of proper procedure in the Patent Office. Having been put under an order to show cause why priority should not be decided against him, the Junior Party asserts the Lorenz application was "abandoned," though the Patent Office, under its own rules and practice, did not consider it to be.

I will now take up the three important considerations which in my opinion demonstrate error in the conclusion of the majority and in the reasoning by which it is reached.

#### I

The first matter overlooked by the majority is that its decision flies straight in the face of this court's own helding in Bain et al. v. Hasselstrom et al., 35 CCPA 811, 165 F.2d 436, 76 USPQ 302. That was a very carefully considered case on this very issue of an application becoming abandoned by failure to respond to a final rejection and being put into an interference wherein the party who was defeated on dates attempted to win the priority decision by a technical claim of "abandonment," based on failure to respond to a final rejection.

I know there are factual differences on the basis of which an attempt might be made to distinguish the present case from the Bain case, but no such attempt has yet been made. However, there are questions there dealt with and decided

TUP to the decision of the Board of Patent interferences, which was the last act and the only round of the fight lost by appellant.

by this court which cannot be distin-

Bain was the Junior Party. He tried to win, just as Finkl does here, by a motion to dissolve on the ground of informality in declaring the interference in that the Hasselstrom application was abandoned by failure to reply to the final rejection. Bain's case was even stronger than Finkl's. No response were ever made to the final rejection. This court held there was no abandonment. The examiner had sent Hasselstrom

The examiner had sent Hasselstrom a letter suggesting a claim for interference, he made it and the interference was declared, as here. The only difference from the inetant case was that that examiner's letter was mailed before the 6-month period ended. The interference was declared after the 6 months were up.

What this court decided, after briefing by the Patent Office, on request, 25 well as by the parties, was that suggesting claims to an applicant for interference purposes is a new action in the case and that the provisions of the rules (then Rule 77, now 135) about abandonment no longer apply.

A "leading case" in the Patent Office was cited in Bain in which the claims were not made by the applicant until after the period allowed for response to a rejection (then one year). Coulzen v. Callender et al., 1902 C.D. 395. Several other cases also were cited following it, including Ex parte Kohn et al., 1932 C.D.9, 14 USPQ 175, and Ex parte Larner, 1929 C.D. 18. This court wrote a supplemental opinion on rehearing reiterating its position that suggesting a claim is a new Patent Office action. It accepted what the Patent Office action to be its policy in the Kohn case, as follows, 76 USPQ at 305:

Where claims are suggested to an applicant for interference purposes such action is deemed, as held in the above referred to Coulson v. Callender et al. decision, a new action in the case. In effect such action is an offer to the applicant of the allowance of claims for his invention if presented in the suggested form and if he can prove he is the prior inventor. The provisions of Rule 77 are not deemed to extend to actions in cases in which claims are suggested for interference provided of course such claims are presented within the designated period.

The result in the Bain case, of course, was that Hasselstrom et al. were held not to have abandoned their application though they never made era response whatever to the final rejection,

because they copied suggested claims within the time given them to do so, that suggestion having been a new action by the Patent Office.

I know of nothing to prevent an examiner from withdrawing a final rejection, sua sponte, to put an application into an interference in order to assure that the patent goes to the proper first inventor. The majority cites none. In section 11I hereof I show it is proper

procedure.

It seems to me that what the examiner did here is in the public interest. I cannot agree with the unsupported notion of the majority opinion that Primary Examiners are without authority to revive abandoned applications because of Rule 137 and an empty theory that the "Commissioner" alone retains that authority. But, as shown infra, we are not dealing with revival here. Every act done in the Patent Office below the level of the boards is in the name of the Commissioner.

Attention is called to Rules 192 and 183 under which the "Commissioner" "when justice requires" can act outside of any rules he has made. These rules are not mentioned in the majority

opinion.

II

The second point overlooked is that whether the application was ever in a state of "abandonment" was entirely dependent on whether the amendment, timely filed on December 7, 1959, was

or was not responsive.

If it was responsive, of course there was no abandonment. Either it was or it was not, and what anybody thought about it is not controlling until there is a final authoritative decision on that issue. Included here are the first thoughts of the examiner and the prob-able thoughts of the attorney. They able thoughts of the attorney. are quite irrelevant.

Let it not be overlooked that in this case, within all the rules and statutes cited by the majority, applicant made timely response to the final rejection, which response is alleged to be sufficient, under all the rules and statutes, to put the application in condition for

allowance.

If it in fact did so, there was never any abandonment.

On October 12, 1961, the examiner held the amendment to be "responsive under Rules 113, 116 and 135 and that the application was in condition for allowance." (My emphasis.)

It is also to be inferred that earlier, on May 20, 1961, in his "new action" suggesting the claim, he found the ap-

plication to be allowable, at least with that claim in it. Only "allowable" applications can be put into interference. Rule 201(b). Interference Law and Practice, Revise & Caesar, Chap. II.

The Board of Patent Interferences.

It is true, of course, that the cranainer could reverse his opinion on patentability and withdraw the front re-jection if the amendment of Descra-ber 7th had placed the case in condition for allowances. [My emphasis.]

\* \* \* an examiner can reverse his judgment as to whether or not an amendment was responsive and act on a case which he previously held abandoned. This is correct but does not fit the situation here, since the examiner never held the amendment was responsive and never previously held the case was abandoned. We cannot read into the examinar's actions holdings which he did not make on the record. [My emphasis.]

I do not understand the last statement. The words following "This is correct seem (a) a complete non-sequitar and (b) contrary to the fact of the examiner's October 12 holding of sufficiency quoted above. What did the board a mand, a label on the paper saying "Allowance, final rejection withdrawn". I do not see how the examiner coult have made & clearer ruling.

I am unable to find how the bear! arrived at a finding of a holding by the examiner of non-responsiveness e cept by denying to him the very right to change his mind which it held he had. See infra part III for further

on this right.

The board did not go into the merit of the amendment as a response me-if I understand its confusing opinic at all, it held "There is nothing befor us for review in this regard."

Consequently the responsiveness the amendment is not before this confor review as it was either not bef. the board or not decided by it ii . was.

The examiner having held that 1: amendment put the case in condicient allowance, there never was any at. donment.

The unstated presumption to derived the rationalization of the majority of ion is that a reversal in this caplay havoe with established process in the l'atent Office. The rifuation quite otherwise. It is the affirmance that

will play havor with them.

The place we look to see what the procedure now is—or is supposed to be—is the Manual of Patent Examining Procedure (MPEP), upon which appellant here strongly relies and which the majority wholly fails to mention, even those sectious considered by the board.

The fallacy into which the majority reasoning falls is the same one which the MPEP warms the examiners against in 711.03 (c), the failure to distinguish between (1) "A petition to revive an chandoned application" and (2) "a petition from an examiner's holding of abandonatat." (My emphasis.) In other words, a holding does not create an abandonneat. If there is an abandonnent, you have to revice the application. But if there is only a holding, you can argue that it was wrong. As the cited paragraph points out—and I note this particularly in refutation of the majority opinion footnetes 11 and 12 and their related text—if one is petitioning to revive, the application is assumed to be "abandoned," the matter falls under Rule 137 and the petition requires a fee of \$10. If the issue is whether the application ever became abandoned "the petition from such a holding comes under Rule 181 and does not require a fee." The majority does not seem to appreciate this cracial difference and ignores the existence of Rule 181 and the procedure established under it.

What we have in this case—the sole issue in the case—is only a question of whether the application was ever abandoned and until it is clear that it was, revival and the law and rules relating to revival are wholly irrelevant. 35 U.S.C. 133 does not control in this situation because it applies only where there is failure to prosecute within six months and the issue we are deciding is whother there was such failure. If our decision is affirmative on that issue, then the application falls within section 133; if it is negative, the section does not apply at all. Therefore on the issue the section is irrelevant. To utilize it in deciding the issue before us is to indulge the logical fallacy of petitio principii, or begging the question.

But to get back to what the existing practice is, MPEP 706.07(e) says, in part (my emphasis):

The examiner may withdraw the rejection of finally rejected claims whenever he deems the conditions appropriate for such action. If, for example, new facts or reasons are presented such as to convince the example.

aminer that the previously rejected claims are in fact allowable, then the final rejection should be withdrawn.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

This is my answer to the majority opinion's statement that the examiner here did not have the "nuthority" to do what he did because that authority (assumed to be but actually not authority to "revive") "is retained by the Commissioner under Patent Onice Rule 137."

Another significant paragraph showing what is the practice is MPEP 1161.01(n), as follows (my emphasis):

M. claims are suggested in an application near the end of the statutory period running against the case, and the time limit for making the claims extends beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the six months' period AND EVEN THOUGH NO AMENDMENT WAS MADE RESPONSIVE TO THE OFFICE ACTION OUTSTANDING AGAINST THE CASE AT THE TIME OF SUGGESTING THE CLAIMS. However, if the suggested claims are not thus made within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the six months' period. Rule 203(c).

Therein I see a clear recognition of what this court held in Bain et al. v. llasselstrom et al. I deem the majority decision to be inconsistent with the spirit if not the letter of this recognized Patent Office practice.

But it seems to me that the complete answer to the entire majority position and to the erroneous position taken by the board is in MPEP 711.03 (a) which reads (my emphasis):

711.03(a) HOLDING BASED ON INSUFFICIENCY OF RESPONSE Applicant may deny that his response was incomplete.

While the examiner has no authority to act upon an application in which no oction by applicant was taken during the statutory period, he may reverse his holding as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned, THIS IS NOT A REVIVAL OF AN ABANDONED

APPLICATION BUT MERELY A HOLDING THAT THE CASE WAS NEVER ABANDONED. See also 714.03.

I cannot say more than that. The section fits the present situation like the proverbial glove. But, since the appropriate that the proverbial glove and the section of the pellant put pivotal emphasis on that section, I am at a loss to understand why there is no mention of it in the majority opinion. It is clear to me that if the majority decision as now ex-pressed is to govern the practice, then changes are certainly going to be re-quired in the Manual because the ex-aminer is no longer going to be au-thorized to give thoughful reconsideration to his erroneous, semetimes hasty, first responses and correct them by withdrawing or otherwise undoing erroncous holdings of abandonment.

If the examiner's first word is the last word on abandonment, as the majority now seems to hold 2 then I do not see how any tribunal, including this court, can ever correct it.

I think the decision below must be reversed to maintain the present salutary proctices in the Patent Office.

SMITH, Judge, concurring.

The majority opinion reaches what I consider to be the proper result in this case and I fully agree with it. The purpose of this concurring opinion is to point out wherein I disagree with the views expressed in the dissenting opinion. To do so requires but a brief recital of facts which are not discussed in the dissenting opinion but which in my opinion make 35 U.S.C. 133 determinative of the issue.

After the final rejection of June 19, 1959, Lorenz submitted an amend-ment on December 7, 1959. This amend-ment was not catered. This is clear from the examiner's letter of December 23, 1959 which states:

The amendment dated December 7, 1959 has been considered. If and when requested, the amendment will be entered for purposes of appeal only. [Emphasis added.]

Thus, on December 23, 1959, more than 6 months after the final rejection,

2 The majority opinion says:

2 The majority opinion seys:

• • • since the clear inport of the examiner's letter of December 23, 1959 has that the proposed amendment of December 4, 1959, did not constitute a complete and proper response to the examiner's final action of June 19, 1859 and since appellant did not file an appeal within the six month statutory time period, we agree with the board that the Lorenze application is abandoned.

there was no responsive amendment entered in the case. Appellant might well tered in the case. Appellant might well have requested entry of the arcondment for purposes of appeal but in order to prevail presumably would have been required to show to the satisfaction of the Commissioner that the dollay in so requesting its entry "was unavoidable." Instead, this record shows that appellant did nothing. Thes, it seems to me that 35 U.S.C. 133 is controlling. Under these circumstances, and trolling. Under these circumstances, applicant had not prosecuted the applica-tion within 6 months from the date of the final rejection and this section of the statute requires that in such case the application "shall be regarded as abandoned by the parties thereto." The abandonment stands "unless it be shown to the satisfaction of the Conmissioner that such delay was unavoidable." It is clear from the record here

that appellant made no such shewing.
There is no provision in Title 35
U.S.C. which sutherizes the sua sponte
revival by the Patent Office of an application which has become abandonch under 35 U.S.C. 133. Section 123 authorizes revival of such an abandonch application only upon a showing "to the satisfaction of the Commissioner" that the delay was unavoidable. There is no such showing here.

It seems to me that it but confuses It seems to me that it but concuses the issue to concern ourselves with the respective authority of the examiner and the Commissioner in this situation. The fact is that the statute itself requires a showing of unavoidable deiny to overcome the abandoned status of an application where the abandonment results from the failure of the applicant to respond timely to an Office ne-

Likewise I find it irrelevant to discuss the relative position of the parties in an interference proceeding. Abandoning an application under the conditions specified in section 133 may be some avidence of an intent either to abandon the invention or to conceal it, within the meaning of 35 U.S.C. 10:2 (c) and (g).

There is a public interest not only in awarding a patent to the first in-ventor but also in not awarding it to one who has by abandonment of his patent application taken a first seep in perhaps depriving the public of knowledge of his invention. In such a situation the reasoning in Mason v. Bettourn, 13 App. D.C. 86, 95-96 (1988), seems to be particularly appropriate. The court stated:

Considering, then, this parametric interest of the public in its bearing

upon the question as presented here, we think it imperatively demands that a subsequent inventor of a new and useful manufacture or improvement who has diffigently pursued his labors to the procurement or a pat-ent in good faith and without any knowledge of the preceding discov-evies of another, shall, as against that other, who has deliberately con-cealed the knowledge of his inven-tion from the public, be regarded as the real inventor and as such entitled to his reward.

The true ground of the doctrine, we apprehend, lies in the policy and we apprehend, hes in the policy and spirit of the patent laws and in the nature of the equity that arises in favor of him who gives the public the benefit of the knowledge of his invention, who expends his time, labor, and money in discovering, perfective and money in discovering, perfective and money in discovering, perfective and money in discovering. feeting, and patenting, in perfect good faith, thet which he and all others have been led to believe has never been discovered, by reason of the indifference, supinchess, or wilful act of one who may, in fact, have discovered it long before.

52 CCPA

Court of Customs and Patent Appeals

In re MANSON

Decided June 25, 1964 Appl. No. 7140 Rehearing denied Nov. 5, 1964

#### PATENTS

1. Affidavits-In general (§ 12.1)

Interference-In general (§ 41.01)

Patentability-Subject matter for patent monopoly-l'recess, preduct and apparatus (\$ 51.613)

Patentability-Utility (§ 51.75)

35 U.S.C. 101 does not justify requirement that, before applicant may have his claims to a new process placed in inter-ference with prior patent to determine priority of invention pursuant to section 135, he must show (Rule 204(b)) that a utility for known compound produced by process was known at time he invented process; as defined in section 101, a process is a separate category of patentable invention; process which operates as disclosed to produce known product is weful within meaning of section 101; to

add to section 101 the further requirement that such process is useful only when a use for a known end product is disclosed is improper arrogation of authority delegated to Congress by Constitution.

Patentability—Subject matter for patent monopoly—Process, product and apparatus (§ 51.613)

Patentability-Utility (§ 51.75)

Specification-Sufficiency of disclosure (§ 62.7)

Process is patentable if it produces a product even if product is not known or proved to be useful, although 35 U.S.C. 101 : quires that product be useful to be patented; specification need not show how to use product of claimed process; where claimed process produces known product, it is not necessary to show utility for product.

3. Patentability-Utility (§ 51.75)

Process is useful, as a matter of law, if it operates as disclosed to produce its intended result or perform its intended function and if it is not, in operation or result, detrimental to public interest.

Particular patents --- Organic Com-

Manson, Preparation of Organic Compounds, rejection of claims 2 and 3 of application reversed.

Appeal from Board of Appeals of the Patent Chice.

Application for patent of Andrew John Manson, Serial No. 3,693, filed Jan. 20, 1960; Patent Office Mechanized Division A. From decision rejecting claims 3 and 3, applicant appeals. Reversed; and 3. applicant appeals. Reversed; Worley, Chief Judge, dissenting with

LAURENCE & LAURENCE (DEAN LAURENCE and John L. White of coursel) all of Washington, D.C., for appellant.
CLARENCE W. MOORE (JOSEPH SCHIMMEL)

of counsel) for Commissioner of Patents.

Before Worley, Chief Judge, and Richt, MARTIN, SMITH, and ALMOND, Associate Judges.

SMITH, Judge.

The single legal issue presented by this appeal is whether an applicant for a patent on a new process for making a known compound must establish a utility for such compound, in order to satisfy the requirements of Rule 201 (b) preparatory to having an interference declared between his application and a prior patent.

It is unnecessary to encumber this

primary examiner, except under the provisions of rule 196, without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

# INTERPERENCES: DEFINITION, PREPARATION, DECLARATION

201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title, and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

25 U.S.C. 135. Interferences. (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same rubject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the came so requests, the copy shall be kept separate from the file of the interference, and made available only to Governmeal agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforecable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

202. Preparation for interference between applications; prelininary inquiry of junior applicant. In order to ascertain whether any question of priority arises between applications which appear to interfere and are otherwise ready to be prepared for interference, any junior applicant may be called upon to state in writing under oath or declaration the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration for the purpose of establishing priority of invention. The statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than thirty days, or if the earliest date alleged is subsequent to the filing date of the senior party, the interference ordinarily will not be declared.

203. Preparation for interference between applications; suggestion of claims for interference. (a) Before the declaration of interference, it must be determined by the examiner that there is common subject matter in the cases of the respective parties, patentable to each of the respective parties, subject to the determination of the question of priority. Claims in the same language, to form the counts

D/3451 A Auin

Paper No. 60

IN THE UNITED STATES PATERT OFFICE

BEFORE THE BOARD OF PATENT INTERPERENCES

DEC 20 1973 U. S. PATENT GIFTE

0

Patent Interference No. 98,047

Shattuck ot al v. Hoegl et al

Shattuck et al on November 14, 1973 filed a motion under Rule 287(c) for an order requiring the senior party Hoegl et al to:

1. Answer interrogatories,

2. Produce decuments,

3. Dasignate witnesses,

4. Produce Hoogl and Barchietto for the purpose

of taking oral depositions and 5. Produce Loll, Weigl and Karambeles for the purpose of taking oral depositions.

Hoegl et al have opposed the motion.

There appears to be some confusion as to the name of one of the persons referred to on better Report No. 21. It is presumed the spelling specified in the papers filed by Hoegl et al is correct and, therefor, the discovery requested of E. Loll is considered to be directed to E. Loll.

Shattuck et al based their request for discovery en (a) the Hoegl et al submission of claims in their parent application after the Shattuck et al patent issued, (b) the statement in one of the attachments to the Hoegl et al proliminary statement that certain results "show again what E. Lell and J. Weigl already have pointed out; namely, that TMF in the best CT sensitizer found so far for PUC", (c)

the failure of Hoefi et al to disclose the existence of four foreign patent applications corresponding to their parent application, (d) the changes made in the specification of the CIP application and (e) the averment of counsel for Shattuck et al based on hearsay evidence and the alleged difference in appearance of the signature of Barchiette in the CIP declaration. It is asserted that the above constitute grounds to justify the investigation of the possibility that Hoefl et al are guilty of fraud on the Patent Office.

Turning to the question of possible fraud by Hoegl ot al., we do not consider that the showing by Shattuck et al in support of their motion establishes that the interest of justice requires the ordering of the additional discovery requested. Where, as here, a broad allegation of fraud has been leveled by one of the parties no order for broad discovery will be issued merely to investigate the possibility of the existence of fraud. Moreover, it is considered that the fraud in ex parts prosecution of an application does not directly relate to the question of priority of invention and is, therefore, not a matter that is reviewable under Rule 258 at final hearing. The proper procedure consistent with Rulo 56 was established by Vandenberg v. Reynolds 46 CCPA 938, 268 F.2d 744, 122 USPQ 381; and Norton v. Curtiss, 433 F.24 779, 167 USPQ 532. Any question of such fraud should be raised by way of petition to the Commissioner under the aforementioned rule.

[UNDERLINING FOR EMPHASIS]

As to the possibility of fraud on the Board of Patent Interferences in connection with the preliminary statement of Meegl et al we note that they have no objection to the fourth interrogatory to the extent it requests all documents concerning, relating or referring to the work performed by E. Lell and J. Weigl which forms the basis for the statement in the Letter Report No. 21 be identified. Hoegl et al also state they they have no objection to the fifth and fifteenth interrogatories. An ensuer to the noted interrogatories to the extent indicated above should provide Shattuck et al with the discovery that is justified under the circumstances.

Therefore, the motion of Shattuck et al is granted to the extent that Hoogl et al are hereby ordered to answer, within twenty (20) days from the date of this decision, interrogatories No. 5 and No. 15 and interrogatory No. 4 to the extent it requests the identity of documents which form the basis for the statement in Letter Report No. 21 referring to E. Lell and J. Weigl. Hoegl et al are also ordered to make available to the party Shattuck et al, within thirty (30) days from the data of this decision, for inspection and copying all documents in the possession custody or control of Hoegl et al or of his assignce of record which will be identified in the latter's response to interrogatory No. 4.

It should be further noted in connection with the Shattuck et al request for the production of witnesses that this Board has no authority to order or force a person to testify in an interference proceeding. Shattuck et al can, however, call the persons involved as their own witnesses which apparently is what they intend to do.

To the extent not granted above the Shattuck et al motion under Rule 287(c) is decired for the reasons stated belove.

In view of the action taken above the stipulation for extension of time filed on Docember 13, 1973 is approved to the extent that the times are extended as follows:

Testimony-in-chief of Shattuck et al to close February 25, 1974.

Time for service under Rule 237(a) by Heegl et al of decuments and lists to close Harch 11, 1974.

Tostimony of Hoegl ot al to close April 11, 1974.

Timo for service under Rule 287(a) by Shettuck et al of decements and lists in robuttal to close April 15, 1974.

Rebuttal testimony of Shattuck et al to close April 30, 1974.

Time for filing and serving the record to close May 30, 197h.

James S. Bailey

James S. Bailey Examiner of Interferences

Stephen W. Capelli

Stephon W. Capelli Examiner of Interferences

MARYIN A. CHAMPION

Examiner of Interferences)

PATEMET INTERFARENCES

TEC STRANS

## ITEM No. 10

UNITED STATES DISTRICT COURT WESTERN DISTRICT OF NEW YORK Rec'd 5/10/74

SHATTUCK, ET AL.,

Moventa

- vs -

No. 98,047

HOEGL, ET AL.,

Respondents

Wiser, Shaw, Freeman, Vangraafeiland, Harter & Secrest 700 Midtown Tower Rochester, N.Y. 14604 Attorneys for movants

Pennie & Edmonds
330 Madison Avenue
New York, N.Y. 10017
and
Joseph G. Walsh
% International Business Machine Corp.
San Jose, Calif. 95114
(of counsel)

Brumbaugh, Graves, Donohue & Raymond 30 Rockefeller Plaza New York, H.Y. 10020 by Francis J. Hone

Paris, Haskell & Levine
Washington, D.C.
and
Anthony W. Karambelas
Xerox Corporation
Xerox Square
Rochester, M.Y. 14644
Attorneys for respondents

Harris, Beach & Wilcox 2 State Street Rochester, M.Y. 14614 by Elliett Horton (of counsel) order to show cause, to compel the witness Weigl and Kerox Corporation to produce documents identified in the moving papers attached to the order to show cause dated April 23, 1974, and compelling Weigl to answer all questions relating to such documents. The documents withheld by Weigl are dated in March and April, 1970, about when IBM commenced commercial production of its IBM Copier machines employing a specific composition coming within the scope of the Shattuck \* al patent.

Reference is here made to the order of this court dated March 26, 1974 compelling the witness Weigl to testify and to produce documents, including the documents now withheld, and holding in part, "The movants are entitled to unrestricted access to sources of information bearing on the question of fraud.---". It is essential that Shattuck, et al, have access to the documents to be able to present the facts to the Patent Office regarding the issue of fraud.

The objection of Xerox to the production of the documents on the ground of attorney-client privilege is over-ruled.

- 3 -

produce the identified documents and answer all questions relating to such documents. If the parties can not agree upon a time and place, I will, on ex parte application of either party, fix the time and place by order.

HAROLD P. BURKE United States District Judge

Yay 7. 1974.

## ITEM No. 11

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

SHATTUCK ET AL.,

Movants,

Patent Interference 98,047

v. HOEGL ET AL.,

Respondents.

#### NOTICE OF APPEAL

Notice is hereby given that the party, Hoegl et al, the Respondents above named and its assignee, Xerox Corporation, hereby appeal to the United States Court of Appeals for the Second Circuit from the Order directing the witness Weigl to produce documents claimed to be privileged and attorney work product and to answer all questions relating to such documents, entered in this action on the 8th day of May, 1974.

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

Dated: May 14, 1974

Francis J. Hone Attorneys for Respondents 30 Rockefeller Plaza New York, New York 10020

(212) 489-3326

Of Counsel:

Elliott Horton, Esq. Harris, Beach & Wilcox 2 State Street Rochester, New York 14614 Tel. (716) 232-4440 Ronald B. Hildreth, Esq.

Brumbaugh, Graves, Donohue & Raymond 30 Rockefeller Plaza New York, New York 10020



焰

Anthony W. Karambelas, Esq. Xerox Corporation Xerox Square Rochester, New York 14644

# CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Appeal was served this day by mailing a copy thereof, postage prepaid, to Robert J. Kadel, Esq., Pennie & Edmonds, 330 Madison Avenue, New York, New York 10017, and to Joseph G. Walsh, Esq. International Business Machines Corporation, Monterey & Cottle Roads, San Jose, California 95114.

Dated: May 14, 1974

Francis J. Hone

Attorney for the party

Hoegl et al

UNITED STATES DISTRICT COURT WESTERN DISTRICT OF NEW YORK
SHATTUCK ET AL.,
Movants,
<b>v.</b>
HOEGL ET AL.,
Respondents.
Patent Interference 98,047
NOTICE OF APPEAL

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND
30 ROCKEPELLER PLAZA
NEW YORK, N. Y. 10020
212-480-0300